
(2006) 12 IPAB CK 0003

In the Intellectual Property Appellate Board

Sami Khatib

APPELLANT

Vs

Optho Remedies Pvt. Ltd. And Anr.

RESPONDENT

Date of Decision : 29-12-2006

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 11, 12(3), 18(1), 131
Trade Marks Act, 1999 — Section 100
Code Of Civil Procedure, 1908 — Order 13 Rule 2

Citation : (2007) 34 PTC 357 (IPAB)

Hon'ble Judges : Z.S. Negi, J;S. Usha, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

S. Usha, Technical Member

1. The first respondent filed an application on 18.8.1986 for registration of a trade mark B-Tone in respect of medicinal and pharmaceutical

preparation in class 5 under Application No. 458729 claiming user since 1977 under the provisions of the Trade and Merchandise Marks Act, 1958

(hereinafter referred to as the Act). The said application was advertised before acceptance in Trade Marks Journal No. 1075 dated 16.3.1994. On

15.3.1995 the first respondent herein had filed their counter statement. The appellant had filed certain documents including the trade mark registration

certificate of the trade mark 'R.B. Tone' registered under No. 280624B as of 2.6.1972. The first respondent filed their reply evidence in support of

their application. After completion of the formal procedures, the matter was heard by the Assistant Registrar of Trade Marks on 15.9.1998 and orders

were reserved. The opponent was represented by counsel and none appeared for the appellant. Meanwhile the applicant had taken out an

interlocutory petition on 18.3.1999 to consider and take on record the documents which were not filed earlier.

2. The Assistant Registrar had passed an order on 22.3.1999 disallowing the opposition No. DEL 8752 and accepting the application No. 458729 to

proceed to registration. The Assistant Registrar had disallowed the opposition stating that the adoption of the trade mark by the applicant, i.e., the first

respondent herein is honest and a concurrent use and the requirement under Section 12(3) of the Act was satisfied. The Assistant Registrar also held

that the marks were not identical. The Assistant Registrar proceeded further and held that the appellant's mark was registered in a peculiar manner

having the logo of Madley Labs which eliminates the chances of confusion. He further held that by long user of about nine years as on the date of

application the first respondent were justified to claim to be the proprietors of the mark in terms of Section 18(1) of the Act.

3. The appellant on receipt of the main order in opposition No. DEL 8752 to application No. 458729 - disallowing the opposition and accepting the

application for registration - had filed a review petition to review the order dated 22.3.1999 and to pass appropriate orders taking into consideration of

the new material facts which were filed along with the interlocutory petition and to take the evidence on record. The Assistant Registrar had

dismissed the review petition on 10.1.2000 with an observation that no interlocutory petition shall be maintainable after completion of the hearing in the

eyes of law as nothing remains interlocute after closure of the proceeding and final hearing. He also observed that no error apparent on the face of

record was there. The above orders dated 22.3.1999 and 10.1.2000 passed by the Assistant Registrar were under challenge before the Hon'ble High

Court of Delhi in CM (M) 180 of 2000 which has been transferred to this Board in terms of Section 100 of the Trade Marks Act, 1999 and

renumbered as TA/162/2003/TM/DEL.

4. The matter was taken up for hearing in the Circuit Bench held at New Delhi on 11.9.2006. Learned Counsel Shri Amarjit Singh appeared for the

appellant and learned Counsel Shri Mohan Vidhani appeared for the first respondent.

5. The learned Counsel for the appellant submitted that the appellants had adopted two trade marks namely R.B. Tone and 'ARBITONE' as early as

1972 and 1969 respectively and had been using the marks continuously without any interruption. He further submitted that the trade mark

'ARBITONE' was registered under No. 280624 as of 2.6.1972. Learned Counsel for the appellant drew our attention to paras 9 and 10 of the

affidavit of evidence in support of opposition, where the sale figures and the promotional expenses for the year from 1972-73 were given. Learned

Counsel for the appellant further contended that the first respondent had not disputed the sales figures given in the evidence affidavit.

