

Aravind Laboratories Vs. M.A. Rahim, Trading as Jamuna Product

Aravind Laboratories Vs. M.A. Rahim, Trading as Jamuna Product

SooperKanoon Citation : sooperkanoon.com/835542

Court : Chennai

Decided On : Sep-25-2006

Reported in : AIR2007Mad1; 2007(1)CTC392; LC2007(1)142; (2006)4MLJ1072; 2007(34)PTC542(Mad)

Judge : D. Murugesan and ;V. Ramasubramanian, JJ.

Acts : [Trade and Merchandise Marks Act, 1958](#) - Sections 9, 11, 12, 18, 56 and 109

Appeal No. : T.M.S.A. No. 3 of 2000

Appellant : Aravind Laboratories

Respondent : M.A. Rahim, Trading as Jamuna Product

Advocate for Def. : No Appearance

Advocate for Pet/Ap. : Gladys Daniel, Adv. for ;C. Daniel, Adv.

Disposition : Appeal dismissed

Judgement :

V. Ramasubramanian, J.

1. The appellant is aggrieved by the rejection of his application for rectification of the Register, by the Deputy Registrar of Trade Marks and the dismissal of his

appeal under Section 109 of the [Trade and Merchandise Marks Act, 1958](#) by the learned Judge of this Court.

2. The facts leading to the above second appeal are as follows:

(a) The respondent obtained the registration of a trade mark bearing No. 302515, in Part-A of the Register, in respect of cosmetic preparations such as Kanmai, Kumkum, Eyebrow pencil and Bindi for sale in the States of Tamilnadu, Kerala, Karnataka, Andhra Pradesh and Orissa and Union Territory of Pondicherry. The mark consisted of the word 'IRIS' in Tamil character and the respondent sought registration claiming user from 15-5-1964 and the Registrar registered the mark on 29-1-1975.

(b) On 13-6-1980, the appellant filed an application for rectification, on the ground that they are the registered Proprietors of a Trade Mark known as 'Eyetex' bearing registration No. 124824 dated 11-9-1946 and that the impugned mark of the respondent offended the provisions of Sections 9, 11, 12 and 18 of the Act.

(c) The said application was rejected by the Deputy Registrar, by an order dated 22-3-1988, holding that when the marks are taken as a whole, they are dissimilar and distinguishable.

(d) Against the said order of the Deputy Registrar, the appellant filed an appeal under Section 109 of the Act in T.M.A. No. 4 of 1988 but the same was also dismissed by the learned Judge of this Court by an order dated 3-2-1998. Therefore the appellant has filed the above second appeal.

3. Ms. Gladys Daniel, learned Counsel appearing for the appellant contended-

(a) that the respondent was actually committing a fraud by adopting the word 'Eyeris' as an English rendition of his actual registered trade mark in Tamil 'IRIS';

(b) that the device of an eye used along with the English rendition or transliteration of the word 'EYERIS' by the respondent, makes it deceptively similar to the registered trade mark of the appellant and also exposes the intention of the respondent to take away the broad and essential features of the appellant's mark

and that therefore the register was liable to be rectified;

(c) that in order to find out whether a mark is identical to or deceptively similar to another mark, the marks should be looked at as a whole and the words cannot be split; and

(d) that the appellant had obtained prohibitory orders against the very same respondent as well as others restraining them from using similar marks and that therefore the dismissal of the application for rectification by the Registrar and the dismissal of the appeal by the learned Judge were erroneous.

4. In support of her contentions, the learned Counsel for the appellant relied upon the decisions of the Apex Court in *Amritdhara Pharmacy v. Satya Deo Gupta* reported in : [1963]2SCR484 , *Parle Products (P) Ltd., v. J.P. & Co* reported in : [1972]3SCR289 and *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.* reported in 2001 (1) CTMR 288 . She also relied upon the decisions of this Court in *Arvind Laboratories v. V. Annamalai Chettiyar* reported in , *Arvind Laboratories v. V.A. Samy Chemical Works* reported in AIR 1987 Mad 265 and *Jamna Products Manufacturer of Kanmaie v. Arvind Laboratories* reported in 2003 (27) PTC 409.

