
(1998) 12 GUJ CK 0100
In the Gujarat High Court

Case No : O.J Appeal No. 11 of 1993 in Appeal Under Section 109 No. 1 of 1992

Torrent Laboratories Ltd.

APPELLANT

Vs

Ciba-Geigy Ltd.

RESPONDENT

Date of Decision : 08-12-1998

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 109(5), 11, 12(1), 18(1), 48

Citation : (1998) 12 GUJ CK 0100

Hon'ble Judges : Rajesh Balia, J;Anil R. Dave, J

Bench : Division Bench

Advocate : R.R. Shah and Harshil R. Shah, for the Appellant; A.R. Lall and G.N. Shah, for the Respondent

Final Decision : Allowed

Judgement

R. Balia, J.—This appeal is against the judgment and order of the learned Single Judge dated 5/6-5-1992 of this court in appeal No.1 of 1992 u/s 109(5) of the Trade and Merchandise Marks Act, 1958 (‘Act of 1958’) by which registration of trademark ‘ULCIBAN’ granted in favour of the appellant was set aside on appeal by the respondent company.

2. The appellant- Torrent Laboratories Limited had filed an application for registering ‘ULCIBAN’ as its trade mark under the Act of 1958 on 5.6.1984 which was advertised before acceptance u/s 20 in Trade Mark Journal No.925 dated 16.12.1989. The respondent CIBA Geigy Limited, a foreign company, filed notice of opposition inter alia on the ground that it was a registered proprietor of trade mark ‘CIBA’ and several other trade marks comprising trade mark ‘CIBA’ for specification of the goods medicinal preparations, pharmaceutical and veterinary preparations, sanitary chemical substances, disinfectants, preparations for killing weeds and destroying vermin. They are using the trade marks in India through their licensee Hindustan Ciba-Geigy and step for registration of registered user of the same has also been taken and the application is pending before the Trade mark registry. Ciba forms the fore-part

and most distinctive and prominent feature of the plaintiff's corporate name and trading style. The opposition was founded on the ground that other mark 'ULCIBAN' comprised of two prominent features 'ULCI' and 'BAN' and is identical to the use to their trade mark. Registration of the appellant's mark is likely to cause confusion and deception amongst the trade and public who would assume that it was yet another mark of the opponent. Opposition was under sections 9, 11(a), 11(e), 12(1) and 18(1) of the Act of 1958. Before the Registrar, opposition u/s 12(1) was abandoned and was confined to sections 9, 11(a), 18(1) and 11(e).

3. While there was no dispute about the fact that the opponent-respondent is registered proprietor of mark 'CIBA' and other marks using the letters 'CIBA' with respect to various commodities, more particularly referred to in the application viz. CIBA, CIBAZONL and CIBALGIN. The question was of the proprietary interest of the appellant in the word 'ULCIBAN' and its eligibility u/s 9.

4. It was found by the Registrar in his order dated 15.5.1991 that mark 'ULCIBAN' is comprised of two prominent features 'ULCI' and 'BAN'. The commodity in question is medicinal preparation of Cimetidine used for the purpose of treating patients suffering from ulcer. The word ULCI is referable to ulcer and BAN is referable to obstruct, that is to say- the applicant invented new word ULCIBAN by denoting its preparation in combating disease of ulcer by joining two words 'ULCI' and 'BAN'. Therefore, it was eligible for registration subject to other conditions u/s 9(1)(c) as the appellant had invented this word. It was found to be proprietor of this word. This finding was not disputed in appeal. The Registrar found that though letters 'CIBA' are included in the impugned mark but that could not be pronounced independently and, therefore, did not occupy any prominent position in the impugned mark 'ULCIBAN' and that registration of impugned mark of the respondent was not likely to cause any confusion or deception because the word CIBA in the impugned mark cannot be pronounced independently. Upon this reasoning, the Registrar held that there is no likelihood of deception or confusion in terms of section 11(a) of the Act of 1958 by the use of word ULCIBAN as trade mark. Thus, he overruled the objections and having found the plaintiff's mark eligible for registration and of proprietorship of the mark, allowed the application by rejecting the opposition after incorporating the amendment in the specification of goods as suggested by the applicant, so as to read "medicinal and pharmaceuticals preparation containing 'CIMETIDINE' and to be sold on the written prescription only.

5. Aggrieved with the aforesaid order, the opponent has filed appeal before this court.

6. The only contention raised before the learned Single Judge on behalf of the appellant was that the appellant was registered proprietor of CIBA and other series of marks containing the word 'CIBA' which was the most significant feature in the opponent's trade mark. CIBA of India was recorded as registered

user from the year 1964 and CIBA of India as well as its successor Hindustan Ciba-Geigy were using their trade marks and the product like CIBAZOL was sold in India by its registered user. As the applicant had tried to obtain registration of the impugned mark ULCIBAN containing the word 'CIBA' from which it should be inferred that the attempt to get registration of the impugned mark was a dishonest one and the Registrar in his discretion ought to have refused the application u/s 18(4) of the Act as the same is likely to cause confusion and deception in the minds of average buyers of the goods.

