

Andrews JA

[2] The appellant has appealed against the judgment of Mohamed Mackie J, delivered in the High Court at Lautoka on 18 November 2020, in which the Judge upheld the decision of the Fiji Intellectual Property Office (“FIPO”) to refuse registration of a trademark applied for by the appellant under the provisions of the Trademark Act 1933 (“the Act”) (“the High Court judgment”)¹

Background

[3] On 18 November 2018 the appellant applied to FIPO to register a trademark for “Elements Beyond Expectation” in which an image of an electrical plug was embedded in the letter “n” of the word “Elements”, as is represented in the application:



In this judgment I will refer to the image of the electrical plug embedded in the letter “n” as the “embedded plug device”.

[4] The appellant stated in its application that the trademark was to be registered in respect of goods under Class 18, which includes electrical goods including lamps, light fittings, illuminated signs, pumps and fans.

¹ *R C Manubhai and Co Pte Ltd v The Attorney General of Fiji* [2024] FJHC 178; HBM23.2021 (7 March 2024).

[5] By a letter dated 19 January 2021, FIPO refused the application. FIPO set out its reasons for the refusal (at the request of the appellant’s solicitors) in a letter dated 14 June 2021 (received by the appellant’s solicitors on 5 August 2021). The essence of the refusal was set out in paragraph 3 of the letter:

It is noted that the classification of goods for the trade-mark is, inter alia, “electric filament or discharge lamps ... lamps and lighting fitting including searchlights and spotlights and in parts illuminated signs...”. It is also noted that the trade-mark includes a “plug device”. As such, the trade-mark is directly descriptive of the character of the goods.

FIPO referred to the English judgment of *British Sugar Plc v James Robertson & Sons Ltd* in support of its refusal of the application.²

[6] The appellant’s solicitors sought reconsideration of FIPO’s refusal on 11 August 2021. They wrote (inter alia):

...

Your reason for refusal appears to be the drawing of a “plug device” in the letter “n” of the word “Elements”. You suggest that this word is “directly descriptive” of the character of the goods. We understand that you are referring to section 8(1)(d) of [the Act], which required that the word or words have “no direct reference to the character or quality of the goods”. ...

Your letter and your position are not supported by the law that you rely on:-

- 1. The letter “n” in “Elements” is not a word. It is an alphabet.*
- 2. The drawing of the plug is not a word. It is a drawing.*

Therefore, it does not fall within the category of “word or words”.

We request you to let us know which “word or words” you say directly references the character or quality of the goods on which our client wished to register the trademark “Elements Beyond Expectations”.

² *British Sugar Plc v James Robertson & Sons Ltd* [1996] EWHC 387 (ChD), [1996] RPC 281.

Appeal to the High Court

[7] The appellant's solicitors filed an appeal to the High Court against the refusal by way of a Notice of Originating Motion on 2 September 2021. The grounds of appeal were set out at paragraph 5 of the Notice of Originating Motion, as follows:

5.1 *[FIPO] erred in law in rejecting the application for Trademark on the grounds that the Trademark includes a plug device bearing a direct reference to the character of goods classified as described under the application number 271/2020, when*

5.1.1 *The plug device is not descriptive of the class of goods that the appellant intends to sell under the Trademark.*

5.1.2 *The authority of British Sugar Plc v James Robertson & Sons Ltd is not applicable to the trademark the appellant intends to register, the Authority did not establish that drawing or design are not capable of being registered as the Trademark.*

5.1.3 *The provision of section 8(1)(d) of the [Act] is limited to only words and does not go beyond to regulate drawing or design*

[8] In dismissing the appeal the Judge said in the High Court judgment:

22 *It is common knowledge that an electrical Plug (device), being an integral part of most of the electrical appliances and products in the market, is always accompanied with those products, or subsequently purchased, which establishes the connectivity to the power supply socket for the operation of such electrical appliances or instruments. Undoubtedly, most of the electrical goods sold by the Appellant also fall into the category, which require the device of male plug for its connectivity to the power supply. ...*

24 *After impregnation of the letter "n", found in the word "Elements", with the image of an Electrical Plug, the word "Elements", being a part of the intended Trademark, plays a role more than it is expected to do. Because, once an image of this nature is introduced therein, it gives the direct reference to the character or quality of the goods, which eventually contravenes the section 8(1)(d) of the [Act]. ...*

