
(2008) 03 IPAB CK 0003

In the Intellectual Property Appellate Board

Case No : ORA/119/2006/TM/AMD

Lark Laboratories Limited

APPELLANT

Vs

Nabros Pharma Pvt. Ltd.

RESPONDENT

Date of Decision : 19-03-2008

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11, 18, 45, 57, 125
Code Of Civil Procedure, 1908 — Order 39 Rule 1, Order 39 Rule 2

Citation : (2008) 03 IPAB CK 0003

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

Bench : Division Bench

Advocate : R.K. Jain, Sejal R. Shah

Final Decision : Allowed

Judgement

,
Syed Obaidur Rahaman, Technical Member",

1. This is an application for removal of trade mark from the Register or rectification of the Register under Section 45, 57 and 125 of the Trade Marks",

Act, 1999. The trade mark 'DOLAREN' under No. 810263 in class 5 registered in the name of M/s Nabros Pharma Private Limited. The entry in the",

Register in respect of the above mentioned trade mark may be removed or cancelled.,

2. The facts of the case is that the applicant is engaged in the business of manufacturing and selling of medicinal and pharmaceutical preparations for,

more than two decades. In the year 1980 the applicant adopted a fanciful and inherently distinctive trade mark consisting of the work 'DOLAR' in,

respect of the aforesaid goods and after obtaining necessary drug licence from competent drug authorities, started using the said trade mark 'DOLAR'",

in respect of cough syrup in the year 1981. The trade mark 'DOLAR' in respect of medicinal preparations, by virtue of long, continuous, extensive and",

exclusive user of the last more than twenty five years, has become distinctive and the same is also associated exclusively with the name of the",

applicants. The applicant is the registered proprietor of the trade mark 'DOLAR' under No. 439950 in class 5 in respect of medicinal preparations.,

The said trade mark is valid, subsisting and in force till date. The applicant claims himself to be the sole and exclusive proprietor of the trade mark",

'DOLAR' in respect of the medicinal preparations under the common law by virtue of prior, long, extensive, exclusive and uninterrupted user and",

under the statute by the virtue of registration. The medicinal preparations of the applicant under the trade mark 'DOLAR' are very popular amongst,

the doctors, patients and medical fraternity at large by virtue of the exact composition, quality and effective control regarding the treatment of related",

ailments and as such, the trade mark has earned a unique goodwill and reputation associated exclusively with the name of the applicants.",

3. It is the case of the applicant that the goods of the applicant under the trade mark 'DOLAR' have been sold practically throughout the Republic of,

India. The sale of the applicant's aforesaid goods under the trade mark 'DOLAR' are very extensive and runs in to several lakhs of rupees. The,

applicant is carrying on extensive sales promotion of its trade mark 'DOLAR' through various dealers schemes, discount schemes, free samples",

schemes etc. and a huge amount has been spent on the sales promotion by the applicant. Due to excellent quality of the medicines sold by the,

applicant's goods under its trade mark 'DOLLAR' coupled with its aforesaid extensive sales promotion, the trade mark 'DOLAR' has become a very",

reputed mark and is associated exclusively with the name of the applicant. By virtue of the continuous and extensive user coupled with huge,

advertisement and publicity campaigns, the trade mark 'DOLAR' of the applicant in respect of its aforesaid goods has become a 'well-known' mark",

and has earned a commanding reputation and goodwill in the pharmaceutical industry on a national scale. The use of the trade mark 'DOLAR' and/or,

any other similar/deceptively similar trade mark in respect of medicinal preparations is bound to cause confusion and deception amongst the doctors",

patients and medical fraternity as the same shall amount to unfair trade practice, dilution and infringement of the applicant's proprietary rights with",

respect to its prior registered and established trade mark 'DOLAR'.,

4. The respondent/registered proprietor claims himself to be the manufacturer and merchants of medicinal and pharmaceutical preparations and has, obtained registration in respect of trade mark 'DOLAREN' in respect of identical/similar goods under No. 810263 in class 5 dated 15.07.1998, the",

