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F. HOFFMANN-LA ROCHE & CO. LTD.

v.

GEOFFREY MANNERS & CO. PVT. LTD.

September 8, 1969

B

[J. C. SHAH AND V. RAMASWAMI, JJ.]

The Trade and Merchandise Act, 1958, ss. 12(1) and 9(1)—Vitamin preparations—‘DROPOVIT’ whether a trade mark deceptively similar to ‘PROTOVIT’ so as to offend s. 12(1)—‘DROPOVIT’ whether a descriptive word or an invented word for the purpose of s. 9(1)—Tests.

C

In 1946 the trade mark ‘PROTOVIT’ was registered for one of the vitamin preparations manufactured by the appellant company. In 1957 the respondent company applied for registration of its mark ‘DROPOVIT’ in respect of “medical and pharmaceutical preparations and substances”. The application was granted. When the appellant came to know about this trade mark it asked the respondent to alter it. On the respondent’s refusal to do so, the appellant in 1959, applied to the Registrar for rectification of the Register of Trade Marks by removal thereof of the respondent’s trade mark. Later the appellant amended its application by adding the ground that ‘DROPOVIT’ was not an invented word. The Joint Registrar by letter dated August 5, 1961 rejected the appellant’s application for rectification. The appellant went in appeal to the Bombay High Court. During the hearing of the appeal the respondent restricted the designation of goods covered by the mark ‘DROPOVIT’ to “medical preparations and, substances containing principally vitamins.” The Single Judge as well as the Division Bench decided in favour of the respondent. The appellant came to this Court with certificate. The questions that fell for consideration were : (i) whether the word ‘DROPOVIT’ was deceptively similar to the word ‘PROTOVIT’ and thus offended the provision of s. 12(1) of the Trade and Merchandise Act, 1958; (ii) whether the word ‘DROPOVIT’ was an invented or a descriptive word for the purpose of s. 9(1) of the Act.

E

HELD : The appeal must be dismissed.

F

(i) In order that a trade mark may be found deceptively similar to another it is not necessary that it should be intended to deceive or intended to cause confusion. It is its probable effect on the ordinary kind of customers that one has to consider. For this purpose it is necessary to apply both the visual and phonetic tests. It is also important that the marks should be compared as wholes. 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 trade mark is such that it is likely to cause deception or confusion or mistake in the minds of the persons accustomed to the existing trade mark. [216 H; 217 G—H; 218 E]

G

Parker Knoll Ltd. v. Knoll International Ltd., [1962] R.P.C. 265 at 274, *Pianotist Co. Ltd.’s application* 23 R.P.C. 774, 777, *Aristoc Ltd. v. Rysta Ltd.*, 62 R.P.C. 65 at 72 and *Toklon Ltd. v. Davidson & Co.*, 32 R.P.C. 133 at 136, applied.

H

The terminal syllable ‘VIT’ in the two marks ‘DROPOVIT’ and ‘PROTOVIT’ was both descriptive and, as the evidence showed, common to the trade. If greater regard was paid to the uncommon element in

the two words it was difficult to hold that one would be mistaken for or confused with the other. The letters 'D' and 'P' in 'DROPOVIT' and the corresponding letters 'P' and 'T' in 'PROTOVIT' could not possibly be slurred over in pronunciation and the words were so dissimilar that there was no reasonable probability of confusion between the words either from the visual or phonetic point of view. This was all the more so because the preparations from their very nature were likely to be purchased on the prescription of doctors, and under r. 61(2) of Drug Rules, 1945 could be sold only by licensed dealers so that the possibility of confusion would be reduced to a considerable extent. [219 A—C, E]

(ii) It could not be accepted that the word 'DROPOVIT' would strike an ordinary person knowing English as meaning 'DROP OF VITAMINS'. The appellant's original application for rectification did not contain the ground that the word 'DROPOVIT' was descriptive. It was therefore reasonable to presume that it did not strike even the legal advisers of the appellant as descriptive. It was true that the word 'DROPOVIT' was coined out of words commonly used by and known to ordinary persons knowing English. But the resulting combination produced a new word, a newly coined word which did not remind an ordinary person knowing English of the original words out of which it was coined unless he was so told or unless at least he devoted some thought to it. It followed that the word 'DROPOVIT' being an invented word was entitled to be registered as a trade mark and was not liable to be removed from the Register on which it already existed. [220 H—221 D]

CIVIL APPELLATE JURISDICTION : Civil Appeal No. 1330 of 1966.

