
(2010) 07 IPAB CK 0005

In the Intellectual Property Appellate Board

Case No : M.P. No. 218/09 In OA/67/2009/TM/MUM, OA/67/2009/TM/MUM

Franco-Indian Pharmaceuticals Pvt. Ltd.

APPELLANT

Vs

Ciron Drugs And Pharmaceuticals Pvt. Ltd. And The Assistant
Registrar Of Trade Marks

RESPONDENT

Date of Decision : 30-07-2010

Acts Referred:

Trade Marks Act, 1999 — Section 9, 9(2), 11, 12, 18(1)

Citation : (2010) 07 IPAB CK 0005

Hon'ble Judges : S. Usha, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

S. Usha, J

1. Appeal arises out of the order dated 17.11.2008 dismissing opposition No. BOM-167475 and allowing application No. 1132727 in class 5 to proceed

to registration under the provisions of the Trade Marks Act, 1999 (hereinafter referred to as the Act.). The Appellant has filed M.P. No. 218/09 to

stay the operation of the order of Respondent No. 2 dated 17.11.2008.

2. The Respondent No. 1 herein filed an application for registration of the trade mark ""CORORANGE"" in class 5 in respect of pharmaceutical and

medicinal preparation under No. 1132727 on 11.09.2002 claiming user since 20.11.2002. The said application was advertised in the trade marks

Journal No. MEGA 4 dated 04.10.2003 at page No. 1324.

3. The Appellant herein filed the notice of opposition on the ground that they are leading and established manufacturers and dealers of pharmaceutical

products for the last several years. In the year 1971, they bonafidely and honestly adopted the trade mark ""DEXORANGE"". The Appellants are the

registered proprietors of the trade mark DEXORANGE under No. 269335 in class 5. The said trade mark was assigned to M/s Warde

Pharmaceuticals Pvt. Ltd., who later on re-assigned to the present Appellant on 01.01.1989. The registration is subsisting and still in force. The

Appellants are the owners of the artistic work and have obtained copyright registration in the label and carton under Nos. A-12173/74 and A-1055174.

The Appellant's trade mark has acquired a tremendous goodwill and reputation among the public by virtue of extensive and continuous use.

4. The registration of the impugned trade mark ""CORORANGE"" would be contrary to the provisions of Sections 9, 9(2), 11, 12, 18(1) of the Act. The application, therefore, be refused and opposition be allowed with costs.

5. The Respondent No. 1 herein filed their counter-statement to the notice of opposition denying the averments made in the notice of opposition. They

stated that they are carrying on business of manufacturing and marketing medicinal, pharmaceutical goods cognate and allied. The Respondent No. 1

in or about 2000, after making a search in the Trade Marks Registry and as no conflicting mark was available in the Register of Trade Marks adopted

the trade mark ""CORORANGE"" and applied for registration in the year 2002. They further stated that the rival marks ""CORORANGE"" and

DEXORANGE"" are not deceptively similar and are distinct and different in sound and vision. The mark DEXORANGE when split the prefix DEX

does not bar others from using the word ORANGE with any other prefix or suffix. The suffix ORANGE is either a fruit or a colour. The Respondent

No. 1's adoption is honest and bonafide and deserves to be protected under Section 12 of the Act. The application, therefore, be allowed to be

proceeded for registration.

6. On completion of the formal procedure, the Assistant Registrar of Trade Marks passed the impugned order on the finding that the objection under

Section 9(2) was rejected as the trade mark ""CORORANGE"" of the Respondent No. 1 was distinctive and different from the Appellant's trade mark

DEXORANGE"" by sound and vision and was not deceptively similar; the Appellants have not produced cogent evidence to support their claim of

confusion and deception, therefore, the objection under Section 11 of the Act was rejected; the objection under Section 12 of the Act is rejected as the

Respondent No. 1's adoption and user is honest and the Respondent No. 1 is the

proprietor of the trade mark as it has been coined and adopted by them and the objection under Section 18(1) is hence rejected;

7. Aggrieved by the said order, the Appellant herein filed the appeal on the following grounds:

(a) the impugned order is erroneous and contrary to the principles of law and facts and circumstances of the case and is liable to be set aside;

(b) the learned Registrar erred in holding that the trade mark ""CORORANGE"" was distinctive and different from the Appellants trade mark

DEXORANGE"";

