
(2004) 02 IPAB CK 0007

In the Intellectual Property Appellate Board

Case No : TA/33/2003/TM/CH (TMA/1/2002)

Fena Private Limited

APPELLANT

Vs

Nipa Chemicals Pvt. Ltd. And Ors.

RESPONDENT

Date of Decision : 04-02-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11(a), 11(e), 12(1), 18(1), 20(1)

Citation : (2004) 28 PTC 371 (IPAB)

Hon'ble Judges : Raghbir Singh, J; T.R. Subramanian, Technical Member

Bench : Division Bench

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

Final Decision : Allowed

Judgement

Raghbir Singh, J

1. Application No. 435800 for registration of trade mark 'NIPA' (word per se) in class 3 in respect of chemical substances for cleaning metal surfaces

was filed by respondent-1 herein before on 29th March, 1985. The trade mark was stated to be proposed to be used on the date of application. The

application on having been advertised before acceptance under proviso to Section 20(1) of the Trade and Merchandise Marks Act, 1958 (hereinafter

referred to as the Act) was published in the trade mark journal No. 996 dated 1st December, 1990 at page 988. Appellant/opponent herein above filed

an opposition on 18th February, 1991 inter alia the following grounds :-

- i) They are the registered proprietors of trade mark 'Nip' in respect of ""detergents and soaps"" under trade mark No. 306410B as of 20th July, 1975
- ii) That great reputation and goodwill has accrued to their trade mark by reason of long and continuous use, advertisement, sales promotion etc.

iii) That the impugned mark is identical with and/or deceptively similar to their trade mark 'Nip' and the goods in respect of which the applicant

purposes to use the impugned trade mark are the same for which the trade mark 'Nip' is registered.

iv) That the use of impugned mark will result in deception and confusion in view of the established user and reputation associated with their mark.

v) That the use of impugned mark is neither adapted to distinguish nor capable of distinguishing the goods of the applicants.

vi) That some more applications for the registration of the trade mark NIP are pending and proceeding to registration under the provision of the Trade

and Merchandise Marks Act, 1958.

vii) That the registration of the impugned mark applied will be contrary to Sections 9, 11(a), 11(e), 12(1) and 18(1) of the Act.

2. On the basis of the counter statements of the applicant and the evidence filed in support of the opposition filed by the opponent, the learned Deputy

Registrar of Trade Marks came to the following conclusions:-

a) Section 12(1) provides that 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

opponent's mark 'Nip' is stated as registered under No. 306410 and 430691 in respect of ""detergents and soaps"" and detergents, soaps and cleaning

powder respectively. The applicant's mark 'NIPA' is sought to be registered in respect of chemical substances for cleaning metal surfaces. Applying

the principles laid down by Lord Parker in Pianotist Co. Ltd.'s, (1906) 23 RPC 774 at 777, the learned Deputy Registrar came to the conclusion that

the opposition does not meet the standards fully as laid down in that case. The opponents are the registered proprietors of the trade mark 'Nip'

whereas the mark sought to be registered by the applicant is ""NIPA"". Applying these principles that the two marks 'Nip' and 'NIPA' as a whole are

same and are deceptively similar to each other and on application of these principles the foregone conclusion is that the rival marks are practically

identical. However, in relation to the test in matter of goods under the rival mark, the Ld. Deputy Registrar came to the conclusion that 'chemical

substances for cleaning metal surfaces' in respect of applicant's trade mark

'NIPA' are different from the goods in respect of which the opponents'

trade mark 'Nip' registered under Nos. 306410 and 430691 for 'detergents, soaps and cleaning powders'. The former is basically a cleaning

preparation which is used to clean metal surfaces, whereas the latter is detergents, soaps and cleaning powders being preparations for cleaning which

are mainly used to clean clothes and household utensils. However, both belong to the same class in matter of classification of goods under the Fourth

schedule. But that in no way affects the distinctiveness of the purpose for which they are used. Thus, he concluded that the requirements of Section

12(1) are not satisfied.

b) In the matter of opponent's claim that the impugned mark is struck by Section 11(a) of the Act as the same is likely to deceive or cause confusion

in the mind of the purchasing public and that shall be to the detriment to their trade marks registered for 'detergents, soaps and cleaning powders'

covered under registration Nos. 306410B and 430691, the learned Deputy Registrar held the view that even though the marks are identical and the

goods relating to which those marks pertain being totally different, it was difficult to infer that confusion is likely to arise unless there is such positive

evidence to arrive at such conclusion and thus he was of the view that as the rival goods being different, there is no scope for such confusion. He

further concluded on the basis of evidence adduced that nothing has been filed to substantiate that any of the dealers or consumers so feels that, in

spite of variance of the goods covered and identity of marks, there is likelihood of confusion.

c) In the absence of any positive evidence having been adduced the learned Deputy Registrar felt that there is no scope for withholding the

registration of the trade mark on the basis of Section 11(e) of the Act also.

d) In matter of challenge under Section 18(1) of the Act, the learned Deputy Registrar agreed with the explanation given by the respondent for

choosing the mark 'NIPA' in relation to the goods, it being a coined word from the name of the Japanese collaborators of their company. They had

accordingly changed the name of their company also.

In view of the above the learned Deputy Registrar by his order dated 26th November, 2001 dismissed opposition MAS 2458 and ordered for the

registration of application No. 435800. The present appeal is against the order

dated 26th November, 2001 of the Deputy Registrar.