7. In countering the contention of appellant- opponent apart from urging that the impugned mark ULCIBAN if compared as a whole, the same is not likely to deceive or cause confusion, amongst buyers or public, it was urged that there was no user of trade mark CIBA, CIBAZOL or CIBALGIN by the opponent and the user by opponent's licensee Hindustan CIBA GEIGY cannot be deemed to be the user of the opponent who was the proprietor of the trade mark in view of provisions of section 48(2) of the Act of 1958. The only assertion in the notice of opposition being that application for registering Hindustan CIBA Geigy as a registered user, has been made and there being no assertion nor any material to suggest that Hindustan Ciba Geigy has been registered as a registered user in view of section 48(2), use of trade mark by Hindustan Ciba Geigy cannot enure for the benefit of proprietor as to its use and it cannot result in acquisition of any goodwill in the mark in the trade circles or market so as to cause likelihood of confusion in the public mind .

8. The contention of the applicant about non-user of the proprietary mark by the opponent was overruled by the learned Single Judge by holding that even where there is no use for 5 years, the protection to the rights of the proprietor of the registered trade mark are not automatically taken away and the procedure u/s 46 for removal of the trade mark from Register has to be undergone. Until that is done, there is presumption about the validity of the registration of trade mark u/s 31(1). The mere fact that application for registering licensee of the proprietor as a 'registered user' is not granted, despite lapse of several years by the concerned authority and which has remained pending will not create any right in favour of the applicant-respondent to get a mark registered if it falls within any of the prohibitions enumerated in section 11.

9. The learned Single Judge also found that the material on record established connection of registered proprietor of trade mark ,Ciba Geigy , with the goods which were marketed in India and it can never be said that there was no actual use of those trade marks by the proprietor. On merits of the issue whether the impugned mark was likely to cause confusion and deception in public and trade, the learned Judge was of the opinion that the Registrar has erred in oversimplifying the matter by splitting the impugned mark ULCIBAN into two parts which he called prominent features namely ULCI and BAN and holding that having split the word into two parts, it was not possible to pronounce the word 'CIBA' which lost its identity by virtue of such splitting up.

10. The learned Judge was further of the opinion that the word CIBA is not descriptive of the goods nor is it a commonly used word in the trade and, therefore, its use in the impugned mark cannot be defended on that ground. Visually, the word `CIBA" appearing in the impugned mark ULCIBAN because of its distinctiveness as common element with the registered trade mark CIBA cannot but attract attention. Referring to glossy pamphlet containing trade literature on which mark `ULCIBAN" is prominently written in the lower half and which is also written in the middle on the left side, on the second and third pages again, the impugned mark ULCIBAN is prominently written at the top and at the bottom on both the pages. In any of these three pages, there is no reference to the fact that the said mark belongs to the applicant. On the last page at the top, the impugned mark is written prominently and it is only at the bottom there is a writing "For further information please write", below which the name of the applicant is printed. Even at that place, it is not written that the product is of their own. In the prominently written impugned mark, the word `CIBA" stands distinctive by virtue of its being registered trade mark of the petitioner, would attract the attention of the reader.

11. On these findings, the learned judge found that applying ocular test, by comparing the mark with series of marks by the opponent would make it appear as if that trade mark also belongs to the family of marks of the proprietor-appellant before it and the confusion as to the origin of goods would be inevitable leading one to believe that they come from the same source. Phonetically also, the learned Judge was of the view that the sound of the word CIBA is quite distinct and would be likely to cause confusion or to deceive one to believe that the impugned mark is in respect of a product coming from the same source bearing the trade marks CIBA, CIBAZOL or CIBALGIN. What weighed with the learned Judge is that common element has to be identified in the impugned mark and the registered trade mark and if such common element is highly distinctive and is not just a description or a commonly used word, the likelihood of deception or confusion would be very much there despite the fact that it may not constitute part of the first syllabus of the impugned mark. The fact that the goods under the impugned mark and under the registered trade marks belong to the same specie of pharmaceutical and medicinal goods makes deception or confusion more likely to occur. On these findings, the learned judge concluded that it is clear that the impugned mark is likely to cause deception or confusion in the trade and the public having regard to resemblance that it bears by virtue of incorporating within it the highly distinctive part CIBA which is the registered trade mark of the proprietor-appellant and therefore, the proposed mark cannot be registered as a trade mark of the applicant. The learned Judge also opined that the Registrar ought not to have exercised his discretion u/s 18(4) of the Act even on the ground that applicant had tried to dishonestly use the impugned mark in view of the fact that it was in the same business and was well aware of the opponent's registered trade marks CIBA, CIBAZOL AND CIBALGIN. As noticed earlier, he placed stress on the not indicating in the pamphlet that the

product bearing the impugned mark ULCIBAN was manufactured by respondent No.1 (appellant) and it is only mentioned in a comparatively small print at the bottom that, for further information, one may write to respondent No.1. With these findings, the order of the Registrar was set aside. Opposition of opponent was allowed and the application of the present appellant for registration of its mark was rejected. The order is under challenge in this appeal.

12. We have heard the learned counsel for the parties. It has been urged by Mr. Shah, in the first instance, that as the decision relies on likelihood of causing confusion in the mind of average buyer of the product with whom the appellant's mark is likely to cause confusion, it is precondition that the opponent establishes user by them of their mark in India, where the goods manufactured by the applicant are to be marketed under impugned mark. User which would justify comparison for the purpose of finding out whether there is likelihood of causing confusion or deception by use of the impugned mark, must be legal user either by the proprietor of the mark or by registered user. The contention proceeds with its reasoning that registered proprietor of the mark CIBA is respondent Ciba Geigy Limited (a foreign company). , it does not itself market any product in India. What is alleged in the notice of opposition is that request of the opponent was filed on 2.12.1991 for recording Hindustan CIBA Geigy as registered user of the said trade mark CIBA and all other marks. However, said Indian company has not been yet recorded as registered user. Until such registration ,use of the mark by said Indian company itself is not lawful and cannot be recognised as use by the proprietor. Such unlawful use cannot be of any avail by the opponent.

