

(2014) 02 IPAB CK 0003
In the Intellectual Property Appellate Board
Case No : OA/05/2006/TM/KOL

M/s. Raptakos, Brett And Co. Ltd	APPELLANT
Vs	
M/s. Assam Chemical Pharmaceutical Pvt. Ltd	RESPONDENT

Date of Decision : 20-02-2014

Acts Referred:

Trade Marks Act, 1999 — Section 9(2)(a), 11(1), 11(2)(a), 11(3)(a), 12, 18

Citation : (2014) 02 IPAB CK 0003

Hon'ble Judges : S. Usha, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Advocate : Sharmila Basu

Final Decision : Dismissed

Judgement

S. Usha, J

1. The instant appeal arises out of the order dated 30/08/2005 passed by the Deputy Registrar of Trade Marks, dismissing the opposition No. KOL-166848 and allowing the application No. 739760 in class 5 to proceed to registration under the provision of the Trade Marks Act 1999 (hereinafter referred to as the Act). The brief facts of the case are --

The respondent herein filed an application for registration of the trade mark "Hepatone" under No. 739760 in class 5 on 17/12/1996. The mark was claimed to be used since 13/03/1956. The said application was advertised in the Trade Mark Journal No. Mega 3 dated 14/10/2003 at page 88. The appellant herein opposed the said registration on various grounds.

2 . On completion of the pleadings, the Deputy Registrar heard both the parties and passed the impugned order dismissing the opposition and allowing the application for registration.

3. The Registrar held that the rival trade mark "Hepatone" and "Hepatoglobine" cannot be held to be deceptively similar. The prefix and suffix in the rival marks

are different and dissimilar. The applicants i.e. the respondents are using the trade mark "Hepatone" since the year 1956 and there has been no instance of confusion and deception and that they are entitled to claim protection under Section 12 of the Act. The impugned trade mark "Hepatone" consists of combination of two syllables Hepa + Tone whereas the appellant's trade mark "Hepatoglobine" consists of two syllables Hepato + Globine. There is no basis for the appellants objection as to proprietary right since the respondents have been using since the year 1956. There is no justifiable reason to exercise discretion adverse to the respondents and therefore registration was allowed.

4. Being aggrieved by the impugned order, the appellant has filed this appeal on the grounds that --

(1) the learned Registrar failed to consider that the appellants are the registered proprietors of the trade mark "Hepatoglobine" as of 25/08/1944 in class 5 under No. 4044 in respect of pharmaceutical preparations;

(2) the learned Registrar failed to consider the fact that the appellants have a vast organization all over India and have spent huge amounts towards advertisements of their products and have acquired reputation all over India and abroad;

(3) the learned Registrar failed to consider that the impugned trade mark is deceptively similar to the appellants registered trade mark "Hepatoglobine" which is prohibited under Section 11(2)(a) of the Act;

(4) the Registrar failed to consider that the marks are visually, structurally, phonetically and deceptively similar;

(5) the impugned trade mark being deceptively similar is likely to cause confusion and is therefore prohibited registration under Section 11(1) of the Act;

(6) the respondents use would result in passing off their goods as those of the appellants and is hence prohibited under Section 11(3)(a) of the Act;

(7) the impugned mark is prohibited from registration under section 9(2)(a) of the Act as it is of such a nature so as to deceive the general public and cause confusion in the minds of the public;

(8) the respondents are not the proprietors of the trade mark and hence the mark is prohibited registration under section 18 of the Act;

(9) the application for registration has been made in the year 1996 claiming user since 1956 after a delay of 40 years clearly shows the intention of the respondents;

(10) the impugned order is bad in law and in fact is liable to be set aside.

5 . The respondents filed their vakalath through their counsel from Bureau of Patents and Trade Marks on 23/02/2012. The notice was served for the subsequent hearings on the respondents. The respondents, till the date of

hearing have not filed their counter statement nor have they appeared before the Board. The Board therefore set the respondents ex-parte and proceeded to hear the appellants.

6. We heard Ms. Sharmila Basu, counsel for the appellant.

7. The learned counsel for appellant submitted that the rival marks are "Hepatone" and "Hepatoglobine" which are deceptively similar and are likely to cause confusion and deception among the public. The appellant adopted and used the trade mark "Hepatoglobine" since 1942 continuously and extensively. The respondents adopted and used the trade mark "Hepatone" impugned herein only since 1956 which is subsequent to the appellants. The counsel relied on certain advertisements which had a mentioning that - "Tried & time tested for 75 years". Based on this the counsel submitted that it was used for more than 75 years. The counsel finally submitted that the impugned registration ought not to be granted as the appellants rights are to be protected.

8. We have carefully considered the appellants arguments and have gone through the pleadings and documents.

9 . The rival marks are "Hepatone" and "Hepatoglobine". The main grievance of the appellant is that they are prior user of the trade mark "Hepatoglobine" since 1942 and they had been using the mark extensively and continuously. On perusal of the records it is seen that the appellants have filed their drug license No. 3/59 dated 14/11/1959 issued by the Director of Drugs Controller for the drug "Hepatoglobine". The other documents are the Trade Marks registration certificate, few advertisements, few price lists etc. The drug manufacturing license is of the year 1959 and therefore only after the grant of license the appellant could have manufactured and sold the product in the market. The appellants have not filed any evidence to prove their use since 1942. If at all the appellants have used the trade mark it could be only from 1959 and not earlier. We are aware that in an opposition proceedings it is for the applicants i.e. the respondents to prove their case. The respondents are not before us to satisfy the same and therefore the trade is on the appellants. Here it is the appellant's case that there will be confusion if registration is granted and that apart their use is prior to that of the respondents. The appellants have not satisfied us their claim in any manner.

10. The advertisements relied on by the appellants to say that they had been using the trade mark for more than 75 years do not seem to help them as we do not find any date in the advertisement to calculate the date of use. The advertisement also does not prove their user as claimed by the appellants since 1942. User means actual use by producing invoices, bills etc. It is not the case of the appellants the medicine bearing the rival trade mark is for the same ailment.

11 . The rival trade mark i.e. the appellants trade mark "Hepatoglobine" and "Hepatone" of the respondents are not similar either visually or phonetically in any manner. When we have considered the marks not to be similar, the

possibility of confusion and deception is not certainly present. The impugned trade mark for registration therefore, deserves to be allowed. Accordingly the impugned order is upheld and the appeal is dismissed with no order as to costs.