Appeal from the judgment and order dated August 4, 7, 1964 of the Bombay High Court in Appeal No. 65 of 1962.

K. S. Shavaksha, R. A. Shah, J. B. Dadachanji and Bhuvanesh Kumari, for the appellant.

M. C. Chagla, I. M. Chagla, Anoop Singh, M. N. Shroff, for *I. N. Shroff*, for the respondent.

The Judgment of the Court was delivered by

Ramaswami, J. This appeal is brought by certificate from the judgment of the Bombay High Court dated August 17, 1964 in application no. 65 of 1962 upholding in part the judgment of Mr. Justice Tarkunde dated December 7, 1962 in Miscellaneous Petition No. 358 of 1961.

The appellant is a limited liability company incorporated under the laws of Switzerland and carries on business in the manufacture and sale of pharmaceutical and chemical products. The respondent is a company incorporated under the Companies Act in India and also carries on business in the manufacture and sale of pharmaceutical products.

On December 2, 1946 the appellant applied for registration of its trade mark "PROTOVIT". The application was granted and the appellants mark was registered in Class V in respect of

A "Pharmaceutical preparations for human use and for veterinary use, infants' and invalids' foods". The appellant thereafter used that mark on multi-vitamin preparations in liquid and tablet forms and its goods are being sold under that mark at least since the year 1951.

B On January 28, 1957 the respondent applied for registration of its mark "DROPOVIT" in respect of "medicinal and pharmaceutical preparations and substances". The application was registered but the advertisement of the respondent's application escaped the notice of the appellant who did not hence oppose the registration. By a letter dated March 4, 1958 Messrs Voltas Ltd., the appellant's agents, drew the attention of the appellant to the respondent's mark "DROPOVIT". There was negotiation between the parties but on March 19, 1958 the respondents wrote to the appellant refusing to alter its trade mark. On January 21, 1959 the appellant applied for rectification of the Register by removal therefrom of the respondent's trade mark. The ground urged in support of the application was that the respondent's mark so nearly resembled the appellant's mark as to be likely to deceive or cause confusion. On March 9, 1960 the appellant applied for amendment of the application and an additional ground was taken that "DROPOVIT" was not an invented word. The application for amendment was allowed by the Registrar. The amended application was opposed by the respondent. By his judgment dated August 5, 1961 the Joint Registrar rejected the application for rectification holding that "DROPOVIT" was not deceptively similar to "PROTOVIT" and that the word "DROPOVIT" considered as a whole was not descriptive. The appellant took the matter in appeal to the Bombay High Court. On December 7, 1962 Mr. Justice Tarkunde dismissed the appeal. The appellant preferred an appeal under Letters Patent but the appeal was dismissed by a Division Bench consisting of Chief Justice Chainani and Mody, J. on August 17, 1964. During the hearing of the appeal the respondent restricted the designation of goods to "medicinal and pharmaceutical preparations and substances containing principally vitamins."

C The application for rectification was made on January 21, 1959 before the Trade and Merchandise Marks Act, 1958 (Act no. 43 of 1958) came into operation. But it is not disputed that under s. 136(3) of this Act the decision of this case is governed by the provisions of Act no. 43 of 1958 (hereinafter called the Act).