13. User of mark for the purpose of creating goodwill in it in the market must be user either of the proprietor himself or by registered user as u/s 48(2). Only use by the registered user can be considered to be permitted use of the registered mark which alone can be considered use of trade mark by the proprietor. Use of trade mark by a person even if he be licensee unless recognised as registered user, is unauthorized use of the mark and necessary consequence must be to assume that mark has not been legally used at all. The learned counsel relied on the decision of the Supreme court in Cycle Corporation of India Ltd. Vs. T. I. Raleigh Industries Pvt. Ltd. and others, .

14. The finding which has been recorded by the learned Single judge is only in respect of regular use by CIBA of India ?td, predecessor of Hindustan Ciba Geigy India Limited which, according to the affidavit dated 17.2.1989 of Dineshchand C.Shah filed on behalf of Hindustan Ciba Geigy in support of opposition was recorded as registered user upto 17.2.1970. Application for recording Hindustan CIBA GEIGY as rgistered user was made only on 14.10.1971. In these circumstance, it is urged that there is no lawful use of the opponent's mark in India. That being so, there could be no reputation or goodwill of the marks CIBA in Indian market vis-a-vis source of goods so as to draw comparison with the impugned mark for the purpose of finding out whether its user is likely to cause confusion with the user of existing mark in the trade circle or general public.

15. Mr. Lall appearing for the respondent urged that Hindustan Ciba Geigy which is successor company to Ciba of India Limited and the respondents have already entered into agreement authorising Indian company to market its goods under the trade marks owned by the respondent and application as required u/s 49 has been made way back in 1971. The fact that for one reason or the other, the competent authority has not been able to decide that application so far cannot render use of trade mark by Indian company which has duly been authorised by the proprietor cannot be considered unauthorised so as to denude proprietor of registered trade mark from benefit and rights attached with the mark and from protecting the same. He also urged that even assuming that there has not been any authorised use of the mark in Indian market, it does not denude proprietary interest of the owner until the mark remains on the register of trade marks and he would be entitled to oppose registration of other marks which is likely to cause confusion with such mark and affect its future user. In such event, remedy of other persons desirous of using identical or similar marks is to make an application for striking it out by way of rectification application u/s 56 read with section 46 of the Act of 1958.

16. We may, at the outset, clarify that the contention of Mr. Shah for the appellant is not that registered proprietor of the trade mark has become liable to be removed from the register. His contention is limited for considering what should be the criteria in reaching the conclusion whether impugned mark when used is likely to cause confusion with the existing mark which is already in use. That, according to him, necessarily depends on actual user because unless there is actual user of the mark as such is current in the market and the buyer can connect the product coming in the market, legitimately with the proprietor of the mark, there is no room for comparing the impugned mark with the mark which is unused, to find out whether use of impugned mark by the applicant is likely to cause confusion in mind of an average buyer, a person having imperfect recollection of the essential features of the mark. The test presupposes exposure of the mark to the imperfect recollection of buyer with which the mark of the applicant is to be compared, as lawfully connecting with the source of such goods.

17. It would be apposite here to reproduce section 48 of the Act of 1958:

"(1) Subject to the provisions of section 49, a person other than the registered proprietor of a trade mark may be registered as the registered user thereof in respect of any or all of the goods in respect of which the trade mark is registered otherwise than as a defensive trade mark; but the Central Government may, by rules made in this behalf, provide that no application for registration as such shall be entertained unless the agreement between the parties complies with the conditions laid down in the rules for preventing trafficking in trade marks.

(2) The permitted use of a trade mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 46 or for any other purpose for which such use is material under this Act or any other law."

18. The primary object of this provision, as is apparent in sub-section (1), is to prevent trafficking in trade mark and to protect proprietary interest of the owner of the registered trade mark as such. The provisions have to be read in that context. It would be pertinent, before considering this case in some details, to notice that a Division Bench of Delhi High court in K.R. Beri and Co. Vs. The Metal Goods Manufacturing Co. (P) Ltd., had opined that it is not possible to accept the contention that even without the use by a registered user of the trade mark, use by any person can be equated as a use by the proprietor, if it is with the latter's consent. If this argument was to be accepted this will make the provision of section 48(2) more or less otiose and superfluous. It is well settled that superfluity cannot be attributed to legislature. When the legislature is creating a fiction by means of section 48(2) to equate the use by a registered user only as that of proprietor, the court cannot ignore this mandate of the legislature and hold that the use of trade mark by an unregistered user can be equated to the user by the proprietor. This construction was founded on the definition of 'permitted use' expressed in section 2(m) of the Act, which defines 'permitted use' in relation to a registered trade mark to mean the use of trade mark by a registered user of the trade mark in relation to goods with which he is connected in the course of trade...and which complies with any condition or restriction to which the registration of trade mark is subject to.....

19. This principle has not been wholly approved notwithstanding finding it to be in tune with strict construction by the apex court in Cycle Corporation of India.