5. The first and second contention of the learned Counsel for the appellant are that the respondent was actually committing a fraud by adopting the word 'Eyeris' as an English rendition of his actual registered trade mark in Tamil 'IRIS' and that the device of an eye used along with the English rendition or transliteration of the word 'EYERIS' by the respondent, makes it deceptively similar to the registered trade mark of the appellant and also exposes the intention of the respondent to take away the broad and essential features of the appellant's mark and that therefore the register was liable to be rectified. But the said contentions were not raised by the appellant before the Registrar in their application for rectification in so many words. The appellant made only a vague allegation that the respondent was guilty of fraud, but did not elaborate on the same and hence the said contention could not be dealt with by the Registrar and the Registrar refused to look into the evidence sought to be adduced by the appellant in this regard, on the ground that in respect of an allegation of fraud specific details are to be provided in the pleadings. In particular, the appellant failed to plead in their application for

rectification before the Registrar of Trade Marks, that though the respondent was granted registration for the Tamil word 'IRIS', he was using an English adaptation reading 'EYERIS' and that he was copying the device of an eye in his cartons. It is for the first time in the grounds of appeal in T.M.A. No. 4 of 1988 that the appellant came forward with such a plea in specific terms. Therefore the same could not be looked into. It is well settled that a person who failed to make out a specific case in the court of first instance, through appropriate pleadings, cannot improve his case at the appellate stage. The pleadings of the parties form the foundation of their case and no party shall be permitted to travel beyond its pleading. In the absence of pleading, evidence if any, produced by the parties cannot be looked into. Therefore the first and second contention of the learned Counsel for the appellant, are liable to be rejected, for want of pleadings at the appropriate stage namely, before the Registrar of Trade Marks, in the application for rectification.

6. Coming to the 3rd contention of the learned Counsel for the appellant, that in order to find out whether a mark is identical to or deceptively similar to another mark, the marks should be looked at as a whole and the words cannot be split, it is seen that this contention rests upon the claim of the appellant that there is phonetic similarity between the words 'EYETEX' and 'IRIS' (or EYERIS as projected by the appellant).

7. In support of the said contention, the learned Counsel relied upon the decisions of the Apex court in *Amritdhara Pharmacy v. Satya Deo Gupta* reported in : [1963]2SCR484 , *Parle Products (P) Ltd. v. J.P. & Co* reported in : [1972]3SCR289 and *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.* reported in 2001 (1) CTMR 288 (SC). In *Amritdhara's* case, the Supreme court was dealing with the words *Amritdhara* and *Lakshmandhara* and held that the words had overall structural and phonetic similarity. It was further held by the Supreme court in the said case that 'the trade mark is the whole thing-the whole word has to be considered'. In *Parle Products (P) Ltd's* case the Supreme court held that 'In order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design.' In *Cadila Health Care Ltd. v. Cadila Pharmaceuticals*

Ltd. reported in 2001 (1) CTMR 288 , the Supreme court, relied upon its earlier decision in Amritdhara's case and held that 'It is also important that the 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.'

8. But in all the above cases, phonetic similarity alone was not taken to be the sole deciding factor. On the other hand, the Supreme Court emphasized the need to apply the test of 'overall structural and phonetic similarity' in Amritdhara's case and 'visual and phonetic tests' in Cadila's case. Similarly, the Supreme Court applied the test of 'broad and essential features' in Parle Products case.

9. Applying these tests of 'overall structural and phonetic similarity', 'visual and phonetic similarity' and 'broad and essential features', to the case on hand, it is seen that the trade mark of the respondent (of which rectification is sought for by the appellant) consisted of a word mark in Tamil reading as 'IRIS'. Admittedly, the trade mark of the appellant consisted of a word mark in English reading 'EYETEX' along with an artistic picture of a human eye. Therefore, the Registrar found that there was no structural or overall or visual similarity, though there was a phonetic similarity in so far as the first part of the word was concerned. The said phonetic similarity in the first part of the word also vanished when the word was taken as a whole along with the second part of the word. Therefore the Registrar as well as the learned Judge were right in coming to the conclusion that the marks were not identical or deceptively similar to each other.

