

**IN THE HIGH COURT OF FIJI  
(WESTERN DIVISION) AT LAUTOKA  
CIVIL JURISDICTION**

**CIVIL APPEAL NO. HBM 65 OF 2020**

**BETWEEN** : **GLASS & MIRROR (FIJI) PTE LIMITED** a limited liability Company having its registered office at Shop 6 Ba Market Sub-Division, P O Box 9, Ba, Fiji.

**APPELLANT**

**AND** : **THE ATTORNEY GENERAL OF FIJI** as a representative of The Fiji Intellectual Property Office (Copyright, patents & Trademarks, Traditional Knowledge & Expressions of Culture) Level 3 Suvavou House, Victoria Parade, P O Box 2213, Government Buildings Suva, Fiji

**RESPONDENT**

**BEFORE** : Hon. Justice Mohamed Mackie

**APPEARANCES** : Mr. Padarath, for the Appellant  
Mr. Mainavolau, for the Respondent

**DATE OF HEARING** : 5<sup>th</sup> October, 2022.

**INITIAL WRITTEN SUBMISSIONS:** By both the parties on 5<sup>th</sup> October, 2022.

**FURTHER WRITTEN SUBMISSIONS:** By the Respondent on 24<sup>th</sup> October, 2022.

**REPLY SUBMISSIONS** : By the Applicant on 21st November, 2022.

**DATE OF JUDGMENT** : 7<sup>th</sup> March, 2023

**JUDGMENT**

**INTRODUCTION:**

1. Before me is an Appeal preferred by, GLASS AND MIRROR (FIJI) PTE LIMITED (“the Appellant”), against the decision of the **Fiji Intellectual Property Office (FIPO)** (“the Respondent”) to refuse the registration of the Appellant’s trademark more fully described in the prayer 2 of paragraph 2 and depicted in paragraph 18 below.
2. The Appellant by its Notice of Originating Motion ( “Application”) filed the aforesaid Appeal on 09<sup>th</sup> December , 2022 seeking the following Orders;

1. *The appellant be granted leave to lodge and serve this Appeal out of time if required.*
  2. *The decision by the Fiji Intellectual Property Office to refuse the registration of the trademark "Cyclone Safe" with 2 window and wind swirl devices ( as fully described in the Application with reference trademark number 275/2020 ) on the grounds that it is not permitted under section 8 (1) (d) of the Trademarks Act 1933 be set aside;*
  3. *The Respondent accept and register trademark " Cyclone Safe" with two window and two swirl devices as fully described in the Application with reference Trademark number 275/2020.*
  4. *And that the costs of an incidental to this Appeal be paid by the Respondent.*
3. The Application is supported by an Affidavit sworn by, **Amit Pratap**, Financial Accountant of the Appellant company filed on 9<sup>th</sup> December, 2020, along with annexures "AP1" to "AP4". The Respondent on 9<sup>th</sup> April, 2021 filed its Affidavit in opposition sworn on 7<sup>th</sup> April, 2021 by one **Sanjay Ram**, an Executive Officer, together with annexures marked as "SR-1" to "SR 3". The Appellant opted not to file Affidavit in reply.
  4. The Appeal is made pursuant to Order 100 of the High Court rules 1988 and inherent jurisdiction of this Court. In addition to the oral arguments advanced at the hearing, parties have filed their respective written submissions as stated above.

**GROUND OF APPEAL:**

5. The grounds of appeal relied on by the Appellant, as per paragraph 5 of the Notice Originating Motion, are as follows.
  - 5:1. *The Respondent erred in rejecting the application for trade mark on the grounds that the words 'Cyclone Safe' bears a direct reference to the character of goods classified as glass, when:-*
    - 5.1.1. *Adequate reasons were not given by the Solicitor General as to how the phrase makes reference to the character or quality of goods.*
    - 5.1.2. *The two words "cyclone" and "safe" have been put together in a distinct way and is created by the Appellant.*
    - 5.1.3. *The phrase "cyclone safe" is not commonly or uniquely used to describe goods falling within the classification of glass, such as window and plate glass, painted glass, glass mosaic, glass beads".*
    - 5.1.4. *The phrase Cyclone Safe is distinct and therefore falls within the provision of section 8 (1) of the Trademarks Act 1933.*