20. In the "Cycle Corporation" case, the facts were that Raleigh Industries of U.K. was under an agreement with one Sudhir Kumar Sen to render technical know how to the Indian company to be formed which would manufacture bicycles and market them under Raleigh's Indian Trade marks. Sen Raleigh the Indian company that was formed, was permitted users of the trade marks for marketing bicycles and other products. The management was taken over in 1975 under the IDR Act by the Government. The agreement dated 29.12.1962 was modified and the Indian company was given option to terminate the agreement. Agreement dated 20.12.1976 came into existence which extended the period of user by Indian company for a period of five years. Sen Raleigh was thereafter nationalised. No new agreement came into existence between the Cycle Corporation of India in which Sen Raleigh was vested and registered proprietor of mark or with registered user of mark, though Cycle corporation continued to manufacture and pass on goods manufactured by it under the trade mark under which Sen Raleigh was marketing its products. In these circumstances, Cycle Corporation moved an application for rectification for removing the trade mark in question from the register of marks on the ground of non user. Like contention as has been pressed before us was raised, that is to say use of the mark by Cycle Corporation of India could not be considered a use by the proprietor at all, resulting in non user of mark by the proprietor.

21. The court rejected the contention holding that there is no specific bar for an

unregistered licensee to use registered trade mark so long as there is a connection in the course of trade between the licensor and the licensee. The legislature did not intend to register proprietor to be deprived of their property at the instance of user whose use is unregistered. The expression, therefore, should not be restricted to user by the proprietor himself or any registered user but should also take into account bona fide authorised user.

22. The court went on to explain it by stating that there must be real trade connection between the proprietor of the trade mark and licensee of the goods and the intention to use the trade mark must exist at the date of the application for registration of trade mark and such intention must be genuine and bona fide and continue to subsist in order to disprove the charge of trafficking in trade mark. With this object in view, the court commented on decision of the Delhi High court in K.R. Beri (supra) and observed:

"We have given anxious consideration to the reasoning therein. On strict interpretation, the view of the Division Bench may be correct but it is correct to hold that by a bona fide user of an unregistered user when connection between the proprietor or the trade mark and the permitted user in relation to passing off the goods under the trade mark are proved, it does not render sub-section (2) of section 48 surplusage or otiose."

23. The aforesaid decision clearly goes to show that merely because use of mark is by a person other than registered proprietor and is not by registered user, within the meaning of section 48(2), it cannot be kept out of consideration for all purposes, more particularly, u/s 46 where foundation for action for rectification is non-user by the proprietor. Whether such use can enure for the benefit of registered proprietor would depend upon the fact whether use by non-registered user is by way of trafficking in trade mark or on account of real trade connection that may exist between the proprietor of the trade mark and licensee so as to make it genuine and bona fide authorisation of the use of the trade mark.

24. The question arises about probability of deception or confusion within the meaning of section 11(2). It must be decided in the context of certain factual background. It is existence of factual background about reputation of the mark in connection with trading style connected with origin of goods. After comparing the applicant's mark with such existing state of affairs one has to reach the conclusion whether there is likelihood of deception or confusion when the impugned mark comes into market. In the present case it cannot be said that opponent CIBA has failed to establish such reputation in connection with its mark. It is also not in dispute that opponent is proprietor of registered trade mark CIBA, CIBAZOL and CIBALGIN to which word 'CIBA' denotes the name of the company and is used as prefix of its products. It is also not in dispute that in India, medicinal products under those names were marketed and being marketed since about 1964. It is also not disputed that Indian predecessor of the present user was a registered user of the trade mark owned by the opponent-respondent and they had marketed the goods under that name until February 1970. It is not

in dispute also that Hindustan Ciba-Geigy came into existence in succession to CIBA India Limited and is marketing those very goods under the same trade mark. It is also not in dispute that trade agreement to use the mark exist between the proprietor company and the Indian company in succession to CIBA India Ltd. and application for recording it as registered user since October 1971 is pending. Existence of real trade connection between the two in relation to goods in respect of mark cannot be doubted. It is nobody's case that the application has been rejected. In these circumstances real trade connection between the proprietor of trade mark and Hindustan Ciba Geigy and in respect of the goods marketed by Hindustan Ciba Geigy and others, in the trade name of the respondent-opponent is genuine and bona fide. Actual user of mark in the marketing the goods referable to its trade origin cannot be denied. As has been noticed , according to the Apex court, such user by licensee though he may not be registered user would not render proprietor liable to lose his right in the mark. It, however, goes to suggest that user of the mark by such licensee with real trade connection does not amount to illegal or unauthorized use of market zone not to be considered for the purpose of finding out whether reputation on that aspect has been made in the market or not. Therefore, the first contention of the learned counsel for the appellant that there is no factual background for comparing impugned mark with the mark of the opponent-respondent must fail.

25. The question now arises for our consideration is what is the probability of confusion likely to arise when the proposed mark is used in fair and normal manner against the factual background of the effect of use of objector's mark CIBA.

