



(T)CMA(TM)7/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 01.08.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

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(OA/26/2011/TM/CH)

M/s. Wockhardt Limited
Wockhardt Tower,
Bandra Kurla Complex,
Bandra (East), Mumbai - 400 001.

... Appellant

Vs

1.Apex Laboratories Limited,
No. 76, C.P. Ramasamy Road,
Alwarpet,
Chennai - 600 018.

2.The Deputy Registrar of Trade Marks,
Office of the Trade Marks Registry,
Intellectual Property Building,
G.S.T.Road, Guindy,
Chennai-600 032.

... Respondents

Prayer: Transfer Civil Miscellaneous Appeal (Trademark) filed
under Section 91 of the Trade Marks Act 1999 praying to (a) set



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aside/quash the order dated 27th January 2011 of the 2nd respondent, restore order dated 3rd February 2010 allowing appellant's opposition MAS -58565 and dismissing 1st respondent application No. 699376 in class 5; (b) allow appellant's opposition MAS-58565 and disallow 1st respondent's application no.699376 in class 5 to proceed for registration.

For Appellant : Mr.Arun C. Mohan

For Respondents : Mr.R.Sathish Kumar for R1
Mr.C.Samivel, SPC for R2

ORDER

An order dated 27.01.2011 allowing a review application is impugned in this appeal. The first respondent herein had applied for registration of the mark 'ZINCODERM'. The appellant filed notice of opposition on 08.03.2001. After considering the pleadings and the evidence placed on record by the parties, by order dated 03.02.2010, the opposition was accepted and the Trademarks Registry refused to register the first respondent's mark 'ZINCODERM'. Upon a review



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application being filed, the order dated 27.01.2011 was issued allowing such review.

2. Oral arguments on behalf of the appellant were advanced by Mr.Arun C. Mohan, learned counsel; and on behalf of the first respondent by Mr.R. Sathish Kumar, learned counsel. Mr. C.Samivel, learned Senior Panel Counsel, appears for the second respondent.

3. Mr.Arun C. Mohan assailed the impugned order on the ground that the scope of review jurisdiction is narrow and that appellate jurisdiction was erroneously exercised while issuing the impugned order. He invited my attention to the judgment of the Hon'ble Supreme Court in *Meera Bhanja v. Nirmala Kumari Choudhury (Meera Bhanja)*, (1995) 1 SCC 170, particularly paragraph 8 thereof, to contend that the scope of review is confined to the ambit of Order 47 Rule 1 Code of Civil Procedure, 1908 (the CPC). He also pointed out the conclusion of the Hon'ble Supreme Court in the above



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judgment that the exercise of review jurisdiction should be confined to cases where the error is apparent on the face of the record without resorting to a long-drawn process of reasoning, especially on issues on which there could conceivably be more than one opinion.

4. He next invited my attention to the original order dated 03.02.2010. By referring to the operative portion of the said order, he pointed out that the Deputy Registrar of Trademarks concluded that the appellant's mark 'ZINDERM' and the first respondent's mark 'ZINCODERM' are nearly identical, except for the inclusion of the letters 'C' and 'O'. Mr.Arun C.Mohan submitted that this conclusion was drawn after taking note of the pleadings and evidence on record. He next referred to the order passed in the review application. He pointed out that the grounds for review under Order 47 Rule 1 CPC were noticed in the impugned order while recording that the grounds of discovery of new and important matter or evidence and error apparent on the face of the record are inapplicable. After



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recording such finding, Mr.Arun C.Mohan contended that there is no explanation in the impugned order as to why there is sufficient reason to review the original order. Indeed, he contended that the review order does not contain a finding that the original order contained an error apparent or anything analogous thereto. In effect, his submission was that appellate jurisdiction and not review jurisdiction was exercised while passing the impugned order.