5.2. *The Respondent erred in not seeking further information from the Appellant and in particular to consider the extent to which the appellant has used the trademark and is known for it.*

### **FACTS IN BRIEF**

6. The Appellant's Affidavit in support, inter-alia, states, THAT:-
- a. An Application was made by it to the Respondent (FIPO) on 28<sup>th</sup> August, 2022 to register the Trademark shown in the annexure "AP-1" to the Affidavit in support.
  - b. The Respondent, (FIPO), as per its letter dated 14<sup>th</sup> October, 2020 marked as "AP-2", rejected the said Application without giving any reason/s.
  - c. The Appellant's Lawyers on 16<sup>th</sup> October, 2020, as per annexure marked as "AP-3", wrote to the FIPO seeking reasons for the refusal.
  - d. By a letter dated 6<sup>th</sup> November, 2020, marked as "AP-4" and delivered to the Appellant's Lawyer's Office via facsimile on 11<sup>th</sup> November, 2020, the reasons for refusal were given. However, as the original of the said letter was not promptly served on their Lawyer's Office, the Appeal could not be lodged in time.
7. The Respondent FIPO by its Affidavit in opposition, admitted the receipt of the Appellant's "AP-1" Application, the refusal of the Application by their letter marked "AP-2", the receipt of the "AP-3" letter from the Appellant's Lawyers seeking reason for refusal, and informing the Appellant's Lawyers the reason for the delay by letter dated 6<sup>th</sup> November, 2020 marked as "AP-4". But, the Appellant denied the paragraphs 9 and 10 of the Affidavit in support, which are on the receipt of the letter "AP-2" and the alleged delay in giving the reason.

### **LAW & ANALYSIS:**

#### **Is the Appeal Out of Time?**

8. The First Respondent do not dispute that the letter dated 6<sup>th</sup> November, 2020, with reasons for refusal, was faxed to the Appellant's Lawyer's Office only on 11<sup>th</sup> November, 2020.

Further, the First Respondents has not adduced any evidence to substantiate that the original of the said letter dated 6<sup>th</sup> November, 2020 was in fact promptly posted to or served on the Appellant or their Lawyers. Hence, I accept the reason adduced by the Appellant for the delay in filing the Appeal and decide to proceed with the Appeal notwithstanding the laps of the appealable time.

#### **The Substantive Matter:**

9. The substantive issue that begs adjudication through this Appeal is whether the , purported, reason given by the Respondent by letter dated 6<sup>th</sup> November,2020 was sufficient in justifying the refusal to register the Appellant’s Trademark described above.
10. The relevant parts of the letter dated 6<sup>th</sup> November,2020 containing the impugned decision of the FIPO reads as follows:-

Dear Mr. Ram.

6<sup>th</sup> November, 2020.

**Grounds for refusal – Trademark no. 275/2020.**

1. *We refer to the abovementioned application ( application) to register the Trade-mark “ Cyclone Safe” with two window and a wind swirl devices ( Trademark)*
2. *We refer to your 16<sup>th</sup> October, 2020 letter requesting the grounds of refusal to register the Trade-mark.*
3. *During legal examination, it was noted that the classification of goods is ‘Glass, such as window and plate glass, printed glass, glass mosaic, glass beads.’ As such, the Trade mark bears a direct reference to the character of the goods, and is therefore, contrary to section 8(1) (d) of the Trade-marks Act 1933. (Emphasis mine)*
4. *Given this, the Trade-mark has been refused.*
5. ..

11. Section 8 (1) of the Trademark Act 1933 states as follows;

**Trade marks. What marks are registrable as such?**

- 8.-(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 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; (emphasis mine)*
  - (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:*

**APPELLANT’S SUBMISSIONS:**

12. The goods that were sought to be covered by the said Trademark, according to the Appellant , are Glass based products, such as Windows and plate glass, painted glass, glass mosaic and glass beads. The Appellant complains that “*the grounds given for the refusal are vague; it simply noted that the mark made a direct reference to the character*

*of the goods. As such it is very difficult to ascertain the particulars or the reasons of how the Respondent arrived at the conclusion and such reasons were inadequate”.*

