

(2010) 10 DEL CK 0223

In the Delhi High Court

Case No : Writ Petition (C) No. 11800 of 2005

Smt. Raj Wadhwa

APPELLANT

Vs

Glaxo India Ltd. and Others

RESPONDENT

Date of Decision : 05-10-2010

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 11, 12(1), 18(1)
Trade Marks Act, 1999 — Section 11, 33

Citation : (2011) 46 PTC 61

Hon'ble Judges : Dr. S. Muralidhar, J

Bench : Single Bench

Advocate : Ajay Amitabh Suman and Santosh Kumar, for the Appellant;
Anuradha Salhotra, Sumit Wadhwa and Doyel Sen Gupta, for the Respondent

Final Decision : Dismissed

Judgement

S. Muralidhar, J.—Aggrieved by an order dated 9th March 2005 passed by the Intellectual Property Appellate Board ("IPAB") dismissing her appeal, the Petitioner has filed the present writ petition.

2. The Petitioner filed an Application No. 429975 on 20th November 1984 for registration of the trade mark in the form of label consisting of the word "GOLDCON-D" in respect of infant foods including glucose in class 5 of the I Vth Schedule to the Rules framed under the Trade and Merchandise Marks Act, 1958 ("TM Act, 1958") claiming user since 27th May 1984. The application was advertised in the Trade Marks Journal No. 935 dated 16th May 1988 at page 195. Respondent No. 1 Glaxo India Ltd. ("Glaxo") gave notice of their intention to oppose the registration of the impugned mark on 14th July 1988 on the ground that it was violative of the provisions of the TM Act, 1958. On 20th March 1989, the Petitioner filed her counter statement and grounds in rebuttal to the objections of Glaxo. On 28th August 1989, Glaxo filed its evidence in support of the opposition. The Petitioner also filed evidence in support of the application.

3. The Assistant Registrar of Trade Marks rejected the Petitioner's application on

the ground that the impugned mark of the Petitioner i.e. "GOLDCON-D" is similar to the registered mark of Glaxo i.e. "GLUCON-D". After discussing the evidence filed by the parties, the Assistant Registrar concluded that "the use of the mark applied for is likely to deceive and cause confusion in the minds of the consumers in respect of the trade source. Hence registration of the mark applied for is prohibited by operation of Section 11(a) of the TM Act, 1958."

4. As regards the user of the mark, the Assistant Registrar noticed that the Petitioners had claimed user since 27th May 1984 but had not adduced evidence in support of such claim. Consequently, the claim of the Petitioner to be the proprietor of the mark in terms of Section 18(1) of the Act was negatived.

5. Before the IPAB it was contended by the Petitioner that GOLDCON-D is part of Petitioner's trading style, M/s. Goldcon Products. Further it was submitted that both visually and phonetically there was a lot of difference between "GOLDCON" and "GLUCON". Thirdly, it was contended that the suit filed by Glaxo against the Petitioner in the civil court at Dehradun was dismissed for default on 17th May 1988 and Glaxo did not take any steps for restoration of the suit. This implied that Glaxo did not have any case. It was further submitted by the Petitioner that no documents were produced by Glaxo to demonstrate the user of the mark prior to the Petitioner. Glaxo had only filed affidavits.

6. On comparing the marks, the IPAB concluded that GOLDCON-D was likely to cause confusion in the minds of the average consumer and deceive him into thinking that he was buying GLUCON-D. It was noticed that when goods are of the same description, Courts are expected to be careful in finding similarity and minute differences cannot be taken into account to find out the distinction between the two marks. The Petitioner's goods were infant foods including glucose whereas the Glaxo's registered trade mark was in respect of Glucose (for food), flour and preparation made from cereals, bread, biscuits, etc. The goods were of the same nature, composition and functions. The trade channel was also the same. The IPAB concluded that the prohibition u/s 12(1) of the Act was also attracted. As regards the claim of the Petitioner that the word "GOLDCON" is part of their trading style, the IPAB observed that there was no explanation for adding the letter "D" along with the mark.

7. Before this Court, Mr. Ajay Amitabh Suman learned Counsel for the Petitioner reiterated the submissions made before the IPAB. In addition, he urged that the dismissal of the suit filed by Glaxo against the Petitioner in the civil court in Dehradun followed by Glaxo's failure to have the suit restored, tantamounted to acquiescence by Glaxo in the use by the Petitioner of the impugned mark. Secondly it is submitted that in response to a legal notice issued to it by Glaxo, the Petitioner had replied in 1984 denying any infringement. For three years thereafter no action was taken by Glaxo. It was only in 1987 that a suit was filed. The suit was dismissed for default in 1996 and not restored. It is submitted that all the ingredients of what would constitute "acquiescence" within the meaning of Section 33 of the Trade Marks Act, 1999 (TM Act, 1999"), stood attracted.

8. This Court is unable to agree with the above contention of the Petitioner. The mere dismissal of a suit for infringement in 1996 cannot per se mean that Glaxo acquiesced to the use by the Petitioner of the trade mark in question. At the first available opportunity after the Petitioner's application was advertised for acceptance in the Trade Marks Journal on 16th May 1998, Glaxo filed its opposition on 14th July 1998. That opposition was upheld concurrently both by Assistant Registrar as well as the IPAB. It cannot be said in the circumstances that Glaxo acquiesced in the claim of the Petitioner as to use of the trade mark.