3. Appellant/Opponents in their averments in the memorandum of appeal have made the following submissions:-

i) The mark 'Nip' and 'NIPA' are as a whole the same and are deceptively similar to each other and thus are practically identical.

ii) Since the appellant is the registered proprietor of the trade mark 'Nip' in respect of cleaning powders in addition to other goods and the respondent-1

is seeking registration of the deceptive trade mark 'NIPA' in respect of chemical substance for cleaning metal surfaces and thus the appellant's mark

'Nip' registered in respect of cleaning powder includes, inter-alia, chemical substances for cleaning metal surfaces, the learned Deputy Registrar ought

to have come to the conclusion that the goods involved are of the same description and that he should have refused registration for the impugned

mark. The impugned order is thus violative of Section 12(1) of the Act.

iii) The learned Deputy Registrar having recognised that the appellant has extensively used the trade mark 'Nip' for 'detergents, soaps and cleaning

powders' covered under trade mark registration Nos. 306410B and 430691 should have for the purposes of Section 11(a) concluded that the use of the

trade mark applied for is likely to cause confusion and deception, for which the onus of proof that no confusion or deception is likely from use of such

trade mark lay upon the respondent/applicant and they have not adduced any evidence in support of the same.

iv) Principles of law have been laid down under various judicial pronouncements to the effect that a slight possibility or likelihood of a trade mark

causing confusion or deception shall lead to the conclusion of denying the registration with a view to maintain the purity of register and keeping public

interest in mind. The intentions in this regard are irrelevant and what is more important is the effect of use of the trade mark. The learned Deputy

Registrar has gone wrong in accepting the belated explanation for adopting deceptively similar trade mark "'NIPA' having been derived from the name

of their collaborators in Japan.

4. First we would take up for consideration the issue under Section 12(1) of the Act. The rules for comparison of words has been laid down by Lord

Parker in Pianotist Company Limited's application, (1906) RPC 774 at p.777, which is as follows :-

You must take the two words. You must Judge 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 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 marks. 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"".

5. 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).

6. It is also a well settle 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 visualise, if a customer who may be an ordinary citizen and who may want to purchase a product would get confused. Also in Aplin v. Richards, (1903) 20 RPC 799 it has been held that ST. IVES was similar to ST. IVEL, the goods being cheese.

7. As pointed out in Simatul Chemical Industries (P) Ltd. v. Vibatul Ltd., 19 GLR 315 d,eception 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. The appellant's mark is 'NIP' registered under Nos. 306410 and 430691 in class 3. The appellant's trade mark is 'Nip' (word per se) whereas the respondent's trade mark is 'NIPA' (word per se). The only difference between the two marks is the suffix letter 'A'. Taking into consideration the above decisions that the trade mark has to be compared as a whole and that the first impression counts more in deciding the case and also in view of the fact whether an average person with imperfect recollection would be confused, we are of the view that the rival marks are visually, phonetically and structurally deceptively similar.

8. As regards the goods, the respondent's goods comprises of 'chemical substances for cleaning metal surfaces', whereas the appellant's goods comprises of 'detergents, soaps and cleaning powder' which have been registered under No. 306410 and 430691. The counsel for the appellants submitted that detergents, soaps and cleaning powders could also be used for cleaning metal surfaces like utensils and hence the rival goods are the same. In reply the counsel for respondents submitted that their goods are chemical composition for cleaning metal surfaces which are used for industrial purposes like cleaning of oil, water tankers etc. and hence the use for which the respondent's goods are utilised is quite different from the use for which the applicant's goods are utilised. We have carefully considered the arguments of the counsels. Respondent's goods is chemical composition for cleaning metal surfaces. This is a very wide description of goods. The appellant's goods is detergents, soaps and cleaning powder. Both the goods fall under class 3. It may be seen that detergents, soaps and cleaning powder fall under the category of chemical compositions. Furthermore, they can also be used for cleaning metal surfaces like cars, vehicles and big table tops in hotels and in other places where large metal surfaces has to be cleaned. In view of this we are of the opinion that the goods of the appellants and that of the opponents are goods of the same description. Hence, the appellant's objection under Section 12(1) is sustained.

9. As regards Section 11(a) of the Act which provides, that a mark the use of which would be likely to deceive or cause confusion shall not be registered as a trade mark, the appellants have filed evidence of use of the trade mark 'Nip' during the period from 1976 to 1991, the appellants have also filed documentary proof such as invoices, trade correspondence, advertisements etc., to establish use and reputation of their mark. It is seen from the above that the appellants have extensively used their trade mark 'Nip' in respect of detergents, soaps and cleaning powder. As we have already held that the rival marks are deceptively similar and the goods are also goods of the same description, we hold that the appellant's objection under Section 11(a) is also sustained as they have established the use and reputation of their mark.

10. As regards Section 18(1) of the Act, the counsel for the respondents submitted that the respondents are trading in the name of ""NIPA"" Chemicals

Private Limited and so they have adopted the mark 'NIPA' from their trade style. They have further submitted that the word 'NIPA' was coined by

combining the first two letters of each of the words Ninon and Parkerising respectively from the name of the foreign collaborators Nihon Parkerising

Company Limited, Japan. We are satisfied with the explanation offered by the counsel for the respondents regarding their honest adoption of the trade

mark 'NIPA'. Therefore, the appellant's objection under Section 18(1) is not sustained.

11. In the result the appeal is allowed and there is no order for costs.