13. Learned Counsel for the Appellant , in this regard drew my attention to paragraph 61 of the Court of Appeal of Fiji judgment in ***Prasad v State (2018) FJCA AAU0010/2014 (4<sup>th</sup> October,2018)*** .Counsel for the Appellant also alluded to a decision in this regard in ***Commonwealth v Pharmacy Guild of Australia (1989) 91 ALR 65-88***
14. Appellant’s Counsel argued that the case law Authority in ***Asia Brewery Inc v The Hon. Court of Appeals and San Miguel Corp GR No-103543*** relied on by the Respondent will not assist the Respondent to advance its position that the words “Cyclone safe” in this case is descriptive and directly relates to the classification of goods. Accordingly, the Appellant’s Counsel argued that the word “**Cyclone safe**” is not a descriptive word and the terms used in this context do not bear any direct reference to the classification of goods concerned. However, counsel in paragraph 23 of his written submissions concedes ***‘on the face of it, glass products with the product name as “CycloneSafe” may suggest that the glass is safe against a Cyclone’*** and argues that however, a mere suggestion will not tantamount to a direct reference.
15. In conclusion, counsel for the Appellant submits that the Respondent was under duty to give adequate reasons for refusal of the Trademark “CycloneSafe” for registration, the one paragraph explanation given on 6<sup>th</sup> November, 2020 is inadequate, and the mark “Cyclone Safe” is not a word or words that bear a direct reference to the character or quality of the goods. Counsel argued further that it is not a descriptive word that is generally used in the context of glass manufacture of fabrication.

#### **RESPONDENT’S SUBMISSIONS:**

16. Conversely, learned Counsel for the Respondent argued that the word “CycloneSafe” is considered to be descriptive under Section 8(1) (d) of the Trade-mark Act of 1933.
17. A descriptive Trademark is the one where either the word or picture(s) in the Trademark describes the goods upon which the Trademark will be used and such Trademarks, under the Trademarks principles, are an absolute bar to registration.

Counsel for the Respondent heavily relied on **Asia Brewery Inc**, where the Court held that words ‘Beer pale pilson’ could not be registered because they were descriptive words. The Court has emphasized this by saying that the descriptive words such as ‘**evaporated milk**’ or ‘**cooking oil**’ which are generic or descriptive in nature cannot be appropriated by anyone person, because they belong to the public domain.

My attention was drawn to the page 8 of this **Asia case** Judgment, where the Court has stated ***“no person can appropriate to himself exclusively any word or expression, properly descriptive of the article, its qualities, ingredients or characteristics ... if they are thus descriptive, and not arbitrary, they cannot be appropriated from general use and become the exclusive property of anyone.”***

Respondent's Counsel submits that the Asia case judgment applies to the 'Cyclone safe' Trade mark given that the window and devices, relate directly to the classification of goods

**MY DECISION:**

18. For the purpose of better manifestation, I shall reproduce below the image of the Trademark submitted by the Appellant, which was refused by the FIPO.



19. In the matter at hand, the word or words "**CycloneSafe**" is only a part of the disputed Trademark. Vide the images in paragraph 18 above. It also accompanies an image of a window and wind device (swirl), of which the character and quality are described by those very word or words "Cyclone safe", with no semblance of ambiguity.
20. In other words, the disputed wordings refer directly to none other than the very character and quality of the glass products of the Appellant. This in my view, is not a mere description to the public/ customers as argued by the learned Counsel, for the Appellant in paragraph 23 of his initial written submissions.
21. In re *Boston Beer Co. Ltd. Partnership*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999), the Court of Appeals for the Federal Circuit has reinforced the principle by asserting, "**A phrase or slogan can be so highly laudatory and descriptive as to be incapable of acquiring distinctiveness as a trademark.**" This statement was made in relation to the slogan, "THE BEST BEER IN AMERICA" for beer and ale. It was stated:-
- "Marks that are merely laudatory and descriptive of the alleged merit of a product are also regarded as being descriptive. . . . Self-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods".*
22. However, in the case at hand, it is argued that the phrase/slogan that the Appellant has utilized "**CycloneSafe**" is merely descriptive of the merit of the product and fails to achieve distinctiveness over the other products in the market.
23. Even in the absence of the accompanying images of the window and wind device (swirl), the very term "**CycloneSafe**" is capable enough of attracting customers, which directly

refers to the quality and character of goods and may bestow an undue advantage/benefit over other competitors in the market.

