

IN THE SUPREME COURT OF FIJI

Appellate Jurisdiction

Miscellaneous Civil Causes Appeal No. 7 of 1959

Between:

PARBHUBHAI DALPATBHAI PATEL Appellant

v.

THE ACTING REGISTRAR-GENERAL Respondent

Trade Marks Ordinance (Cap. 189)—application to register trade marks rejected under s. 18—principles to be followed by Registrar-General when application opposed.

The appellant's application to register a trade mark was opposed by the proprietor of another registered trade mark. The respondent rejected his application under s. 18 of the Trade Marks Ordinance (Cap. 189), the relevant words of which are: . . . "no trade mark shall be registered . . . which is identical with one belonging to a different proprietor . . . or so nearly resembling such a trade mark as to be calculated to deceive." The appellant appealed to the Supreme Court.

*Held.*—(1) There is one principle that does emerge from the English cases and that is how strictly the Registrar is required to act when opposition is made to the registration of a new trade mark. An applicant is required to satisfy the Registrar on the very strongest grounds that the trade mark is not likely to deceive. If the Registrar considers there is doubt as to whether deception is likely the application should be refused.

(2) In the circumstances of this case the appellant's application was properly rejected by the respondent.

*Appeal dismissed.*

R. I. Kapadia for the appellant.

R. A. Kearsley for the respondent.

KNOX-MAWER, Ag. J. [25th November, 1959]—

This is an appeal instituted under section 35 of the Trade Marks Ordinance (Cap. 189), against the decision of the Registrar-General, rejecting the appellant's application for registration of a trade mark.

The appellant applied under section 11 of the Ordinance (Cap. 189), to register the trade mark which has been exhibited in this Court Exhibit I. He sought registration of this trade mark in respect of the following goods:—

Hair oil, cosmetics, hair dye, perfumery, toilet goods, textiles, sundry goods and other manufactured articles.

He applied for registration in Class 48 of the Classification of Goods specified in the Schedule to the Trade Marks Rule made by the Chief Justice in 1913 in pursuance of subsection 3 of section 13 of the Trade Marks Registration Ordinance, 1886. This Rule, the schedule to which sets out the classification of goods for the purposes of trade marks registration in the Colony,

is to be found in Council Paper No. 34 of 1913. There is no suggestion that this rule has been superseded by any other rule or rules. It therefore continues to be in force by virtue of section 67 of the Trade Marks Ordinance (Cap. 189). It is observed that in the 1955 revised edition of the Laws of Fiji, volume VI, this particular subsidiary legislation is omitted, although it is still operative.

The appellant's application for registration was opposed by one Mayawati (d/o Ram Ritu), the proprietor of trade mark No. 2242 registered on the 18th May, 1955, and exhibited in this appeal Exhibit 2. This trade mark is registered in class 48 for perfumery and cosmetics.

After hearing the parties and considering the evidence, the Acting Registrar-General recorded a decision on 25th August, 1959, rejecting the appellant's application.

The Registrar-General has rejected the application on the ground that it offends section 18 of the Trade Marks Ordinance (Cap. 189). Section 18 follows section 90 of the Trade Marks Act, 1905. The English case law is fully considered in Chapter XVII of Kerly on Trade Marks 7th Edition p. 612 et seq. The learned Registrar-General has reviewed a number of the authorities cited in Kerly in two earlier judgments, where the same opponent successfully objected to the registration of two other trade marks. However, in so far as the decided cases have necessarily turned on the facts of each case, they are of limited assistance.

Certainly there is one principle that does emerge from the English cases and that is how strictly the Registrar is required to act when opposition is made to the registration of a new trade mark. An applicant is required to satisfy the Registrar on the very strongest grounds that the trade mark for which he seeks registration is not likely to deceive. Indeed according to Kerly, *supra* at p. 619, a weaker case than would entitle a plaintiff to succeed in an action for infringement would enable an opponent to object successfully to the registration of a new mark. For a refusal to register does not necessarily involve the conclusion that the resemblance is such that either an infringement action or a passing off would succeed. In cases in which the Registrar considers that there is doubt as to whether deception is likely, the application should be refused.

The persons to be considered—are of course all who are likely to be purchasers of the goods, provided that such persons use ordinary care and intelligence. In the instant case, it is common ground that amongst the main purchasers of the appellant's goods will be Fijian villagers some at least of whom will be unable to read.

Moreover, it is the principal characteristic or characteristics of the marks which must be considered. Two marks when placed side by side may show various differences yet the main idea left on the mind by both may be the same. As Sargant J. in *Sandow's Application* 1914, 31 R.P.C. 196 p. 205 has said: "The question is not whether if a person is looking at two trade marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other of which he has a general recollection".

In the present case there are certainly various differences between the two marks Exhibit I and Exhibit 2. In particular the respective words above the figure of the Fijian girl in each mark are quite different. It must not, however, be overlooked that the opponent's trade mark can be produced in any colour. Certainly, therefore, the appellant cannot show as unreasonable the inference that a simple illiterate villager seeking in this connection, the mark he knows, would look for a label bearing a picture of a young Fijian woman wearing a hibiscus flower on the left side of her hair, a salusalu, and a dress which leaves the shoulders bare. All this he will equally find on the appellant's mark, as on the opponent's mark.

In these circumstances, I think the appellant's application was properly rejected. This appeal must accordingly be dismissed.

LAULA KAHU AND OTHERS

The first two respondents, who were musicians, each held a permit to enter and reside in the Colony issued by the Principal Immigration Officer. The permits contained the condition that each respondent "will be employed by the Fiji Mosaic Hotel and will remain in the employment for the duration of the permit; and will report to the Principal Immigration Officer if he ceases to be an employer." The Principal Immigration Officer purported to impose this condition under s (2) of the Immigration Ordinance (Cap. 67) which provides as follows:—

The Principal Immigration Officer may issue a permit to any person entering him to enter and reside or remain in the Colony upon such conditions as to the security in the possession or occupation of property which the holder may exercise or engage in within the Colony, and to any other matter which appears to the Officer to be necessary for the public interest. The Officer may also issue a permit to any person entering him to enter and reside or remain in the Colony upon such conditions as to the security in the possession or occupation of property which the holder may exercise or engage in within the Colony, and to any other matter which appears to the Officer to be necessary for the public interest.

The first two respondents of the Fiji Mosaic Hotel while the permits were still operative and took up employment as musicians with the respondent. Both the first two respondents and the fourth respondent reported to the Principal Immigration Officer. Subsequently the first two respondents were charged with failing to comply with the condition in their respective permits in that each remained an employer with the Fiji Mosaic Hotel contrary to section 2 (1) and (2) of the Immigration Ordinance. The third and fourth respondents were charged with harboring the first two respondents contrary to section 2 (1) and (2) of the Immigration Ordinance. The third and fourth respondents were charged with harboring the first two respondents contrary to section 2 (1) and (2) of the Immigration Ordinance. The third and fourth respondents were charged with harboring the first two respondents contrary to section 2 (1) and (2) of the Immigration Ordinance. The third and fourth respondents were charged with harboring the first two respondents contrary to section 2 (1) and (2) of the Immigration Ordinance.

(1) Was the condition imposed on persons (Kahu and others) who entered the Colony in their immigration permits that they must remain in the employment of the Fiji Mosaic Hotel a valid condition lawfully imposed?