- 27 *As the counsel for the Appellant argues, a word or letter may not be a device. But it loses its character of being only a “word” or “words” when an image of the device is found to be hiding behind those “word” or “words”, which gives direct reference to the character and quality of the goods and takes away the distinctiveness.*
- 28 *After introduction or interpolation of an image into a “word” or “words”, which gives direct reference to the character of the goods it will no longer be just a “word” or “words” in terms of the section 8(1)(d) of the Act for it to be protected by that section. In this matter, the disputed plug device found in the letter “n” of the word “Elements” has to be considered as descriptive and gives reference to the Appellant’s goods. ...*
- 38 *I find that the plug device found in the letter “n” in the word “Elements” is considered to be descriptive under s 8(1)(d) of the Act. The plug device gives the description in relation to the product. The essential element that requires attention here is not the word, but the plug device, which is conspicuously embedded in the letter “n” of the word “Elements”. At a mere glance, it immediately shows the public as to what type of goods are being sold.*

Appeal to this Court

- [9] The appellant’s appeal grounds may be summarised as being that the Judge erred in law in:
- [a] his interpretation and application of s 8 and other provisions of the Act, by not considering the appellant’s submissions as to the definition of “mark” in s 2 of the Act, or determining that a “word” in a trademark is different from a device;
 - [b] not considering or holding that s 8(1)(d) is limited to “word or words” not having a “direct reference to the character or quality of the goods”, and the limitation does not extend to a “device” or an image;
 - [c] holding that the embedded plug device was descriptive of the product and therefore restricted under s 8, and in particular, not considering that the proposed goods to be protected were not limited to having a plug device, and the appellant did not apply to trademark a male plug device.

Section 8 of the Act

[10] It is appropriate to set out s 8 of the Act:

8. *Trade-marks — what marks are registrable as such*

(1) *A registrable trade-mark must contain or consist of at least one of the following essential particulars—*

(a) *the name of a company, individual or firm represented in a special or particular manner;*

(b) *the signature of the applicant for registration or some predecessor in his or her business;*

(c) *an invented word or invented words;*

(d) *a word or 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;*

(e) *any other distinctive mark, but a name, signature or word or words other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d) shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness,*

provided always that any special or distinctive word or words, letter, numeral or combination of letters or numerals used as a trade-mark by the applicant or his or her predecessors in business before 22 April 1886, which has continued to be used either in its original form or with additions or alterations not substantially affecting the identity of the same down to the date of the application for registration shall be registrable as a trade-mark under this Act.

(2) *For the purposes of this section “distinctive” shall mean adapted to distinguish the goods of the proprietor of the trade-mark from those of other persons. In determining whether a trade-mark is so adapted the tribunal may, in the case of a trade-mark in actual use, take into consideration the extent to which such user has rendered such trade-mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.*

The appellant's submissions

[11] Mr Padarath submitted for the appellant that “Elements” with the embedded plug device in the letter “n” is not a “word”. He submitted that when an image is inserted into a letter in the “word”, it loses its character as a “word” and becomes an “image” or a “device” (that is, a “composite, or compound, trademark”). A composite trademark does not fall within the ambit of “word” and “device” in Act, and s 8(1)(d) (being limited to “word or words”) has no application, and whether or not the composite trademark is descriptive is an irrelevant consideration. He submitted that it is clear under the Act that it is only “word or words” that are required to have “no direct reference to character or quality of the goods”.

[12] He submitted that the Judge was wrong to consider “Elements” with the embedded plug device as a “word”. He submitted that the Judge had overlooked the definition of “mark” in s 2 of the Act:

Mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;

[13] Mr Padarath submitted that it is incorrect to separate a composite trademark into “word” and “image”, as they are treated separately under the legislation. A “word or words” must not make a direct reference to the character and quality of the goods (s 8(2)(d)), and a “device” must be distinctive (s 8(1)(e)). He submitted that the combination of a word and an image makes “Elements” “any other distinctive mark”. He submitted that the Judge should have recognised the appellant’s composite trademark as a “combination” of a word and a device, and should have considered the application under s 8(1)(e), pursuant to which there is no restriction on being “descriptive”, but the proposed trademark must be “distinctive”.