26. The test which has been recognized as accurate statement of law has been stated by Evershed, J in Smith Hayden's case (1946) 63 RPC 97 in the following terms:

"Having regard to the reputation acquired by user of the opponent's mark, is the court satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

27. Likelihood of deception or confusion has to be considered amongst class of buyers of the goods in question and not amongst the public at large. Before embarking upon inquiry as to the merits of the contentions raised before us, it would be profitable to refer to some of the general principles governing such inquiry keeping in view that both the marks in question are word marks. Each of the marks consists of one word. Each of the marks has multiple and not micro syllable. Mark CIBA is referable to the company's name not manifested in specific or particular manner and according to affidavit of Dr. Erich A Horak 'mark CIBA' forms the fore part of his company's corporate name. Trade Mark CIBA also forms the prefix of many registered marks of the company such as CIBAZOL, CIBALGIN". Whereas the mark which is proposed to be registered is

invented word with reference to the medicinal preparations used for treating ulcer and that whole of mark CIBA form middle part of the proposed mark ULCIBAN.

28. Nature of deception or confusion may usually arise either in relation to goods or in relation to trade origin or in relation to trade connection. A person may buy goods pertaining to one group thinking that it is brand which comes in his mind which in fact is not the case. This may result in deception or confusion, as to goods. A person looks at the mark and buys the goods thinking that it is coming from the same source as some other goods bearing a similar mark which he is familiar with. This is deception or confusion as to trade origin. The third type of deception or confusion that may come into existence or is likely to come in existence in a situation where a person looking at the mark may not think that it is the same as the one with a different brand in his mind but the similarity may make him believe that the two are in some way or other connected with each other. This is in area of deception or confusion, concerning trade relations.

29. What should go in addressing the question about comparison of two competing word marks, Justice Parker in *Pianortist Application*, (1906) 23, RPC, 774 says :

"You must take the two words. You must judge of 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 trade marks 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 confusion- that is to say, not necessarily that one man will be injured and the other will get illicit benefit but that there will be 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".

30. This principle has been approved by the Supreme court in *Amritdhara Pharmacy Vs. Satyadeo Gupta*, and *F. Hoffmann-la Roche and Co. Ltd. Vs. Geoffrey Manner and Co. Pvt. Ltd.*, . This rule makes it clear that while considering the likelihood of deception and confusion both ocular and phonetic tests for comparing two marks are relevant consideration, keeping in view the nature and kind of customer.

31. Another cardinal principle where one mark contains the whole of the other, is to be considered whether individuality of the common part is lost or whether the common part stands out prominently. In other words, if the proposed mark contains whole of the existing mark, the question to be considered ought to be whether the proposed mark absorbs the existing mark within itself so as to lose its individual identity or it projects out prominently not giving its own individuality.

32. In comparing two word marks to find out what is the essential feature of the mark in use and the mark proposed to be used, the first syllable provides an important guideline which is of utmost importance in the word mark.

33. It is considered that the first syllable of a word mark is generally considered the most important part, especially in the case of short words. Letters which precede the termination are the letters upon which an intending purchaser must always rely and to the accuracy of which he must always direct his attention. This principle was adhered to and enunciated by Eve, J. in *British Drug House Ltd.'s Trade Mark* (1913) 30 R.P.C. 73 (Ch.D)

34. Same principle has been applied to the words used as prefix or suffix as they occupy distinct place in formation of the words. Though as a rule, it cannot be said that in any circumstances, middle or trunk of the words can never have essential feature or prominent features of the words. But ordinarily, unless it spells out prominently, it merges its identity with the prefix or suffix, syllables and letters.

35. A reference in this connection may be made to the case of *Fox's Application* (1920) 37 RPC 37 where two component parts were Motrate and Filtrate. The terminate part of the word 'trate' was common. It was observed that in considering polysyllabic marks, the first syllable is of more importance. The word 'trate' not denoting any part, two words were found to be not similar.

36. So also where there is a common denominator in looking at the competing mark, much more regard is to be paid to the parts of the marks that are not common. If in such comparison, the common element strikes out emphatically, then likelihood of confusion may be inferred, but not otherwise. It must depend upon the relative emphasis and importance of the common word in relation to impugned mark as a whole. This requires consideration, where imperfect recollection is relevant, how far the additional word is significant to prevent the imperfect recollection from resultant confusion. One cannot be presumptive that additional words or letters used are superfluous or insignificant. Enquiry ought not to commence from that point.

37. As we are concerned with pharmaceutical and medicinal preparations, it is also to be kept in view that provisions of the Drugs and Cosmetic Act and the rules framed thereunder impose restrictions on the sale of medicinal preparations and are relevant for determination of the probability of confusion as they constitute circumstances surrounding the mark. The question whether the goods are sold only by registered dealer and that it would not be available in any shop and that it will be sold only under prescription of a doctor are relevant considerations in relation to probability or likelihood of causing deception or confusion by creation of any word mark. In *F. Hoffmann-la Roche and Co. Ltd. Vs. Geoffrey Manner and Co. Pvt. Ltd.*, their Lordships were concerned with the question whether the word DROPOVIT is deceptively similar to the word 'PROTOVIT'. The court said- the provisions of the Drugs Rules 1945 are also

relevant. Under rule 61(2) vitamin preparations would be covered by item 5 in Schedule C (1) to the rules and a licence would be required to stock such vitamin preparations and to sell them retail. The question of confusion must hence be determined on the basis that the goods with one of the two rival, trade marks would be sold only by such a licensed dealer and would not be available in any other shop. The fact that the vendor would be a licensed dealer also reduces the possibility of confusion to a considerable extent.

38. The courts have also deprecated the practice of dissecting the words piece by piece and to draw comparison to find out whether one resembles the other in such a manner which is likely to cause deception or confusion in the mind of public who are to use such goods. In the case of Roche and company, (supra) the Supreme court held that-

"It is also important that marks must be compared as a whole. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark."