Section 11 of the Act states :

H

"A mark—

(a) the use of which would be likely to deceive or cause confusion; or

- (b) the use of which would be contrary to any law for the time being in force; or A
- (c) which comprises or contains scandalous or obscene matter; or
- (d) which comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or B
- (e) which would otherwise be disentitled to protection in a court;

shall not be registered as a trade mark.” C

Section 12(1) provides

“Save as provided in sub-section (3), no trade mark shall be registered in respect of any goods or description of goods which is identical with or deceptively similar to a trade mark which is already registered in the name of a different proprietor in respect of the same goods or descriptive of goods.” D

Section 56(1) reads :

“On application made in the prescribed manner to a High Court or to the Registrar by any person aggrieved, the tribunal may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.” E

Section 2(1)(d) defines the phrase “deceptively similar” as follows : F

“A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion;” G

The first question to be considered in this appeal is whether the word “DROPOVIT” is deceptively similar to the word “PROTOVIT” and offends the provision of s. 12(1) of the Act. In other words the question is whether the respondent’s mark so nearly resembles the registered mark as to be “likely to deceive or cause confusion.” It is not necessary that it should be intended to deceive or intended to cause confusion. It is its probable effect on the ordinary kind of customers that one has to consider. H

- A** In *Parker-Knoll Ltd. v. Knoll International Ltd.*⁽¹⁾ Lord Denning explained the words "to deceive" and the phrase "to cause confusion" as follows :

B "Secondly, 'to deceive' is one thing. To 'cause confusion' is another. The difference is this : When you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally, but still you do it, and so you deceive him. But you may cause confusion without telling him a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguish it from the other pieces of truth known to him or because he may not even take the trouble to do so."

- D** The tests for comparison of the two word marks were formulated by Lord Parker in *Pionotist Co., Ltd.'s application*⁽²⁾ as follows :

E "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 a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a 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."

- H** It is necessary to apply both the visual and phonetic tests. In *Aristoc Ltd. v. Rysta Ltd.*⁽³⁾ the House of Lords was considering the resemblance between the two words "Aristoc" and "Rysta". The view taken was that considering the way the words were pronounced in English, the one was likely to be mistaken for the other.

(1) 1962 R.P.C. 265 at 274

(2) 23 R.P. C. 774 at 777

(3) 62 R. P. C. 65 at 72.

Viscount Maugham cited the following passage of Lord Justice Luxmoore in the Court of Appeal, which passage, he said, he completely accepted as the correct exposition of the law :

"The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of section 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants".

It is also important that the marks must be compared as wholes. 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. Thus in *Layroma* case⁽¹⁾. Lord Johnston said :

"..... 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."

In order to decide whether the word "DROPOVIT" is deceptively similar to the word "PROTOVIT" each of the two words must, therefore, be taken as a whole word. Each of the two words consists of eight letters, the last three letters are common, and in the uncommon part the first two are consonants, the next is the same vowel 'o', the next is a consonant and the fifth is again a common vowel 'o'. The combined effect is to produce an alliteration. The affidavits of the appellant indicate that the last three letters "VIT" is a well known common abbreviation used in the pharmaceutical trade to denote Vitamin preparations. In

(1) *Tokalon Ltd. v. Davidson & Co.*, 32 R. P. C. 133 at 136.

- A his affidavit dated January 11, 1961 Frank Murdoch, has referred to the existence on the Register of about 57 trade marks which have the common suffix "VIT" indicating that the goods are vitamin preparations. It is apparent that the terminal syllable "VIT" in the two marks is both descriptive and common to the trade. If greater regard is paid to the uncommon element in these two words, it is difficult to hold that one will be mistaken for or confused with the other. The letters 'D' and 'P' in "DROPOVIT" and the corresponding letters 'P' and 'T' in "PROTOVIT" cannot possibly be slurred over in pronunciation and the words are so dissimilar that there is no reasonable probability of confusion between the words either from the visual or phonetic point of view.

