

1986 March 7

[SYLIANIDES, J.]

IN THE MATTER OF ARTICLE 146
OF THE CONSTITUTION

THE BRITISH PETROLEUM COMPANY PLC.,

Applicants,

v.

THE REGISTRAR OF TRADE MARKS,

Respondents.

(Case No. 21/85).

Trade Marks—The Trade Marks Law, Cap. 268—Section 14(1)—Questions for determination—Goods “of the same description”—Matters to be taken into account in determining the question whether the goods of the registered trade mark are of the same description with the goods of the proposed Trade Marks—The fact that the respective goods come under the same Class of the Registrar’s classification is not the criterion.

5

10

15

The respondent Registrar rejected applicant’s application for the registration of trade mark “FIRIDI” in class 5 of the Register and in respect of air freshening preparations and deodorants, germicides, antiseptic preparations and disinfectants (other than for laying or absorbing dust) on the ground that the proposed mark was, in accordance with the provisions of s. 14(1)* of Cap. 268 similar to Trade Mark “FYRINT” registered in Class 5 in respect of pharmaceutical preparations for human use.

20

Held, annulling the sub judge decision: (1) Under s. 14(1) the Registrar has to consider two questions: (a) Whether the respective specifications cover one or more of the same goods or goods of the same description and (b) Whether

* Quoted at pp 750-751.

the respective marks sufficiently resemble each other having regard to what would be a normal and fair user of them and that due to such resemblance there is an actual probability of deception or of causing confusion.

(2) Section 14(1) applies where some goods for which the existing mark is registered and some goods for which the applicant seeks to register a mark are either the same or at least of the same description. 5

(3) In this case it is clear that the goods of the registered mark and the goods of the proposed mark are not the same. 10

(4) The question whether goods are "of the same description" is one of fact. The nature and composition of the goods, the respective uses of the articles and the trade channels through which the commodities respectively are bought or sold are the matters to be taken into account in deciding the question (Dictum of Romer, J. in *Jellinek's Appn.* [1946] 63 R.P.C. 59 adopted). The fact that the respective goods come under the same class of the Registrar's classification is not and cannot be the criterion. 15 20

(5) In this case the respondent Registrar laboured throughout under a misconception namely that because the respective goods come both under Class 5 they are of the same description. The misconception is material because it prevented the Registrar from carrying out a due inquiry into the matter of the description of the goods on the recognised criteria. 25

*Sub judice decision annulled.
No order as to costs.*

Cases referred to: 30

Austrian Wine Importer's Case [1889] 41 Ch. D. 278;

Darwin's Appn. [1945] 63 R.P.C. 13;

"*Daiguirí Ram*" T.M. [1969] R.P.C. 600;

Jellinek's Appn. [1946] 63 R.P.C. 59;

Smith Hayden and Co. Ltd's Appn. [1946] 63 R.P.C. 97;

Bali T.M. [1969] R.P.C. 472.

Recourse.

5 Recourse against the refusal of the respondent to accept applicants' application for the registration of trade mark "FIRIDI" in Class 5 and in respect of air freshening preparations and deodorants, germicides, antiseptic preparations and disinfectants.

G.M. Nicolaidis, for the applicants.

10 *St. Ioannides (Mrs.)*, for the respondents.

Cur. adv. vult.

15 STYLIANIDES J. read the following judgment. The applicants by this recourse seek the annulment of the decision of the Registrar of Trade Marks whereby he refused to accept the application of the applicants under No. 25337 for the registration of trade mark "FIRIDI" in Class 5 and in respect of air freshening preparations and deodorants, germicides antiseptic preparations and disinfectants (other than for laying or absorbing dust).

20 The applicants are a company registered in England.

25 On 31.8.84 the applicants filed an application under No. 25337 for the registration of trade mark "FIRIDI" in Class 5 in respect of air freshening preparations and deodorants, germicides, antiseptic preparations and disinfectants (other than for laying or absorbing dust). The application being considered for acceptance was on 5.10.84 objected to on the ground that the proposed trade mark was, in accordance with the provisions of s. 14(1) of the Trade Marks Law, Cap. 268, similar to Trade Mark No. 17290
30 "FYRINT" registered in Class 5 in respect of pharmaceutical preparations for human use.

The applicants on 22.10.84 through their advocate, filed a considered reply whereby it was contended that there was no phonetical or visual resemblance between

"FIRIDI" and "FYRINT", which is obviously pronounced with "y" accent; that the specification of goods of the proposed mark "FIRIDI" does not include "pharmaceutical products for human use," which are covered by the cited mark "FYRINT" and that there is no risk of confusion between the two marks in question. 5

The respondent on the arguments put forward in the said reply found that the objections in respect of Trade Mark No. 17290 "FYRINT" could not be waived and consequently the application was refused. The Registrar's refusal was communicated to applicants' counsel on 29.10.84. 10

The grounds of decision of the Registrar were requested by the applicants on or about 24.11.84 and were furnished on 26.2.85.