39. The court quoted with approval the dictum of Lord Johnston in Tokalon Limited vs Davidson and company 32 RPC 133:

" We are not bound to scan the words as we would in a question of comparatio literarum. It is not a matter for microscopic inspection but to be taken from the general and even casual point of view of a customer walking into a shop."

40. The Supreme court in Corn Products Refining Co. Vs. Shangrila Food Products Ltd., said:

"The question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the court to decide that question. English cases preceding on the English way of pronouncing an English word by English men, which is not always the same, may not be of much assistance in our country in deciding questions of phonetic similarity. It is well recognized that in deciding a question of similarity between two marks, the marks have to be considered as a whole."

41. The window through which comparison is to be visioned is decision of man of average intelligence and of imperfect recollection.

42. The principle that more often than not, the question whether two marks are likely to give rise to confusion or not is a question of first impression which the court must decide has been amply stated by Whitford J. in Stuart vs. Ron (1981) FSR 20, as quoted in P. Narayanan's Law of Trade marks:

"Even though the question of similarity is still, in the end probably very much a question of first impression, that never stops counsel arguing, often very

convincingly, first on one side and then on the other."

43. Lord Evershed in *Smith Hayden Appn.* (1946) 63 RPC 97, observed:

"When all is said, the question is in truth as observed by Luxmore, LJ. and the House of lords in the *Aristoc* case, one of first impression, on which different minds may reach different conclusion."

44. With the aforesaid principles broadly lighting the path of inquiry into the question of comparing resemblance of the proposed mark with the existing mark and the probable effect of use of the proposed mark on the question of likelihood of causing confusion or deception, we may examine the issue at hand. As we have noticed, the proposed mark is five syllable letters "ULCIBAN" and existing mark with reference to which question is to be decided is two syllable word CIBA. Both the marks do not bear any characteristic distinctiveness in the manner of presentation. Thus, one can say that, the first impression, which was also of the Registrar, that both do not have visual resemblance to confuse, as such. It is not the case of the opponent that merely because the whole or part of the existing mark forms part of the proposed mark, is sufficient to denounce the mark as which is likely to cause confusion or deception. We are not in agreement with the learned Single Judge that the Registrar has split up the word to ULCIBAN in two - ULCI and BAN to avoid resemblance. It had been the case of opponent that letters "CIBA" is part of its proprietor's name and claim to its distinction has been its use as fore part of the company name as prefix of other series of marks used in connection with products connected with it. That is to say, admitted distinction of the mark has been to use of letter "CIBA" as forepart of names given to its products by the proprietor or its licensees.

45. The Registrar has really not dissected the word into two for the purpose of reading in two parts ULCI and BAN for the purpose of comparing two words. Bifurcation was used as a device to find out the origin of the word to find whether it was invented word or generic word, that is whether it satisfies the test of section 9 as an invented new word eligible as word mark to be registration under part A of the register. The invented word is always considered without any further evidence of distinctiveness as registrable under rule 57 of the Rules because the invented word by itself is considered distinctive. It is not to be found in dictionary. It is connected exclusively with inventor of the word.

46. The test of relative resemblance between comparative marks must depend upon whether the proposed mark contains element of earlier mark in its essential character in prominent way. If the same is used with its projection in any manner prominently, so as to create an impression that addendums are superfluous, the same may be ignored and the substance of the matter may be seen, but at the same time, merely because those very letters in the same order are part of a different word, which is independent of other, the latter cannot be denounced by straining to find out similarity. The likelihood of deception must be in ordinary and spontaneous reaction to the marks and not through a strained of an expert .

47. In the pamphlet which has been produced before us, in our opinion, it in no way leaves an impression that it projects use of letters/word CIBA as such. We cannot be oblivious of the view that the pamphlet was not for purchasers nor was for chemists and druggists but is a piece of information about the drug containing Cimetidine for curing ulcer. It was meant for the man of letters trained in science of medicines for prescribing medicine for curing diseases. Though they use brand name for prescribing medicine but is prominently concerned with contents of medicine needed for cure. Doctor does not prescribe medicine unconcerned with disease with which he is dealing. The word ULCIBAN is a brand name and the substance it contains is cimetidine. The fact that CIMETIDINE for its properties is used in curing ulcers is not in issue. Word CIMATIDINE is printed in bold capital letters on the cover of the pamphlet and it is also printed prominently in deep bold and dark print in capital letters below word ULCIBAN to project the word CIMATIDINE prominently. The word "ULCIBAN" which is the brand name of drug has been clearly printed in full with first letter in capital and all letters following it in small or second alphabet. No particular emphasis on letters CIBA appears in the projection of the word ULCIBAN either in setting or colour background or surrounding so as to look in mind independent of word ULCIBAN. The person for whom the pamphlet is meant is primarily concerned with properties of the substance and not with market name of the properties. It may be seen that on the cover of the pamphlet, word ULCIBAN is not written. The word written is CIMETIDINE. It was not a public advertisement of the drug under its brand name ULCIBAN. We are, therefore, not impressed with the contention of the learned counsel for the respondent-opponent, which, found favour with the learned Single judge that word "CIBA" has been prominently used in ULCIBAN which is likely to cause confusion. It may also be noticed that no material has been produced on record by the opponent to show the manner in which the word CIBA has been used by them or their licensee in labelling their products so as to give distinctiveness to the manner of presentation of the word CIBA indicating trade origin of the commodity. In fact, except that the word CIBA is registered mark of the opponent, no material has been placed to apply ocular test for comparison. A comparison needs two or more objects to be seen in the light of each other. There cannot be any comparison with oneself. Whether word ULCIBAN uses "CIBA" which can look like or give impression of products marketed under mark CIBA, no attempt has been made by the opponent to place on record any evidence the manner of its user of the mark with goods marketed under its name. On the contrary, during the course of arguments, at the suggestion of the court, strip of drug ULCIBAN, label of the appellant-applicant alongwith its photocopy was produced for visual impression and the form in which the commodity reaches the purchasers. Still no attempt was made by the opponent to put on record any material showing the manner and background in which their mark CIBA is used to be seen in the light of imperfect recollection of an average buyer the end customer. For the purpose of visual similarity, one cannot be justified in taking any special features by dissecting separate syllable to bring out similar portion of two marks and then to come to the conclusion that