10. In Indo Pharma Pharmaceutical Works Ltd v. Citadel Fine Pharmaceuticals Ltd. reported in 1998 (2) L.W. 646, a Division Bench of this Court considered the words 'ENERJEX' and 'ENERJASE' and held that the word 'ENERG/J' was a generic term used as a prefix and that the remaining words JEX and JASE are not deceptively similar. Similarly, the Apex court considered the words 'MICROTEL' and 'MICRONIX' in J.R. Kapoor v. Micronix India reported in 1994 Supp. (3) 215 and held that all persons using micro chip technology are entitled to use the word 'MICRO' as a prefix and that the remaining words TEL and NIX are not deceptively similar. Applying the ratio laid down in these judgments, it is seen that the common

denominator between the appellant's Mark and the respondent's Mark viz., 'EYE', cannot give leverage to the appellant to contend that the Marks are similar. As stated earlier, the respondent actually sought registration of his word Mark 'IRIS' only in Tamil and hence the word 'I' or 'EYE', if any, used by him in Tamil, cannot really create a visual similarity to the Mark of the appellant. If the respondent had actually been using a different Mark than the one in respect of which he got registration, it would give a different cause of action to the appellant, but would not give the appellant a right to seek rectification of the Register.

11. Coming to the last contention of the learned Counsel for the appellant with reference to the judgments of this Court, it is seen that in *Aravind Laboratories v. Annamalai Chettiar*, the appellant was fighting against an unregistered Mark known as 'EYESOL', which had both visual and phonetic similarity. Therefore the judgment in the said case is of no use to the appellant. The next case in *Aravind Laboratories v. V.A. Samy Chemical Works* AIR 1987 Mad 265 also related to the fight between the appellant and another with regard to an unregistered Trade Mark by name 'EYEVIX'. The third case in *Jamna Products Manufacturer of Kanmaie, Karaikudi-1 v. Aravind Laboratories* 2003 (27) PTC 409 is actually one in which the very same parties are involved. In that case, the Mark used by the respondent was a word Mark 'EYEESEE' and the same arise out of a suit for infringement. Therefore all the three decided cases of this Court relied upon by the counsel for the appellant are distinguishable in the sense that those cases arose out of proceedings for infringement and passing off, while the present case arises out of the rejection of an application for rectification of the Register. In a case relating to the application for rectification of a register, the Registrar of Trade Marks exercises quasi judicial functions and arrives at a conclusion, based upon the pleadings, evidence and the law on the point. Therefore, the decision of the Registrar of Trade Marks in such a case cannot be equated to an action for infringement or passing off.

12. It is well settled that the order passed by the Registrar of Trade Marks on an application for rectification is a quasi judicial order and the scope of interference with the said order, by this Court, either on a regular appeal or on a second appeal is very limited. The scheme of the [Trade and Merchandise Marks Act, 1958](#)

provided for three filter points viz., (i) at the threshold when an application for registration is made and the Registrar of Trade Marks scrutinises the same to find out if the Trade Mark is registerable or not, (ii) at the time when an advertisement is published in the Trade Mark Journal, enabling the opponents to file notices of opposition for the registration of the Mark and (iii) at the stage when an application for rectification is made. The third filter point viz., a scrutiny at the time when an application for rectification is made, is reached only after crossing the first two points. This is why, Section 56 of the Act, enabled the Tribunal (Registrar of Trade Marks) to 'make such order as it may think fit'. The language in which the power of the Registrar of Trade Marks is couched, in the Act, would show that the Registrar of Trade Marks is vested with an element of discretion in him.

13. When the exercise of that discretion is not shown to be arbitrary or capricious, it is not open to this Court to interfere with his orders very lightly. As an Appellate Court, this Court is not entitled to substitute its own discretion to that of the Registrar of Trade Marks. In this connection, an useful reference could be made to a passage from the judgment in *Rajkrishnan v. Parthas Textiles* 1997 PTC 205, which reads as follows:

When this Court is exercising the appellate power against the order of Registrar of Trade Marks, we must also take into consideration the discretion exercised by him. The discretion, even if it is fanciful, this Court will be reluctant to interfere with the same, if it is exercised judiciously, vide (1932) 49 RPC 306 (*Union Carbide's Appln. to register a trade mark*). We may also note that the Registrar is by experience in a unique position to reach a sensible conclusion and is of great advantage to a tribunal hearing an appeal from the Registrar, and if the Registrar has reached the conclusion after taking into consideration all relevant circumstances and in accordance with law, such a discretion should not be lightly interfered with, vide (1997) RPC 594.

14. Applying the above tests, we find no irregularity or illegality in the order passed by the Registrar of Trade Marks which was confirmed by the learned Judge of this Court. As a result, the appeal is dismissed. No costs.