- C
- In the High Court, counsel for the respondent made a statement that the respondent was willing that the Court should direct in exercise of its powers under s. 56(2) that the Registrar should limit the respondent's trade mark "DROPOVIT" to medicinal and pharmaceutical preparations and substances containing principally vitamins and that the appeal should be decided on this basis. The question of deceptive similarity must therefore be decided on the basis of the class of goods to which the two trade marks apply subject to the limitation agreed to by the respondent. From the nature of the goods it is likely that most of the customers would obtain a prescription from a doctor and show it to the chemist before the purchase. In such a case, except in the event of the handwriting of the doctor being very bad or illegible the chance of confusion is remote. As we have already observed the evidence shows that there are as many as 57 trade marks in the Register of Trade Marks with the suffix "VIT". Therefore, even an average customer would know that in respect of Vitamin preparations the word "VIT" occurs in large number of trade marks and because of this he would naturally be on his guard and take special care against making a mistake. In this connection the provisions of the Drug Rules, 1945 are also relevant. Under r. 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.

- H Having taken into account all circumstances of the present case we are of the opinion that the High Court and the Joint Registrar of Trade Marks were right in holding that there was no real tangible danger of confusion if respondent's trade mark

was allowed to continue to remain on the Register and the application for rectification made by the appellant should be dismissed. A

The question was also argued in the appeal whether the word "DROPOVIT" was not an invented word and whether it was a descriptive word. Section 9(1) of the Act states—

"A trade mark shall not be registered in Part A of the register unless it contains or consists of at least one of the following essential particulars, namely— B

(c) one or more invented words;

(d) one or more words having no direct reference to the character or quality of the goods and not being according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India;" C

It is contended on behalf of the appellant that "DROPOVIT" meant only "DROP OF VITAMIN" with the word 'of' being mis-spelled as 'o' 'VIT' being used to denote "Vitamins", and the three separate words are joined together to make "DROPOVIT" as one word. It was said that the word "DROPOVIT" was simply a combination of three common words in English language and cannot, therefore, be said to be an invented word. In *Diabolo case*⁽¹⁾ Parker J., has explained the meaning of "invented word" as follows : D

"To be an invented word within the meaning of the Act a word must not only be newly coined, in the sense of not being already current in the English language, but must be such as not to convey any meaning, or, at any rate, any obvious meaning to ordinary Englishmen. It must be a word having no meaning or no obvious meaning until one has been assigned to it." E

In the case of *De Cordova and others v. Vick Chemical Co.*⁽²⁾ the Privy Council referred to that interpretation of Parker J., as "the best standing interpretation". The question arising in this case is whether the word "DROPOVIT" would strike an ordinary person knowing English as meaning "DROP OF VITAMIN". In this connection the High Court has pointed out that the original application for rectification did not contain the ground that the word of "DROPOVIT" was descriptive. It was, therefore, legitimate to draw the inference that the word F

(1) 25 R. P. C. 565.

(2) 68 R. P. C. 103. G

- A "DROPOVIT" did not strike even Messrs Depenning and Depenning the legal advisers of the appellant as being descriptive. It was also pointed out that in his judgment Mr. Justice Tarkunde has remarked that when the case was opened before him he did not understand that the word "DROPOVIT" meant "DROP OF VITAMIN" till the explanation of that word was given to him.
- B We see no reason, therefore, to differ from the reasoning of the High Court on this aspect of the case. If the word "DROPOVIT" is not a descriptive word it must be held to be an invented word. It is true that the word "DROPOVIT" is coined out of words commonly used by and known to ordinary persons knowing English. But the resulting combination produces a new word, a newly coined word which does not remind an ordinary person knowing English of the original words out of which it is coined unless he is so told or unless at least he devotes some thought to it. It follows that the word "DROPOVIT" being an invented word was entitled to be registered as a trade mark and is not liable to be removed from the Register on which it already exists.
- C
- D For the reasons expressed we hold that this appeal fails and must be dismissed with costs.

G.C.

Appeal dismissed.