(c) the learned Registrar failed to consider the test of unwary customer, average intelligence and imperfect recollection as laid down by the Apex

Court;

(d) the learned Registrar erred in holding that the Respondent No. 1 had adopted the trade mark ""CORORANGE"" where there was no explanation

given by the Respondent No. 1 for its adoption;

(e) the Respondent No. 2 erred in holding that the Respondent No. 1 adopted the impugned trade mark ""COROGANGE"" in November 2000 whereas

the application for registration was filed on 11.09.2002 claiming user since 20.11.2002 only;

(f) the Appellant has produced voluminous documents to show that the impugned registration would cause confusion and deception which was not

considered by the registrar;

(g) the Respondent No. 2 erred in holding that the trade mark is coined and honestly used by the Respondent No. 1;

(h) the Respondent No. 2 erred in holding that the Respondent No. 1 adopted the impugned trade mark honestly and bonafidely within the meaning of

Section 18(1) of the Act;

(i) the learned Registrar failed to appreciate the fact that the adoption of the trade mark ""CORORANGE"" would lead to dilution of the distinctive

character and repute of the Appellant's mark and would lead to confusion and deception as to the source and origin of goods in view of the

DEXORANGE"" series of marks belonging to the Appellant;

(j) the Respondent No. 2 had erroneously held that the Respondent No. 1 had honestly adopted the trade mark without appreciating the well settled

principles of law that the marks are to be compared as a whole and not split up for the purpose of comparison;

(k) the Respondent No. 2 had not considered the Judgments cited by the Appellant at the time of arguments;

(l) the learned Registrar wrongly exercised the discretion in favour of the Respondent No. 1.

8. The Respondent No. 1 filed their counter-statement denying the contentions made in the grounds of appeal. The Respondent being the first in

adoption and user of the trade mark is the proprietor of the trade mark ""CORORANGE"". The Respondent No. 1 further stated that the application for

registration was made in the September 2002 claiming user since November 2000 but the date of user in the Trade Mark Journal was wrongly printed

as November 2002.

9. The Respondent No. 1 further stated that they adopted the trade mark after telescoping the memorable part of the corporate name of the company

with the word ORANGE which indicates a type of flavour. The trade mark ""CORORANGE"" is a new and freshly coined word and has no obvious

meaning and is not a dictionary word. The certificate issued by the chartered accountant showing the annual sales figures of the product bearing the

trade mark ""DEXORANGE"" for the years 1999-2005 will prove the Respondent No. 1's use of the impugned trade mark.

10. The test of unwary customer and average intelligence will not be applicable as the goods are medicinal products stored by licensed dealers and

dispensed by pharmacists on a written prescription by a doctor. The word DEX and COR are neither similar in vision, phonetics nor in structure. The

common word ORANGE does not disqualify the Respondent No. 1's genuine claim. There are several products available with the word ""ORANGE"".

11. We have heard Shri Mahesh A. Mahadgut learned Counsel for the Appellant and Shri K.K. Sharma, learned Counsel for the Respondent at the

Circuit Bench sitting Mumbai on 10.06.2010.

12. The learned Counsel for the Appellant contended that the Appellants adopted the trade mark ""DEXORANGE"" as early as in 1971 and are the

registered proprietors of the trade mark. The sales turnover runs to several lakhs of rupees and they have spend huge amounts towards promotional

expenses by way of advertisement. The counsel drew our attention to the

invoices at paged 47 to 99 filed as Exhibit B along with the appeal papers and stated that they had been carrying on business under the said trade mark ""DEXORANGE"" continuously and extensively without any interruption.

13. The counsel further submitted that the Respondent had not given any explanation for the adoption of the trade mark ""CORORANGE"" in the counter-statement before the Registrar of Trade Marks in the opposition proceedings, whereas in the evidence in support of application had gone ahead stating that they adopted the mark from their trading style in part and the suffix orange to denote the flavour. The adoption of the impugned trade mark is dishonest and the provisions of Section 12 of the Act will be of no help to the Respondent.