6. The learned Counsel for the appellant mainly contended that he had taken out an interlocutory petition on 18.3.1999 for taking on record the

documents after the matter was heard and orders reserved which were not considered by the Assistant Registrar while passing the order. Learned

Counsel for the appellant submitted that the review petition filed against the order of the Assistant Registrar in the main opposition proceedings was

dismissed erroneously by the Assistant Registrar.

7. The learned Counsel for the appellant also contended that the Assistant Registrar had not considered his submissions and had passed an order

under Section 12(3) of the Act finding that the first respondent was entitled to have the mark registered. The learned Counsel for the appellant also

submitted that the Assistant Registrar had not considered the registration of the appellant as early as 1972 and had observed that the first respondent

had no knowledge of the appellant's mark as their mark was available only after 1980 and not prior to that.

8. The learned Counsel for the appellant relied on various judgments in support of his contentions. His main argument was based on the issue that the

Registrar had powers to grant time for filing evidence.

In *Madan Gopal Kanodia v. Mamraj Maniram* the Supreme Court has held that as per the provisions of Order 13 Rule 2 of the CPC, the Court has

powers to allow the production of documents if satisfactory reasons are given.

He relied on the judgment *Kantilal Tulsidas Jobanputra v. The Registrar of Trade Marks and Anr.* 1982 PTC 127 in support of his contention that the

Registrar was wrong in dismissing the application for review ignoring the facts that the petitioner had failed to file evidence because he was under a

misconception.

He relied on another judgment *Ramgopal Soap Factory v. Tata Oil Mills Co.*

Limited 2006 (32) PTC 292 (IPAB) to support his argument that the dismissal of the review petition on the ground of production of document after the hearing was unjustified.

In Collector, Land Acquisition, Anantnag v. Mst. Katiji and Ors. the Supreme Court has taken the view that liberal approach should be adopted to condone the delay in approaching the Courts.

In Asian Paints Limited v. Registrar of Trade Marks and Anr. 2005 (30) PTC 444 (IPAB) this Board has held that the powers of the Registrar under

Section 131 of the Act is not affected to grant extension in filing evidence in opposition.

9. With the above submissions, the appellant concluded his argument and prayed that the appeal be allowed by setting aside the orders of the Assistant

Registrar dated; 2.3.1999 and 10.1.2000.

10. The learned Counsel for the first respondent argued that the Assistant Registrar was correct in dismissing the main opposition and no erroneous

order was passed. He vehemently argued that the sales figures given by the appellant in the affidavit of evidence in support of opposition will not

prove the appellant's user without any documentary evidence.

11. Learned Counsel for the first respondent also denied the submission of the appellant that the sales figures of the appellants were not disputed and

drew our attention to para 16 at page 47 (internal page 3) of the affidavit of evidence filed in support of application wherein the first respondent had

called upon the appellant to produce the account books for inspection. He also submitted that as stated in the TM-6 the counter statement by virtue of

extensive user since 1977 the Trade Mark 'B-TONE' has acquired distinctiveness.

12. Learned Counsel for the first respondent further submitted that the registration of their mark 'B-TONE' is not violative of any provisions of the Act

and as such they are entitled for registration under Section 12(3) of the Act as honest concurrent user.

13. Learned Counsel for the first respondent relied on Judgment in Cadila Laboratories Ltd. v. Dabur India Limited 1997 (17) PTC 41 7 in support of

his contention that the prefix of the word should be given due weightage and importance in case the suffix is common.

The case of Biofarma and Anr. v. Sanjay Medical Store and Anr. 1998 (18) PTC (DB)the tests to be applied for determining the similarity between

the marks was also relied by the first respondent.

14. The learned Counsel for the first respondent concluded his arguments praying that the appeal be dismissed as the Assistant Registrar had rightly passed the order.

15. We have carefully considered the arguments of both the counsel and have gone through the pleadings and documents of both the parties.