5. In response, Mr.R.Sathish Kumar provided an overview of the fact situation. He submitted that the trademark application was filed in the year 1996, the original order was passed in the year 2010 and the review order shortly thereafter in January 2011. Pursuant to the impugned order, he submitted that the first respondent's trademark was registered with effect from the date of application and has remained on the register for about 12 years. He also pointed out that the first respondent commenced use of the trademark shortly after filing the application for registration in the year 1996 and has



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used the mark openly, honestly and continuously ever since. His next submission was that the original order refusing to register the trademark was issued largely on the ground of likelihood of deception or confusion under Section 11(a) under the Trade and Merchandise Marks Act, 1958. According to Mr.Sathish Kumar, there is no likelihood of deception or confusion, unless the appellant uses its mark 'ZINDERM'. In spite of being provided with an opportunity to adduce evidence, he submitted that the only evidence produced by the appellant was the assignment deed in its favour. In other words, he contended that no proof of use was provided by the appellant. By contrast, he submitted that the first respondent submitted two invoices and an advertisement as proof of use of the mark 'ZINCODERM'.

6. In these facts and circumstances, Mr.Sathish Kumar contended that the original order contained errors apparent inasmuch as the Deputy Registrar of Trademarks did not record any



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findings with regard to the submission of the first respondent that the appellant was not selling any product under the trademark 'ZINDERM'. Therefore, he submitted that the impugned order falls within the scope of review jurisdiction and does not call for interference by this Court.

7. By way of a brief rejoinder, Mr.Arun C.Mohan submitted that the appeal was filed by the appellant within the prescribed limitation period. Consequently, he contended that the delay in consideration of the appeal cannot be held against the appellant. He further submitted that the duration of use of the mark 'ZINCODERM' by the first respondent and the length of time that has expired since registration thereof are immaterial to the adjudication of this appeal. His next contention was that the impugned order does not take into consideration or record any finding with regard to the failure of the first respondent to adduce actionable evidence of use of the mark 'ZINCODERM'. By adverting to the two invoices, he



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submitted that the said invoices are not decipherable. Even as regards the advertisement, he submitted that it does not constitute evidence of use of the trademark 'ZINCODERM'. In conclusion, he submitted that the threshold for exercise of review jurisdiction should be placed at a high level so as to ensure finality of orders.

8. Upon considering the rival contentions, the first aspect to be taken note of is the provision relating to review. The Trade and Merchandise Marks Act, 1958 (the 1958 Act), was in force when the application for registration was filed. Section 97(c) thereof dealt with the review of orders of the Registrar and provided as under:

“the Registrar may, on an application made in the prescribed manner, review his own decision.”

By the time the original order and review orders were passed, the Trade Marks Act, 1999 (the Trade Marks Act) replaced the 1958 Act. Section 127(c) of the Trademarks Act corresponds to Section 97(c) of



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the 1958 Act, and is in identical terms. Thus, there is no doubt that the Registrar has the power of review. Neither Section 97(c) nor 127(c) of the statutes in question specify the grounds on which the power of review may be exercised. While the provisions of the CPC are not applicable or binding on the Registrar, in the absence of statutory prescription indicating otherwise, the principles enshrined therein are applicable to the exercise of review jurisdiction by any forum.

9. Order 47 Rule 1 of CPC, which deals with review, is set out below:

“1. Application for review of judgment--(1) Any person considering himself aggrieved,-

(a) by a decree or order from which an appeal is allowed, but from which no appeal has been preferred,

(b) by a decree or order from which no appeal is allowed,
or

(c) by a decision on a reference from a Court of Small Causes,



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and who, from the discovery of new and important matter or evidence which, after the exercise of due diligence, was not within his knowledge or could not be produced by him at the time when the decree was passed or order made, or on account of some mistake or error apparent on the face of the record, or for any other sufficient reason, desires to obtain a review of the decree passed or order made against him, may apply for a review of judgment to the Court which passed the decree or made the order."