other words are unimportant. This fact is not in dispute that the commodity in respect of which registration of mark is proposed is medicinal preparation containing cimetidine which is used for curing ulcer. In these circumstances, adaptation of the word ULCIBAN cannot be said to be wholly irrelevant. We agree with the view expressed by the Registrar that word ULCIBAN has been invented word by the applicant in connection with introducing drug for treating ulcer and the word formed as a whole does not give any prominence or special place to word/letter CIBA which comes in the middle of it as the integral formation of word so as to give any such visual resemblance to give rise to any reasonable probability of likelihood of deception or confusion in the mind of purchasers, keeping in view that ultimately in most cases, a drug is to be purchased by the customer on prescription of a doctor. It is a Schedule 'H' drug which is only to be procured on prescription of a registered medical practitioner and to be dispensed with only by a licensed dealer. Person who prescribes is also concerned with the pharmaceutical properties and nature of the substance of the drug which he wants to use for treating a particular ailment and the purchaser in most cases is dependent on such prescription and does not use his own discretion to buy one drug. If we keep this class of people in mind, there is no reasonable likelihood of confusion in the mind of any average purchaser.

48. In this connection, it is very relevant that somebody buying a prescribed drug is not really concerned with trade origin of the drug. He is most concerned with what has been prescribed by the doctor. Moreover, as we have noticed above, confusion can be caused in three ways, confusion as to goods, confusion as to trade origin and confusion as to trade connection. In the matter of dispensation of medicinal preparation, test relates to trade origin or trade connection is not of much importance inasmuch as average man of common intelligence who has to purchase drugs on doctor's prescription is not concerned either with trade origin or trade connection, but with the goods itself. This confusion which is likely to be caused in that field attracts more importance than other factors. It has rightly been found that CIBA is a trade mark which has connection with trade origin irrespective of goods where of average purchaser of ordinary intelligence with imperfect recollection to be kept in mind is one who is not concerned with trade origin or trade connection but with goods only, the weight of consideration in deciding whether the use of proposed mark in fair manner, in the ordinary course, is likely to cause confusion or deception, too shifts to such likelihood of deception and confusion in connection with goods. The surrounding circumstances become more important in the mind of such person for remembrance than trade origin.

49. Whether writing the word ULCIBAN or pronouncing the word ULCIBAN, significant importance of the word 'UL' or 'N' appears eloquently and cannot be ignored. Ordinarily, rule of considering the pronouncement and writing of multisyllabic words first or last syllable usually occupies important place visually as well as phonetically. We cannot conceive of a situation unless an effort is made in some way to project CIBA distinctively against 'UL' and 'N' whether in

writing or in pronouncing the word 'ULCIBAN' in any way bears such similarity which is likely to cause deception or confusion. What is to be considered in the context of inhibition u/s 11 is the probable effect of normal and fair use of applicant's mark and not by assuming strained and unfair abnormal use by any unscrupulous men and public. In other words, the test is by assuming that mark sought to be registered is to be used in fair and normal way and by user in such way, what is its probable effect vis-a-vis impression of actual user of the opponent's mark. If any fair and normal use of the applicant's mark does not cause confusion or likely to cause confusion, it would not be a case for refusing registration on the ground of likelihood of deception by unscrupulous use. There may be a case, where mark is used in a manner which is likely to cause deception or confusion. It may amount to infringement of mark. But at the time of registration of the applicant's mark without there being any material, one cannot assume the effect of the mark to be used in a particular manner in future which may not be fair and normal use of mark.

50. As is the case, CIBA and ULCIBAN both have been claimed to be word invented by their respective proprietors having inherent distinctiveness of an invention . The words are not used in specific manner. If the proposed mark is not proposed to be used in a specific manner, and is not proposed to be displayed in any specific manner, comparison must rest on the ordinary way of writing and its appeal to the eyes and ears. ULCIBAN whether written separately in typographical print or in running hand, whether in capital letters or in small letters or in ordinary way, by using the first letter to be capital letter and rest in small or second alphabet, would not attract middle part of it in any way prominently in sound or sight. In fact, if at any point of time, in its print outs, the word CIBA is in any manner sought to be projected separately from the whole of the mark, in any manner, it may amount to unfair use of the mark, infringing the right of CIBA. A strip of ULCIBAN is a strip of ten tablets which shows that whole word is written in capital letters in ordinary typed form. The pamphlet has been printed by using first letter of the word in capital and rest in second alphabet as is usual practice. Neither word has been truncated in any form in the remaining space on the pamphlet nor it has been shown that middle part of ULCIBAN has any peculiar feature which lends or invites special attention to the letters "CIBA" with which comparison is to be made.