16. We find that the appellant has filed this appeal praying to set aside the orders of the Assistant Registrar in the main opposition dated 22.3.1999 and

in the review petition dated 10.1.2000. On perusal of the order dated 22.3.1999 we do not find anything as regards the request made by the appellant

before the Assistant Registrar seeking adjournment for filing of documents. The same has also not been countered by the first respondent as they

were not present at the time of hearing. Moreover, orders were reserved on 15.9.1998, the appellant has produced the documents along with the

interlocutory petition only on 18.3.1999 after a period of six months. Apart from that the Assistant Registrar also seems to have passed an order on

22.3.1999 without dealing with the interlocutory petition. From the plain reading of the order dated 10.1.2000 in the review petition, it is clearly seen

that the Assistant Registrar was aware of the interlocutory petition as he had observed that ""the interlocutory petition was filed after the opposition

was heard and orders reserved and that after the hearing the matter stands closed. Therefore, any interlocutory petition filed after completion of

hearing is not maintainable under the eyes of law."" In the interest of justice and based on the principles of natural justice and on the settled proposition

of law laid by various High Courts and Supreme Court, the Assistant Registrar should have considered the documents. On this account, though the

Assistant Registrar had committed an error in not considering the documents, the question is whether the matter is to be remanded back to the Trade

Marks Registry to take a fresh look in the matter and decide in accordance with law or to decide the matter on merits by us. Taking into consideration

the time factor, as the application for registration has been filed as early as 1986, we are of the view that the matter can be heard and decided on

merits instead of remanding it back the matter which will only cause delaying the finality of the matter.

17. The main issue that arises for consideration is whether the marks are

identical or similar. The appellant's trade mark is 'R.B. TONE' and the first respondent's trade mark is 'B-TONE'. Except for the first letter 'R' both the marks are identical. There is absolutely no difference between the two marks when looked at side by side. As such phonetically also the marks are similar. The letter 'R' is silent at time when the mark pronounced in full- the mark 'R.B. Tone' and possibility of confusion will be there as the marks are visually and phonetically similar. Hence, we find that the marks of the appellant and the first respondent are deceptively similar and hence there is every possibility of confusion and deception.

18. The next issue for consideration is that whether the appellant's use is prior to that of the first respondent. On perusal of the documents i.e., the Trade Marks Registration Certificate for the trade mark 'R.B. Tone' with the renewal certificates filed alongwith the evidence in support of opposition, we find that the trade mark has been registered as of 1972 itself. Hence, we disagree with the statement of the Assistant Registrar that the appellant has not produced any document to prove their user prior to 1980.

19. As has been observed by the Supreme Court in the case of Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. for deciding the question of deceptive similarity, the following factors have to be considered:

- (a) The nature of the mark i.e., whether the marks are word marks or label marks or composite marks i.e., both word and label marks.
- (b) The degree of resemblance between the marks, whether they are phonetically, visually or structurally similar and hence similar in idea.
- (c) The nature of 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.
- (f) The mode of purchasing all the goods or placing orders for the goods, and
- (g) Any other surrounding circumstances.

These factors are to be considered with great care when the products are medicinal products.

20. The learned Judges have further observed as follows:

What is likely to cause confusion would vary from case to case. However, the appellants are right in contending that where medical products are

involved, the test to be applied for adjudging the violation of trade mark law may not be on a par with cases involving non-medicinal products. A strict

approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product with one another by the consumer.

While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between two medicinal products may

have a disastrous effects on health and in some cases life itself. Stringent measures should be adopted especially where medicines are the medicines

of last resort as any confusion in such medicines may be fatal or could have disastrous effect. The confusion as to the identity of the product itself

could have dire effects on the public health.

21. Based on the above principles, it is clear that undue care is to be taken in considering the confusion between two medicinal products. Remote

possibility of confusion is also ruled out in case of medicinal products. It is also the duty of the Court to approach the issue of confusion from the point

of view of a man of average intelligence and imperfect recollection. As held by the Apex Court, Courts must be careful in finding the dissimilarity

especially in medicinal products as human life is in danger if any mistake happens in a decision.

22. In the present case, we observe that the marks are identical except for the first letter "R". As such possibility of confusion and deception is very

much certain. The mark, therefore, does not qualify for registration as per Section 11 of the Act.

23. In view of the above, we consequently allow the appeal and reject the application No. 458729 for registration. There shall be no orders as to costs.