As far as the first point is concerned, it was found in the grounds of decision that no phonetical real difference between the letter "I" and "Y" exist, being both similar letters phonetically and visually and there is no difference as to the pronunciation of the marks "FYRINT" and "FIRIDI". Also the letters "NT" and "D" are pronounced the same and the last letter "I" of the propounded trade mark makes no real difference, and the main idea left on the mind by both may be the same. 15 20

In the grounds of decision on the submission in the considered reply that the goods in respect of the two marks are different, it is stated: "I find the goods are in same class 5 and being all pharmaceutical products are of the same description, and when comparing goods which can be confused with pharmaceutical products for human use the Registrar must exercise the highest degree of care." 25 30

Section 14(1) of the Trade Marks Law, Cap. 268, reads:-

"Subject to the provisions of subsection (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a 35

trade mark as to be likely to deceive or cause confusion.”

This is a replica of s.12(1) of the English Act.

5 Under s.14(1) the Registrar has to consider two questions: (a) Whether the respective specifications cover one or more of the same goods or goods of the same description; and
 10 (b) whether the respective marks sufficiently resemble each other having regard to what would be a normal and fair user of them and that due to such resemblance there is an actual probability of deception or confusion is caused.

Section 14(1) applies where some goods for which the existing mark is registered and some goods for which the applicant seeks to register are either the same or at least
 15 of the same description. In the grounds of decision, in the opposition and in the address of counsel for the respondents the goods of the applicants sought to be covered by the proposed mark are described as “pharmaceutical products or veterinary and sanitary substances or both” for the sole
 20 reason that the application was under Clause 5 of the Rules.

Clause 5 of Schedule IV of the Trade Marks Rules, 1951—1984, reads:-

25 “5. Pharmaceutical, veterinary and sanitary substances; infants’ and invalids’ foods; plasters, material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin.”

It is clear that the goods of the cited trade mark and the goods of the proposed mark are not the same.

30 Are they of the same description? The question of whether goods are “of the same description” is one of fact; it cannot be decided merely by reference to the Registrar’s classification—(*Australian Wine Importers’ Case*, [1889] 41 Ch.D. 278, 291; 6 R.P.C. 311; *Darwin’s Appn.*, [1945] 35 63 R.P.C. 13; “*Daiquiri Rum*”, T.M. [1969] R.P.C. 600, per Lord Wilberforce at p. 620 (H.L.)).

The fact that two goods come under the same class of the

Registrar's classification under Schedule IV is not and cannot be the criterion that they are of the same description. A perusal of the various classes leads to the conclusion that a single class may contain more than one description of goods whilst goods of those description may fall into distinct classes. Each case has to be decided on its own facts. 5

In *Jellinek's Appn.*, [1946] 63 R.P.C. 59, commonly known as the "Panda" case, Romer, J. at p. 70, classified the various matters to be taken into account in deciding whether goods are goods of the same description into three classes:- 10

- (a) The nature and composition of the goods;
- (b) The respective uses of the articles;
- (c) The trade channels through which the commodities respectively are bought and sold. 15

The Registrar in this case in deciding that the pharmaceutical products for human use covered by cited registered trade mark are of the same description as the goods of the proposed trade mark for the sole reason that they are goods in the same Class 5, he considered the goods of the proposed trade mark as veterinary and sanitary substances. The respondent laboured throughout under a misconception that because both goods come under the same Class 5, they are of the same description. 20

This is a material misconception. It prevented the Registrar from carrying out a due inquiry into the matter of the description of the goods on the recognized criteria. The classification of goods under Schedule IV is not in law and cannot be taken as the criterion and is per force not the sole criterion for the description of goods for the purposes of s.14 of the Law. The sub judge decision of the Registrar cannot survive the judicial control of the administrative Court. 25 30

The sub judge decision is faulty being the product of a material misconception of Law and fact; it is faulty as it was taken without a due inquiry. 35

The Registrar after properly finding that the two com-

modities are of the same description of goods within s.14(1). he has to proceed to the further question whether the respective marks sufficiently resemble each other so nearly that there is a likelihood to deceive or cause confusion.

- 5 In *Smith Hayden & Co. Ltd.'s Appn.* [1946] 63 R.P.C. 97, at p. 101 (a case in which there was an opposition by the owners of the mark "HOVIS" to an application to register "OVAX" for improvers and moistening agents to be used in making cakes). Evershed, J., as he then was,
10 held:-

"The questions for my decision have been formulated, and I think accurately formulated, as follows:-

(a)

- (b) (under section 12) 'Assuming user by Hovis
15 Limited of their marks "Hovis" and "Ori" in a normal and fair manner for any of the goods covered by the registrations of these marks (and including particularly goods also covered by the proposed registration of the mark "Ovax"), is the court satisfied that there will be
20 no reasonable likelihood of deception and confusion amongst a substantial number of persons if Smith Hayden & Co. Ltd. also use their mark "Ovax" normally and fairly in respect of any goods covered by their proposed registration? "

- 25 Lord Upjohn in "*Bali*" T.M., [1969] R.P.C. 472 (H.L.), at p. 496, said that the requirement that the deception and confusion be amongst a substantial number of persons is a judicial gloss which needs to be properly and sensibly applied.

- 30 In view of what I said about the first question that the Registrar had to answer, I need not proceed to the issue of resemblance and likelihood of deception and confusion of "FIRIDI" and "FYRINT."

This recourse succeeds. The sub judice decision is declared

null and void and of no effect but in all the circumstances there will be no order as to costs.

*Sub judice decision
annulled. No order
as to costs.*

5