51. If one applies phonetic test, one cannot conceive that word ULCIBAN can be pronounced without emphasis of syllable of 'UL' and 'N'. Neither the first syllable UL can be slurred nor last syllable 'N' can be slurred to the extent to give any prominence to the word 'CIBA' in any form of speech . We are not tempted to divide the word ULCIBAN in three independent parts UL-CIBA-N to find similarity.

52. We are unable to agree with the learned Single Judge ,with great respect, about the conclusion to which he has reached by dividing the word ULCIBAN into three portions UL-CIBA-N and finding similarity in the use of CIBA .If that were

sufficient to reach the conclusion about the impugned mark being deceptively similar to one owned by the respondent, in no case, the word which is already registered as trade mark can be used by any one forming part of larger word treating it to be a trade mark and it would become per se the mark likely to cause deception or confusion. But this is not law and no issue has been joined to that aspect. The only caution is that scrutiny in such cases may be much greater to find out whether the words which have been used as prefix or suffix as additions, in fair and reasonable manner are of such insignificance that only essential features of existing mark gives out an impression to cause confusion in respect of the goods or trade origin or trade connection as the case may be. We are aware of the words spoken by Farwell, J. in *William Bailey (Birmingham) Ltd's application (1952) 69 RPC 136*. He said-

"I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole. In my judgment, it is quite wrong to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case, there is no sufficient similarity to cause confusion. There may be two words which in their component parts are widely different but which, when read or spoken together, do represent something which is so similar as to lead inevitably to confusion. I think, it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word."

53. We may add that this equally applies in making effort to divide the word up and seek to find similarity between the two without considering importance of the different parts left out of consideration.

54. We have noticed that ordinarily in a multisyllable word prefix syllable is of prime importance as essential feature of the mark. Though it is not an inflexible rule. However, on the evidence of opponent itself the mark CIBA is forepart of the corporate name of the company and is used as PREFIX of many of its registered marks as CIBAZOL and CIBALGIN which constitute some of marks containing word CIBA. That is to say, that distinctive feature of opponent's mark CIBA is in its use as prefix of various products connected with it. In other words, the essential feature which is likely to strike in the mind of an average man using one or other goods of the series is the word mark as prefix with some other letters like CIBAZOL or CIBALGIN suggesting zol or lgin are likely to tag in memory with CIBA standing out as prefix in the mind. If seen in this light also, the syllable CIBA in the middle are likely to call attention with average customer of opponent's goods in mind. It may also be observed in this connection that u/s 9, a name of the company individual or firm is eligible to be registered in part A of the register without proof of distinctiveness only if such word mark is presented in particular or specific manner. According to case of opponent word CIBA is fore part of the company's name that is to say word mark is referable to company's name without any evidence for its presentation in special or

particular manner.

55. We, therefore, after considering both the marks together as a whole, do not find any such similarity or resemblance in sound or in vision from the point of view of common purchaser, the doctor who prescribes and the chemist who sells which can give rise to reasonable probability of causing confusion or deception in his mind while purchasing ULCIBAN which may lead him to think that he is purchasing product of CIBA.

56. By taking the two words together as a whole, and taking into consideration that the word mark CIBA is applied to number of goods in the medicinal and pharmaceutical preparations showing trade origin of the goods and proposed mark in respect of medicine falling under Schedule 'H' of the Drugs and Pharmaceutical rules and considering the kind of customers who are likely to buy goods in the circumstances viz. on prescription of the registered medical practitioner and from licensed dealer only and also considering the fact that two marks in question are single word consisting of multisyllable properties and that the proposed mark contains, in the middle of it, whole of the mark of the opponent and both the marks are to be used without any distinctive feature in presentation of medicine and apart from the fact that the impugned mark contains whole of the opponent's mark in the middle of it, we do not find any such similarity, phonetic or ocular, in the two marks, to think that if the proposed mark is used in fair and ordinary manner, it is likely to cause confusion in the mind of ordinary buyer with average intelligence.

57. In the circumstances of the case, we are also of the opinion that the finding of the learned Single judge that the applicant has dishonestly used the word CIBA as part of its proposed mark deliberately is not well founded particularly in view of the fact that the reason given by the Registrar about the adaptation of word ULCIBAN as its trade mark for labelling the drug meant to be used for curing ulcer was neither found to be wrong nor was challenged.

58. As it is well settled, that no precedent in the matter of deciding question whether such resemblance as is likely to deceive or cause confusion which in the very nature of things incapable of definition offers a parallel, each case must depend upon its own facts, we resist temptation to examine and distinguish large number of cases to which our attention has been drawn during the course of hearing as illustrative case by both the learned counsel. However, we may observe in all the cases cited either prefix has been held to be important or suffix has been held to be important or in other cases, part of the word has been held to be of greater consequence, then the other for reaching conclusion for or against such resemblance. But none of the cases presents a parallel to one before us, where contention is to ignore prefix and suffix both and find resemblance with the middle syllable by ignoring the opening and terminating syllables.

59. As a result, we allow this appeal, set aside the order of the learned Single

Judge and restore the order passed by the Registrar. There shall be no order as to costs.