

(2020) 09 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : M.P. No. 29/2020, 115/2020 In OA/20/2020/TM/MUM, OA/20/2020/TM/MUM

Macleods Pharmaceuticals Ltd.

APPELLANT

Vs

Registrar Of Trade Marks, Mumbai

RESPONDENT

Date of Decision : 11-09-2020

Acts Referred:

Trade Marks Act, 1999 — Section 11, 11(a)

Citation : (2020) 09 IPAB CK 0002

Hon'ble Judges : Manmohan Singh, J;Lakshmidevi Somanath, Technical Membe

Bench : Division Bench

Advocate : Archana Sahadeva

Final Decision : Allowed

Judgement

Lakshmidevi Somanath, Member (T)

1. This is the Appeal against the order of Registrar of Trade Marks, Chennai dated 11/04/2019 and 30/07/2019 refusing the registration of Trademark MENOREG under Trade Mark Application No. 2762117 in class 5.

2. The Appellant states that this application was filed in respect of the medicinal, pharmaceutical and veterinary preparations use in the treatment of menstrual disorders with user claims since 15th February, 2013.

3. Thereafter, the application was examined and examination report dated 3rd November, 2016 was issued. Objections were raised under section 11 of the Trade Marks Act, 1999 that same/similar trademarks are already on the record of the Register for same/goods/services. The Appellant filed its Reply to the Examination Report on 2nd May, 2017. Thereafter, the Hearing was listed for 08th May,-2018 and relisted on 10th April, 2019. At the hearings the similar marks cited were MENORAGE bearing registration No. 43281, and MENOREX AND MENORAZ under the Application Nos. 836585 and 964812 respectively were cited by the Respondent. Having heard the detailed submissions on behalf of the

Appellant, the Registrar of Trade Marks by impugned order dated 11th April, 2019 refused the Appellant's trade mark application on the ground that the trademark applied for is objectionable under Section 11 of Trade Marks Act, 1999.

4. Aggrieved by the impugned order dated 11th April, 2019, the Appellant filed review petition dated 10th May, 2019 inter-alia seeking review of the decision of the Registrar along with supporting documents evincing use of the mark MENOREG since 2013. Thereafter hearing was appointed on 23rd July, 2019. The Appellant made submissions with respect to the distinctive of its trade mark MENOREG and continuous and uninterrupted use since 2013 in the mark. Following this Impugned Order dated 30th July, 2019 was issued by the Respondent stating that no substance is found in the review petition.

5. Aggrieved by the impugned orders dated 11th April, 2019 and 30th July, 2019 passed by the Respondent, the Appellant has filed the present appeal before us.

6. The learned counsel for the Appellant Ms. Archana Sahadeva submitted that the Registrar of Trade Marks had erred by issuing a non-speaking order and by deciding that the impugned trademark MENOREG of the Appellant is deceptively similar to the other mentioned trade marks. As regards the usage of the trademark under section 11(a) of the Act she has submitted that the Appellant has been using the mark on a continuous and uninterrupted basis since the year 2013 without there being a single incident of confusion in the mark. She contended that they had submitted documentary evidence regarding usage to the Registrar along with the review petition dated 10th May, 2019. The Appellant states that the Registrar has not appreciated the evidence placed before him during the hearing of the Review Petition.

7. Going into the status of the similar cited mark it is found that the first mark MENORAGE bearing trademark No. 432817 has not been renewed and is likely to be removed from the Trade Mark Register due to non-filing of renewal request. The third mark MENORAZ bearing trademark No. 964812 has also not been renewed yet and the mark is currently valid upto 19th October, 2020. The second mark is MENOREX bearing trade mark No. 836585, this is a registered trade mark.

8. As stated by the Hon'ble Supreme Court in Cadila Healthcare Ltd. Vs. Cadila Pharmaceuticals Ltd. in AIR 2001 SC 1952, the learned Judges has considered the various decisions of the High Court on the question of deceptive similarity and at para 35 below as under:-

"35 Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:

a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. Both words and label works.

b) The degree resemblances between the marks, phonetically similar and hence

similar in idea.

- c) The nature of the goods in respect of which they are used as trade marks
- d) The similarity in the nature, character and performance of the goods of the rival traders.
- e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.
- f) The mode of purchasing the goods or placing orders for the goods, and
- g) Any other surrounding circumstances when may be relevant in the extent of dis-similarity between the competing marks."

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).

9. The rules for comparison of words have been laid down by Lord Parker in Pianotist Company Limited's application, (1906) 23 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 the surrounding circumstances and you must further consider what is likely to happen if each of those trademarks 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."

10. Bearing in mind the cited similar registered trademarks, it is to be ascertained whether the impugned trade mark application as applied on the article of purchase, would create an impression in the mind of an ordinary citizen that he was buying an article bearing the registered trademark. The general principle on the standard of care to be expected is that it must not be assumed that a careful examination of the mark will be made. It is also a well settled proposition that the marks have to be compared as a whole. In the present case the second mark is MENOREX bearing trade mark No. 836585, this is a registered trade mark. The Appellant has submitted that this trademark is being used by the Arya Vaidya Sala Pharmacy on capsules sold within a bottle whereas the impugned trademark is being used by the Appellant on 300 ml. syrup bottles. The packaging of both products has been produced by the Appellant before us.

11. We have examined the Registrars' orders dated 11/04/2019 and 30/07/2019

and reviewed the submissions of the Appellant. We find that the packaging of both goods are entirely dissimilar. Therefore there is no visual or conceptual similarity between the impugned trade mark application and the cited trade marks, and consequentially, no confusion would be caused to an average ordinary consumer with imperfect recollection. The Registrars' non-speaking orders dated 11/04/2019 and 30/07/2019 refusing the registration of Trade Mark application No. 2762117 in class 5 have failed to examine these aspects.

12. Taking into consideration of the above, the Appeal is hereby allowed. The Trade Mark application No. 2762117 in class 5 is allowed to proceed on to advertisement in the Trade Marks Journal. Impugned orders dated 11th April, 2019 and 30th July, 2019 passed by the Registrar of Trade Marks are set-aside. There is no order regarding costs.