On perusal of Order 47 Rule 1 CPC, it is evident that review jurisdiction may be exercised on the following three grounds:

(i) discovery of new and important matter or evidence which was not within the knowledge of or could not be produced by the applicant when the original order was passed, in spite of the exercise of due diligence; or

(ii) a mistake or error apparent on the face of the record; or

(iii) for any other sufficient reason.



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10. It remains to be seen whether the said principles were applied while passing the impugned order and this entails examining the original order first. In the original order, at page 169 of the paper book, the contentions of the first respondent herein with regard to lack of evidence of use of the mark 'ZINDERM' were noticed. In relevant part, the relevant paragraph of the original order is set out below:

“....The opponent has not filed even a single document to prove that they or their predecessors in title have commenced using the said trade mark. The counsel further stated that even today the opponent is not selling any product under the trade mark ZINDERM. The opponent has not even furnished the sales turnover of their product ZINDERM in th affidavit filed by way of evidence in support of opposition. On the other hand the applicants have filed documents and furnished sales turnover of their product in the affidavit filed by way of evidence in support of application to prove that they have been using the said trade mark since September 1999 and on the date of opposition the applicant had already started using the



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trade mark ZINCODERM. The counsel further submitted that the trade mark ZINCODERM applied for registration by the applicant is only extension of their registered trade marks ZINCOFER and ZINCOVIT which marks are in use by the applicant for a very long time. It is also significant to point out that the opponent's mark ZINDERM was not cited as a conflicting mark in the examination report. To the best of the knowledge of the applicant the opponent's product is not available in the market. The counsel also stated that the mark ZINCODERM is dissimilar to the trade mark ZINDERM. He relied on case-laws reported in AIR 1970 SC 2062, RPC 1966 at Page 64 & AIR 1965 Punjab 17 in support of his submissions."

11. After taking note of the express contention that no document was submitted by the appellant herein to establish the use of the mark ZINDERM either by itself or its predecessors, no findings were recorded with regard to this submission. In a similar vein, after noticing the express contention of the first respondent that the mark ZINCODERM is an extension of the first respondent's registered trademarks ZINCOVIT and ZINCOFER, without appreciating the



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significance or implications of this submission, the original order records that the only difference between the prior mark of the appellant and the subsequent mark of the first respondent is the insertion of the letters 'C' and 'O' between ZIN and DERM. It was further recorded that the rival goods are similar/identical and that there is likelihood of confusion and deception in the trade channels. Whether the above findings justify interference in review jurisdiction is examined next.

12. Apart from the contentions referred to above, the following submissions were also recorded in the original order at page 167 of the paper book:

“The applicants have adopted the trade marks with the prefix ZINCO like ZINCOVI and ZINCOFER and the said trade marks have been registered in the name of the applicants. Both the above marks are being used continuously and extensively from the year 1978. In view of goodwill and reputation attached to the above said registered trade marks the applicants adopted another trade mark with the prefix



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ZINCO named as ZINCODERM and applied for its registration under No.699376 in Class-5 as a proposed mark. Immediately after filing the application for the registration of the trade mark ZINCODERM the applicants have started using the trade mark in respect of pharmaceutical and medicinal preparations and have done and is still doing extensive business and the said trade mark has become distinctive of the applicants goods only and with none else. Rest of the counter statement contains mere denial of opponent's averments."

13. Against this backdrop, I turn to the impugned order, which sets out the three grounds for review under Order 47 Rule 1, CPC. Thereafter, a conclusion is drawn therein that the first two grounds are not applicable, whereas the ground of "for any other sufficient reason" is applicable. The impugned order, thereafter, proceeds to record that the appellant obtained registration of the mark ZINDERM but did not use the mark or provide evidence of use of the mark. Eventually, the review was allowed by recording, in relevant part, as under:



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"....Further, the counsel for applicant pointed out that besides the Ld. Deputy Registrar went wrong in coming to the conclusion that the opponents trade mark ZINDERM is phonetically similar to the applicants trade mark ZINCODERM. Indeed the very opponent in these proceedings have succeeded before the Bench of the Chennai High Court where His Lordship Justice MISRA sitting in the bench held that PELOX & PENLOX are dissimilar. Further the applicants have registered several products with the prefix ZINC and have honestly adopted the mark ZINCODERM. In view of the above, I am of the view that mere registration is not enough to prove the user in the absence of filing of any evidence in support of use of the registered trade mark of the opponents. In this regard, the counsel for the applicant/respondents relied on the following:

It has been held by the Intellectual Property Appellate Board in ORA/178/2007/TM/CH vide their judgment dated 31.10.2006 that mere production of Registration Certificate is not enough and that the use of the mark in the course of trade has to be proved by production of invoices and cogent documentary evidence of use has to be proved and that the "mere existence of the mark on the register cannot be proof of use of the mark". The counsel also stated that the main



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grounds of Rectification was based on non user of the mark by the Registered Proprietor. Till date, the mark stands registered in the name of LAKME LIMITED, and a copy of the website status taken on 18.2.2010 is enclosed. A copy of the Statement of Case filed along with the Rectification and the letter forwarded by the Trade Marks Registry, Mumbai to LAKME LIMITED is also enclosed.

In the interest of the justice, I have come to the conclusion that the applicants for Review have made out a strong case for setting aside the order dated 3.2.2010 passed in this matter and dismiss the opposition on merits. Therefore review application dated 2.3.2010 is allowed and the order dated 3.2.2010 is hereby revoked."

14. On examining the above findings, it is evident that the review was allowed on the following three grounds:

(i) that the appellant did not produce any proof of use of the mark ZINDERM.

(ii) that the original order erroneously concluded that the mark ZINCODERM is phonetically similar to the impugned mark ZINDERM.



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(iii) that the first respondent registered several products with the prefix 'ZINC' and had honestly adopted the mark ZINCODERM.

15. As discussed earlier, the original order recorded the submissions of the first respondent to the effect that the appellant had not provided any proof of use of the mark ZINDERM. In spite of noticing such submissions, the original order did not discuss or record any findings in relation thereto. The submission of the first respondent that it had used the prefix ZINCO previously and obtained registrations for the marks ZINCOVIT AND ZINCOFER was also noticed in the original order. Once again, in spite of noticing the submission, the said submission was not dealt with and instead a finding was recorded in the original order that the first respondent's mark is identical to the appellant's mark but for the addition of the letters "C" and "O". In the impugned order, *inter alia*, on the above grounds (see (i) and (iii) of the preceding paragraph), the original



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order was interfered with on the ground that there is sufficient reason to interfere with the same.

16. Although the two specific grounds for review in Order 47 Rule 1 CPC are not traceable to a common genus and, therefore, the principle of *ejusdem generis* may not technically apply, the use of the expression “for any other sufficient reason” leads to the inference that the generic ground should be limited to matters comparable or analogous to the specific grounds. If construed in this fashion, appellate jurisdiction cannot be exercised in the guise of reviewing an order. In this case, interference on the ground of “for any other sufficient reason” would be tenable if a case for interference on the ground of errors apparent on the face of record is made out. As the Hon'ble Supreme Court has instructed in multiple judgments, including *Meera Banja*, an error apparent is an error that is readily discernible without undertaking an extensive or in-depth analysis. Undoubtedly, what would be readily discernible as an error would



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vary depending on the knowledge and skill of the person examining the record. Therefore, this exercise should be undertaken by assuming a reasonable level of domain knowledge and skill. Proceeding on that basis, since submissions were noticed and recorded in the original order without providing any findings in relation thereto, the errors noticed in exercise of review jurisdiction qualify as errors apparent on the face of the record or as any other sufficient reason to review the original order. Therefore, I conclude that the impugned order does not call for interference in exercise of appellate jurisdiction.

17. Consequently, (T)CMA(TM)/7/2023 is dismissed without any order as to costs.

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Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes/ No

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