- [14] Mr Padarath also submitted that the Judge gave insufficient weight to the precise classification and nature of goods for which registration was sought. He submitted that the presence of a stylised plug device does not necessarily describe the core character or quality of all the goods within the specification, especially where the goods might not uniformly incorporate or require a plug. He submitted that the appellant was not registering a “male plug” as the trademark, and as a result of his conflation of embedded plug image with an actual product depiction, the Judge misinterpreted the appellant’s mark, and incorrectly deemed it “descriptive”.
- [15] Mr Padarath further submitted that the objective of s 8(1)(d) of the Act is to guard against purely descriptive or generic terms that would prevent fair competition and fail to function as an indicator of origin. He submitted that embedding a small plug device into the “n” of “Elements” does not deprive other traders of any essential means to describe or market their goods. He submitted that the Judge was wrong to suggest that the mere presence of the device undermines the mark’s differentiating function or circumvents the purpose of s 8(1)(d).
- [16] Mr Padarath submitted that “Elements” does not make direct reference to the character and quality of goods, and the Judge recognised that it is the “plug” image that does so. He submitted that the issue, then, is whether the “device” (that is, the embedded plug device) is “distinctive”. He submitted that the Judge failed to undertake this assessment and, therefore, the FIPO decision and the Judge’s upholding of it are contrary to the Act and unlawful.

The respondent’s submissions

- [17] Mr Mainavolau submitted that it is settled law that a mark must be considered as a whole: including any devices or graphic elements incorporated into the mark: thus in the present case the overall impression created by the mark must be considered, not merely the word “Element” in isolation. He submitted that the presence of a device within a word can significantly alter the overall impression on a consumer. Distinctiveness of a mark can be assessed by reference to the dominant element within the overall impression.

- [18] In the present case, he submitted, the embedded plug device is not a “negligible visual flourish”; for goods such as electric lamps, sealed beam units and ultraviolet lamps, a plug is a highly relevant and directly associated component. The average consumer here is likely to see the plug device as directly alluding to the function or nature of the electrical goods – they need a plug to operate. He submitted that the Judge was correct to consider the descriptive impact of the visual element within the overall context of the word “Elements”.
- [19] He submitted that the visual presence of the embedded plug device in conjunction with “Elements” reinforces and clarifies its descriptive nature in relation to the goods. An image of a plug visually confirms that the goods are electrical elements requiring connection to a power source: this is a visual shorthand for a key characteristic of the goods.
- [20] Mr Mainavolau submitted that allowing registration of “Elements” with the embedded plug device could indirectly grant the trademark owner a monopoly over a visually descriptive representation of a key feature of the goods. This would be contrary to the policy of the Act: that other traders should be free to use visual clues as to the electrical nature of goods in their own branding.
- [21] He submitted that the underlying principle of s 8(1)(d) is to prevent monopolisation of terms or signs that are needed by other traders to describe their goods. He submitted that if the appellant could register the trademark applied for, competitors might be hesitant to use any visual representation of a plug in their marketing, for fear of being accused of infringing the trademark, thus hindering fair competition. He submitted that the average consumer is likely to see “Elements” immediately associated with the visual representation of a plug (which is a fundamental requirement for the operation of, for example, an electric lamp or fan. He submitted this would create a strong overall impression that the trademark directly relates to the nature and function of the goods.
- [22] Mr Mainavolau submitted that the Judge correctly applied the law. Without the embedded device, “Elements” may have been non-descriptive. However, the embedded plug device unmistakably associates the mark with electrical goods. He submitted that in the context of

goods such as electric lamps, sealed beam units, and ultraviolet lamps (all electrical products) the plug device reinforces a direct descriptive reference to the character of the goods: they involve electrical elements and functionality. The combination of words and the plug device leads to the trademark referencing the character/quality of the goods within meaning of s 8(1)(d).

[23] He submitted that s 8(1)(d) must be read in light of Act's objective to prevent registration of marks that other traders ought to be able to use freely. He submitted that the objective would be easily defeated if a trader were able to escape s 8(1)(d) merely by inserting a minor device into descriptive words.