subject matter of the present rectification. The respondent/registered proprietor has suppressed materials and relevant facts from the Registrar of, Trade Marks and by making false claim of proprietorship obtained the registration of the impugned mark. The respondents concealed the fact that the, Applicant is the prior user and registered proprietor of the trade mark 'DOLAR' for the last 25 years in respect of the identical goods. The impugned, trade mark 'DOLAREN' fraudulently adopted by the respondents is similar/deceptively similar to the prior adopted and used, reputed, registered and", established trade mark 'DOLAR' of the applicant. Further the goods involved herein are also identical i.e. medicinal preparations likely to be sold in the, same shop, over the same counter, to the same class of purchaser. Therefore, on seeing/buying the goods of the respondent branded under their", registered trade mark 'DOLAREN', the purchasing public would assume as if the impugned goods of the respondents are also coming from the", applicant's manufacture and/or that the respondent is a sister concern/branch of the applicant's firm, thus, there is every likelihood of confusion and", deception amongst the trade channels as well as the purchasing public. Therefore, the continuity of the registration of the impugned mark is hit by", provisions of Section 9 and 11 of the Act. The registered trade mark is not distinctive of the registered proprietor's goods. As the impugned mark of, the respondent is similar/deceptively similar, to the prior adopted, prior used, registered and established trade mark "'DOLAR' of the applicant in", respect of identical goods, therefore, the same is not capable of distinguishing its goods from those of the applicant's. Thus the impugned mark was not", distinctive or capable of being distinctive as on the date of its registration. Thus, the continuity of the registration of the impugned mark is hit by the", provisions of Section 9 of the Act. If the registration of the impugned mark 'DOLAREN' under the aforesaid number is allowed to be continued in the, name of the registered proprietor in the Register, the same shall lead and facilitate passing of the goods of the registered proprietor as the goods of the",

applicant. The registered proprietor has no justification for the adoption of the impugned mark 'DOLARNEN'. The registered proprietor has adopted, and fraudulently got the trade mark 'DOLAREN' registered with ulterior motives and dishonest intentions to trade upon the established goodwill and, reputation of the applicant's prior adopted and prior used proprietary mark 'DOLAR' and to earn undue profits in an illegal manner. The respondents, are not the actual and lawful owners and proprietors of their impugned mark 'DOLAREN' under Section 18 of the Act. Thus the respondents, concealed the relevant facts before the Registrar of Trade Marks and on the basis of false representation, obtained the registration of the impugned", mark. The impugned mark is of such nature that it is bound to cause confusion and deception among the purchasing public and hence the impugned, mark ought to be rectified by the Registrar. The registration of the impugned mark was made in the contravention of the provisions of the Trade, Marks Act and in particular the provisions contained in Section 9, 11 and 18 of the Act and even today the impugned mark continues to be in", contravention of the provisions of the Trade Marks Act, 1999 and particularly the provisions contained in Sections 9, 11 and 18 of the Act. The", continuation of the registered trade mark 'DOLAREN' under No. 810263 in Class 5 in the name of the registered proprietor would affect the purity of, the Register. The entry relating to the impugned mark was made in the Register without sufficient cause. The entry relating to the impugned mark, wrongly remains on the Register. The impugned mark is otherwise disentitled for protection in court of law. In his discretion, the learned Registrar", ought not to have registered the impugned mark in the name of the registered proprietor. The applicant is an aggrieved person within the meaning of, the present proceedings as the rights of the applicant with respect to its prior adopted and prior used mark 'DOLAR' are being adversely affected by, the registration and continuation of the impugned mark in the Register as both the applicant as well as the respondents are in the same trade and, further the respondents have started manufacturing and selling medicinal preparations under the impugned mark 'DOLAREN'. Further, the", respondents on the basis of their trade mark 'DOLAREN' have filed a civil suit for permanent injunction against the applicants at the District Courts", Ahmedabad. Thus in view of the aforesaid reasons, the applicants are the 'aggrieved persons' and have a locus standi to file and institute the present",

proceedings for cancellation/removal of the registered trade mark 'DOLAREN' in the name of the registered proprietor under the aforesaid number.,

The balance of convenience also lies in favour of the applicant and against the respondents. That the respondents have filed a civil suit against the,

applicant at City Civil Courts, Ahmedabad, on the basis of their aforesaid registered trade mark 'DOLAREN'. It is, therefore, prayed that the",

impugned trade mark 'DOLAREN' under No. 810263 in Class 5 in the name of the registered proprietor be rectified/removed/cancelled.,

5. In the counter statement filed by the respondent it is stated that the respondent is a private limited company incorporated under the Companies Act,"

1956 and the respondent is originally incorporated in the year 1983 in the name of Nabros Pharma Limited, thereafter having passed the necessary",

resolutions on 14.12.2004 to effect the change of name of Nabros Pharma Pvt. Ltd. The respondent company is engaged in the business of,

manufacturing, marketing, selling and exporting, medicinal and pharmaceutical preparations. The product of the respondent is in the form of the tablet",

under the trade mark with the artistic work in its copyright. The respondent coined the trademark 'DOLAREN' and the copyright in the label of the,