14. The counsel for the Appellant further submitted that no search report was filed before the Registrar as observed by the Respondent No. 2 in the impugned order at page 6. The counsel relied on the Judgments reported in (i) AIR 1960 Sc 142 Corn Products Refining Co., v. Shangrila Food Products Ltd.; (ii) 1996 PTC (16) Ciba Geigy Ltd., v. Crosslands Research laboratories Ltd.; (iii) 2001 PTC 300 (SC) Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.; (iv) AIR 1963 SC 449 Amritdhara Pharmacy v. Satya Deo Gupta; (v) AIR 1953 SC 357 National Sewing Thread Co. Ltd. V. James Chadwick and Bros., Ltd.; and (vi) 2009 (40) PTC 732 (IPAB) Glenmark Pharmaceuticals Ltd., v. Bal Pharma Ltd.

15. The learned Counsel for the Respondent No. 1 contended that the impugned trade mark ""CORORANGE"" - ""COR"" was derived from the trading style and ORANGE was the flavour in the medicine. The counsel in this context relied on a passage from P. Narayan on Trade Mark Laws at para 8.34 and stated that it is usual in pharmaceutical business to name the medicine by using chemical names. The counsel relied on the well known DROPOVIT - PROTOVIT case where it was decided that VIT refers to vitamin and to use the ingredient vitamin to the name of the product is common and there was no similarity between the mark.

16. The Respondents have adopted the mark in the year 2000 and have been using the same without any interruption. There has been no confusion or deception among the public till date. The onus to prove confusion is on the Appellant. The Appellant though claim to be using the said trade mark since 1971 no evidence produced as proof thereof. The counsel further relied on the

judgment IPLR 2006 Oct. 205 Dr. Anji Reddy, Hyderabad v. Hoechst Aktiengesellschaft.

17. We have heard both the counsel and have carefully considered the same and have also gone through the pleadings and documents. The contention of the Respondent No. 1 is that they adopted the trade mark in the year 2000 (November 2000), whereas in the Trade Marks Journal it is mentioned as November 2002. Assuming that date to be November, 2000 as it is a printing mistake as contended by the Respondent No. 1 it is subsequent to the date of use by the Appellant i.e. in the year 1971. The Appellant though claims to have used the trade mark DEXORANGE since the year 1971, the latest invoice is of the year 1997. Even that year 1997 is prior to that of the Respondent No. 1's adoption.

18. A trade mark qualifies for registration by acquiring distinctiveness among the public. The mark may be distinctive or may be capable of acquiring distinctiveness by use. In the instant case, the mark has been applied for registration in the year 2002 claiming user since 2000. In a short period of two years the mark could not have acquired distinctiveness. That apart, the certificate issued by the chartered accountant is for the year 1999-2000 (the user is only from November 2000) for the sales of the goods bearing the trade mark ""CORORANGE"" which itself creates a doubt in our mind.

19. The next issue is as to the test of similarity between the two marks, the marks are to be compared as a whole. We have to approach from the point of view of a man of average intelligence and of imperfect recollection. We quote the observation of the Supreme Court in Corn Products case (supra) -

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. So considered, we are inclined to agree with Desai J. that the marks with which this case is

concerned are similar. Apart from the syllable "co" in the Appellant's mark, the two marks are identical. That syllable is not in our opinion such as

would enable the buyer in our country to distinguish the one mark from the other.

20. Following the above observation, we are of the opinion that in the rival marks "CORORANAGE" and "DEXORANGE", except for the prefix

COR and DEX the marks are identical. When the marks are identical the possibility of confusion and deception is certain.

21. It is also the settled principle that in an opposition proceedings the onus is on the applicant (Respondent No. 1) to prove that by registration of the

impugned mark no confusion or deception will arise. In this case, the Respondent No. 1 has not satisfied the same. It is also not the case of the

Respondent No. 1 that the marks are not similar. The search report relied on by the Respondent No. 2 while passing the impugned order has been

denied by the Appellant stating that it was not produced at the opposition stage and that it has been relied on by the Registrar on his own which has

not been disputed by the Respondent No. 1.

22. When the trade mark relates to medicinal products, due care is to be taken while granting registration. We, therefore, having decided that the

marks are deceptively and phonetically similar, are of the opinion that the trade mark "CORORANGE" of the Respondent No. 1 does not qualify to be

registered. The trade mark "DEXORANGE" of the Appellant which has been in use since 1997, if not since 1971 as claimed by the Appellant, has to

be protected.

23. For the reasons stated above, we are of the view that the application for registration of the trade mark "CORORANGE" has to be refused and the

opposition allowed. The appeal is, therefore, allowed and order of the Assistant Registrar is set aside with no order as to costs .M.P. No. 218/09

becomes infructuous as the main appeal has been allowed.