[24] Mr Mainavolau also submitted that the appellant wrongly contended that *British Sugar* does not apply in this case. He submitted that the use of the embedded plug device within "Elements" is not merely an artistic stylisation, or a fanciful or arbitrary mark, it is a "visual signal" as to the nature of the goods: goods with electrical or technological features. In context, he submitted, "Elements Beyond Expectation", reinforced by the plug device, communicates to the average consumer that the goods are advanced or innovative electrical products.

[25] He submitted that while it may be contended that the stylised nature of the mark renders it "distinctive", the appellant's submission overlooks the principle expressed in *British Sugar* that stylisation cannot shield a trademark from being "descriptive", if the overall impression conveyed remains descriptive in nature. He submitted that the plug device is a universally recognised symbol of electricity, and its deliberate inclusion strengthens rather than weakens the descriptive message.

Discussion

[26] It appears to be accepted by both parties that under s 8(1)(d) "word or words" may be registered as a trademark, provided they have no direct reference to the character or quality of the goods (that is, they are not "descriptive"). It also appears to be accepted by both parties that under s 8(1)(e) "any other distinctive mark" (which may include a "word"

combined with a “device”) may be registered as a trademark, notwithstanding that it is “descriptive”, but evidence must be provided as to its “distinctiveness”. Under s 8(1)(e), there is no prohibition against “descriptiveness”, but an application for registration relying on s 8(1)(e) must contain evidence that the mark is “distinctive”.

[27] The High Court Record includes a copy of the application for registration submitted by the appellant, as well as an amended application (which does not appear to include any amendment relevant to this discussion). The amended application was signed by the appellant’s solicitor on behalf of the appellant and submitted together with an Information Sheet certified by the appellant’s solicitor, on behalf of the appellant. It is evident from Part II (“Grounds of Application”) of the Information Sheet that the application was made under s 8(1)(d): the appellant completed the section which was headed:

(Complete this section only if the mark is a name, signature, invented or other word)

[28] The Information Sheet required an answer to section 2 of the “Grounds of Application”:

2. The foregoing application is made upon the following grounds, namely that the trade mark contains one or more of the following essential particulars referred to in section 8 subsection (1) paragraph (a) to (d) of the Trade Marks Act:

In response to section 2, the Appellant ticked the box to indicate that the trademark was made under s 8(1)(d):

It consists of a word or words which have no direct reference to the character or quality of the goods and is not a geographical reference or a surname.

[29] The appellant did not complete the section headed:

(Complete this section if mark is not a name, signature, invented or other word or if there is likely to be some question raised concerning distinctiveness)

[30] Nor did the appellant submit any evidence as to the mark’s distinctiveness, notwithstanding the words in bold capitals at the foot of the Information Sheet:

NB EVIDENCE OF DISTINCTIVENESS IS REQUIRED FOR ALL TRADEMARKS EXCEPT THOSE WHICH FALL WITHIN SECTION 8(1)(a) TO (d).

[31] In the light of the appellant’s insistence that “Elements” with the plug device embedded in the “n” is not a “word”, and that s 8(1)(e) rather than s 8(1)(d) was the appropriate provision for registration, its application for registration under s 8(1)(d) and subsequent appeals were misconceived. As Mr Padarath submitted, the appellant’s proposed trademark was not a “word or words”. Therefore, the appellant could not expect it be registrable under s 8(1)(d).

[32] The Judge did not make an error of law in dealing with the application as it was before him – an application under s 8(1)(d) – and the appellant neither made an application under s 8(1)(e), nor submitted any evidence as to the proposed mark’s distinctiveness.

[33] The appellant has not established that the Judge made an error of law in upholding FIFO’s refusal to register the “Elements’ with an embedded plug device as a trademark, and the appeal must therefore be dismissed.

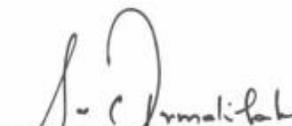
Andrée Wiltens JA

[34] I agree.

ORDERS:

- (1) The appellant’s appeal is dismissed.
- (2) The appellant is ordered to pay costs of \$5000 to the respondent, within 21 days of the date of this judgment.




Hon. Mr. Justice Chandana Prematilaka
RESIDENT JUSTICE OF APPEAL


Hon. Madam Justice Pamela Andrews
JUSTICE OF APPEAL


Hon. Mr. Justice Gus Andrée Wiltens
JUSTICE OF APPEAL