Financial year,Export Turnover

1996-1997,"3,17,65,560.00

1997-1998,"12,41,45,964.00

1998-1999,"7,98,56,552.00

1999-2000,"8,54,39,505.00

2000-2001,"17,98,27,181.00

2001-2002,"10,90,54,902.00

2002-2003,"13,30,67,385.00

2003-2004,"4,59,52,009.00

2004-2005,"9,46,36,707.00

2005-2006,"28,56,24,330.00

Wherever it can be shown, as here that the applicant is in the same trade as the person who has registered the trade mark and wherever the trade",

mark, if remaining on the Register would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register",

he could not lawfully do that, which, but for the existence of the mark upon the Register, he could lawfully do, it appears to me he has a locus standi to",

be heard as person aggrieved.,

Thus when the rights of the applicant is being interfered by the respondent as the registered proprietor under the impugned mark, the applicant is",

construed to be aggrieved person. From the above we are of the opinion that the applicant is a person aggrieved.,

The learned Counsel further relied on the following judgments:,

- (i) Syncom Formulations v. SAS Pharmaceuticals,
- (ii) 1996 PTC (16) Ciba Geigy Ltd., v. Crosslands Research Laboratories Ltd.",
- (iii) USV Limited v. IPCA Laboratories Limited,
- (iv) 2007 (35) PTC (Del) SSG Pharma Pvt. Ltd., v. Amar Nath",
- (v) 2002 (24) PTC 438 (Del) Vijay Grover v. Biocure Laboratories and Anr.,
- (vi) 1992-PTC-137 M.s Astra-IDL Limited v. M.s TTK Pharma Limited,
- (vii) Computer Sciences Corporation v. R. Thangaraj,
- (viii) 1998 PTC (18) Charak Pharmaceuticals v. Deepharma Ltd.,
- (ix) 1994-PTC-183 Brook Bond India Limited v. C. Patel & Co.,
- (x) Saroop Prakash Nayar v. Chesebrough Pond's Inc.,

10. The counsel for respondent No. 1 cited the order passed by the District & Sessions Judge, Delhi in Lark Laboratories v. Nabros Pvt. Ltd., the",

operative part of which is as follows:,

It was a criminal case and in the background of the case the Hon'ble High Court had appreciated the arguments that even in the goods of the,

accused were meant for export purposes only then also their seizure was necessary. The application of the plaintiff is therefore dismissed.,

His contention is that the applicant filed suit for injunction under Order 39 Rules 1 and 2 CPC filed by the plaintiff along with the suit wherein it has,

been prayed that the defendant be restrained from manufacturing, selling, offering for sale or otherwise dealing in medicinal and pharmaceutical",

preparations under the Trade Mark 'DOLAREN' and/or any other similar/deceptively similar trademark. Defendant be also restrained from passing,

off their goods as the goods of the plaintiff. After hearing the submissions of both the parties, the District and Sessions Judge, Delhi dismissed the",

plaintiff's application. He submits that the mark of the respondent is different from the appellant's mark and so there is no question of confusion in the, mark. Hence the rectification application shall be dismissed.,

11. We have heard both parties and gone through the documents. It is an admitted fact that the registration was obtained by the applicant in the year, 1980. So they are the prior adopter and user of the mark 'DOLAR' in respect of medicinal preparations. The respondent has copied the appellant's, mark and advertised his mark and encashing on the goodwill of the applicant's mark which is existing in the market very long. The respondent obtained, the registration of the mark by adding the letters 'EN' to the applicant's mark 'DOLLAR' and using the same mark in the same field as medicinal, preparation. Both the medicinal preparations are used in different use.,

12. So there is likelihood of confusion and deception amongst the trade channels and as well as the purchasing public. Also there is chance of adverse, effect if the medicines use if confused by the user. So we are of the view that the registration of the impugned mark is hit by the provisions of Section, 9, 11 and 18 of the Act. Hence we are of the view that the mark was registered wrongly and the same cannot be allowed to continue in the Register", of Trade Marks.,

13. In view of the above, ORA 119/06/TM/AMD is allowed and the Registrar is directed to remove the mark 'DOLAREN' under No. 810263 from", the Register of Trade Marks. However, there will be no order as to costs.",