24. A single entity in the market cannot be allowed to monopolize a term of this nature. The reason being, among others, it may project a wrong picture in the minds of the customers that the goods produced and marketed by the Appellant are the only goods that offer protection from cyclones.
25. The customer/ the General public in Fiji , who are more prone to Cyclones and resultant disasters almost every year, at the very first sight this phrase / slogan , are more likely to be attracted and convinced by direct reference to the character or quality of the goods concerned, for their choice over the other similar products in the market.
26. Learned Counsel for the Appellant in paragraph 7 of his reply written submissions has stated that *"The combination of two words have different meanings **unless and until the context of the usage is made clear.** A general consumer will not think that the word "CycloneSafe" will refer to glass products **unless and until something more is provided.**"*

I beg to disagree with the Counsel on the above argument. The reason being the very Trademark itself comprises an image of the Window and a wind device (swirl) in addition to the words "CycloneSafe". This provides the sufficient context for the usage of the words, to a general consumer, who's first thought, undoubtedly, would be that it refers to building materials such as glass products, among others.

27. I find that the argument advanced for the Appellant is supported by ***Procter & Gamble v OHIM Case C-383/99*** in which the European Court of Justice held that where a mark consist of a combination of descriptive signs or indications, any perceptible difference between the combination as a whole and its constituent descriptive elements would be apt to confer distinctive character enabling it to be registered as a trademark. Therefore, in that case while the words "Baby" and "Dry" were found to be descriptive of the function of Diapers, the combination "Babydry" was held to be registerable because of the "syntactically unusual juxtaposition"

However, in the case at hand there is no perceptible difference between the words "Cyclone" and "Safe" so as to confer distinctive character on the combination. The Words "Cyclone" and "Safe" are usual common combination, because the word "Cyclone" goes hand- in – hand with the word "Safe". Therefore, the combination "CycloneSafe" lacks distinctiveness and cannot be registered. Therefore, in my view, the above authority will not help the Appellant.

28. Even the slogan "CycloneSafe", if taken in isolation, when heard or seen , the first impression or thought that one generally entertains is in relation to the safety of himself/ herself and his/her dwelling . Therefore, in search for suitable building materials, the mere reading, seeing, hearing of the particular term will drive him/her to believe that the particular goods sold by the Appellant are the only goods in the market, which offer protection from cyclones.

29. In **Asia Brewery judgment (supra)** , the Court held that *“no person can appropriate to himself exclusively any word or expression , properly descriptive of the article, its qualities, ingredients or characteristics ... if they are thus descriptive , and not arbitrary , they cannot be appropriated from general use and become the exclusive property of someone.”*
30. In view of the above, I find that the allegation levelled by the Appellant against the Respondent FIPO that the grounds adduced to refuse the Registration are insufficient, is unfounded. The word “CycloneSafe” in isolation and/ or in conjunction with the image of the window glass, wind device (swirl) clearly describe the character and quality of goods sought to be protected by the impugned Trademark

**CONCLUSION:**

31. In light of the foregoing, the inescapable conclusion that I can arrive at is that the reasons given for the refusal of the Trademark shown above is sufficient and no blame can be pinned on the FIPO as the refusal is justified in terms of section 8(1) (d) of the Trademark Act of 1993 and in light of the case law authorities mentioned above.

**FINAL OUTCOME:**

- a. The Appeal is dismissed.
- b. The decision of the Fiji Intellectual Property Office, to refuse the registration of the Trademark in question, is upheld.
- c. The Respondent is entitled to a sum of \$750.00 from the Appellant being the summarily assessed costs.
- d. The costs shall be paid within 28 days from today.

  
**A.M. Mohamed Mackie**  
Judge



At High Court Lautoka this 07<sup>th</sup> day of March, 2023.

**SOLICITORS:**

For the Plaintiff:

Messrs. Samuel Ram Lawyers

For the Respondent:

Office of the Attorney-General