9. It is next contended that the Assistant Registrar as well as the IPAB erred in upholding the opposition of Glaxo that "GOLDCON-D" was similar to Glaxo's registered trade mark "GLUCON-D" and was likely to cause confusion when viewed from the standpoint of a man of average intelligence and imperfect recollection. It is submitted that in order to substantiate its opposition with reference to Section 11(a) it was incumbent on Glaxo to have filed documents by way of evidence. It is submitted that even the registration certificate was not produced. Further, learned Counsel for the Petitioner submitted that the registration was granted to Glaxo of "GLUCON-D" with a disclaimer as regards the letter "D". Therefore the comparison had to be made of only the words "GOLDCON" and "GLUCON", by omitting the letter "D". When so compared there was, according to the Petitioner, neither phonetic nor visual similarity. He relied upon the judgments in *J.R. Kapoor v. Micronix India*, 1994 (14) PTC 260 (SC), *F. Hoffmann-La Roche and Co. Ltd. v. Geoffrey Manners and Co. Pvt. Ltd.*, PTC (Supp) (1) 88 (SC) and *Hindustan Pencils Private Ltd. v. Universal Trading Co.*, 2000 PTC (20) 561(Del)(DB).

10. This Court is not impressed by the submission that there is no visual or phonetic similarity when the Petitioner's impugned mark "GOLDCON-D" is compared with Glaxo's registered mark "GLUCON-D". The structural similarity of a word followed by a hyphen and alphabet "D" in both marks is unmistakable. The Petitioner is also not correct about having to leave out the disclaimed part of the mark for the purposes of comparison. The marks have to be compared as a whole and cannot be dissected to leave out the disclaimed part. Recently in *Takkar (India) Tea Co. v. Soongachi Tea Industries Pvt. Ltd.* 2010 VII AD (Del) 104 this Court had occasion to deal with a similar contention. The following passage in *Granada Trade Mark* (1979) 13 RPC 303 at page 308 was taken note of:

I do not think, therefore, that a disclaimer per se effects the question of whether or not confusion of the public is likely when that question is for determination u/s 12(1), a context other than one that is concerned solely with the exclusive rights of a proprietor. As Lloyd-Jacob, J. put it in *Ford-Works Application* (1955) 72 R.P.C. 191 lines 30 to 38, a disclaimer does not affect the significance which a mark conveys to others when used in the course of trade. Disclaimers do not go into the market place, and the public generally has no notice of them. In my opinion matter which is disclaimed is not necessarily disregarded when question

of possible confusion or deception of the public, as distinct from the extent of a proprietors exclusive rights, are to be determined. In making the comparison u/s 12(1) therefore I consider that I must have regard to the whole of the opponents mark, including the disclaimed matter, and must assume use of it in a normal and fair manner for, inter alia, the applicants goods. The applicants are very well known as manufacturers of motor cars. The opponents are registered as merchants of their goods. Although the opponents are not manufacturers of motor cars I do not think that this difference in the parties activities should lead me to make the required comparison on any basis other than that, so far as identical goods are concerned, the normal and fair manner of use of the marks would also be identical.

(emphasis supplied)

11. Even if one were to take up only "GOLDCON" and "GLUCON" for comparison, it is not possible to accept the contention of the Petitioner that they are dissimilar and are unlikely to cause confusion in the mind of the average consumer with imperfect recollection. The IPAB was right in observing that the nature of the goods in respect of which the marks are used as well as the trade channel were similar.

12. It was never the Petitioner's case either before the Assistant Registrar or the IPAB that Glaxo's mark was not registered. Even before this Court, the Petitioner contended that the registration for GLUCON-D was granted with a "disclaimer as to the letter "D". As against the registered mark of Glaxo, the burden was on the Petitioner to show that for the purposes of Section 11(a), its impugned mark "GOLDCON-D" bore no similarity with the registered mark "GLUCON-D" of Glaxo. In the considered view of this Court, the Petitioner has not been able to discharge the burden. This Court affirms the concurrent views expressed both by the Assistant Registrar as well as the IPAB that Section 11(a) of the TM Act, 1999 stood attracted in the present case and that the registration of the mark applied for ought to be refused to the Petitioner.

13. Learned Counsel for the Petitioner submitted that the Petitioner's use of "GOLDCON-D" was both honest and concurrent. In order to substantiate the claim of honest user, it was suggested that "GOLDCON" was part of the Petitioner's own trading style since its proprietary concern was M/s. Goldcon Products. The letter "D", according to learned Counsel for the Petitioner, referred to a place, in this case "Dehradun", from where the Petitioner was operating. In the considered view of this Court, the above explanation is hardly convincing. It does appear to this Court that the Petitioner has not been able to show that its user of the mark "GOLDCON-D" was honest.

14. In that view of the matter, this Court finds no error in the order of either the Assistant Registrar or of the IPAB that calls for any interference. The writ petition is dismissed.