

JAMAICA

IN THE COURT OF APPEAL

SUPREME COURT CIVIL APPEAL NO. 3/83

BEFORE: THE HON. MR. JUSTICE KERR, - PRESIDENT (AG.)
THE HON. MR. JUSTICE CARBERY, J.A.
THE HON. MR. JUSTICE WHITE, J.A.

BETWEEN: GUINNESS JAMAICA LIMITED - APPLICANT/APPELLANT
A N D : GENERAL FOODS CORPORATION - OPPONENT/RESPONDENT

Mr. E. George, Q.C., and Mr. D. Coffe instructed by
Mr. K. Robinson for the Appellant.

Mr. R.N.A. Henriques, Q.C., and Mr. A. Rattray for the Respondent.

November 2-4, 7 & 8, 1983; and November 18, 1985

KERR, P. (AG.):

The appellant Company, Guinness Jamaica Limited (hereinafter referred to as Guinness) applied for Registration of the mark "Ting" in respect of the manufacture for sale of a "grapefruit drink". This application was originally refused by the Registrar on the grounds of similarity to the registered mark "Tang" but subsequently was accepted and advertised pursuant to Section 20(1) of the Trade Marks Act (hereinafter referred to as the Act).

The respondent, a Corporation (hereinafter referred to as General Foods), "organised and existing under the laws of the State of Delaware, U.S.A." is the proprietor of the mark "Tang" and took up the challenge presented by the advertisement by opposing the application in respect of "Ting". In a tit-for-tat move Guinness applied to the Registrar for the removal from the Register of the mark "Tang."

There were two applications - the first dated 2nd March, 1977 on the following ground:

"Up to the date one month before the date of this application a continuous period of five (5) years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to 'powdered preparations for making non-alcoholic beverages' by any proprietor thereof for the time being."

And the second dated 24th April, 1979, was based on two grounds:

- "1. The word TANG is so common to the trade in food and beverages that its use as a trade mark on or in relation to any powdered preparations for making non-alcoholic beverages would be likely to deceive or cause confusion or otherwise, and the trade mark TANG offends against the provisions of Section 13 of the Trade Marks Act and ought never to have been registered.
2. The trade mark TANG is not adapted to distinguish the powdered preparations for making non-alcoholic beverages of General Foods Corporation from those of other persons."

The mark "Tang" had been registered as far back as November 2, 1964 for the manufacture and sale of "powdered preparations for making non-alcoholic beverages."

At the hearing before the Registrar, evidence was tendered to the effect that despite the earnest endeavours by General Foods since 1972 there was no significant production of "Tang" because General Foods could not overcome certain adverse circumstances. The Registrar accepted that evidence and held, quite properly in my view, that such non-use of the mark was due to special circumstances and not to any intention not to use or abandon the mark and, accordingly, General Foods ^{is} entitled to rely on Section 28(3) of the Act which provides:

"An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1), or for the purposes of subsection (2), on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates."

["Applicant" being a person aggrieved seeking removal of a registered mark].

She then considered the application on the grounds that the mark offends Section 13 and is not within Section 11 (1) (d) of the Act and held:

"I agree with the applicants that the mark is utterly descriptive of the opponents' product or otherwise deceptive. The word is in fact common to the trade and no one trader should be entitled to the right of its exclusive use. The mark is therefore not distinctive and should never have been registered. Although I admit that a descriptive word may become distinctive, it is necessary to establish extensive use of the mark which was not so in this case. Although the opponents contend that wide use, publicity, marketing and advertising required more cogent evidence of confusion it was not established by them that their mark was widely used, published, marketed or advertised in Jamaica. What use there was in Jamaica was indeed meagre and they cannot therefore claim any public reputation in the mark locally.

In the recent Hy-Line case reported at 1979 R.P.C. 410 advertising in overseas publications circulated locally was relied on to establish reputation of the mark and in the Sheraton case reported at 1964 R.P.C. 202 notice was taken of reputation locally despite the fact business was primarily carried on abroad. In both these cases however it should be noted there was either local circulation of the publications or local reputation of the mark.

In the case before me there was certainly an absence of evidence to support either wide publication or reputation in Jamaica.

The mark is descriptive without being distinctive or otherwise deceptive and offends against section 13 of the Trade Marks Act.

I therefore order that the Trade Mark Yang No. 10527 be expunged from the register pursuant to section 34 of the Trade Marks Act."

On appeal by General Foods, Walker, J. considered (1) - Section 15(1) of the Act which reads:

"In all legal proceedings relating to a trade mark registered in Part A of the Register (including applications under section 34) the original registration in Part A of the Register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless -

- "(a) that registration was obtained by fraud; or
- (b) the trade mark offends against the provisions of section 13."

And (2) the following dicta in the speech of Lord Diplock in G. H. (Trade Mark) 1973 R.P.C. at p. 333:

"What section 41 did was to preclude removal of a trade mark from the register after seven years upon any ground of invalidity, such as lack of distinctiveness, which would have applied to the original registration. What it did not do, was to preclude removal of a mark from the register if it had become likely to deceive as a result of blameworthy conduct by its proprietor since the date of its original registration."

And held:

"Accordingly, insofar as the Registrar's decision was based on a finding that the appellant's trade mark was objectionable and liable to expunction from the Register as being descriptive without being distinctive, that decision was patently wrong, and I so find."

Counsel for the appellant frankly agreed with this eminently correct interpretation.

Walker, J. however, in allowing the appeal rejected the contention that the trade mark "Tang" was "inherently vicious and that, as such, its use was at the date of application for registration likely to deceive or confuse the public" and en route to this conclusion the learned Judge had this to say:

"Now comes the main question which arises on this appeal, namely the question whether at the date of application for registration of the appellant's trade mark, the use of the mark was likely to deceive or cause confusion in such a manner as to be disentitled to protection in a court of justice. If such a likelihood existed at that time the mark ought not to have been registered and consequently, the Registrar's decision would be sustainable."

He then considered the relevant provisions of the Act, and in particular Sections 13 and 46 and continued:

"I think that the question must, therefore, be asked: what evidence was there adduced before the Registrar on the basis of which she could properly have come to the decision at which she arrived? The answer is, of course, none except evidence of the appellant's intention to use the word "TANG" as its trade mark which, if the use of that word was likely to deceive or cause confusion, would have provided such evidence. There could hardly have been any other evidence given the factual position that the appellant's product had not been marketed in Jamaica prior to the date of application for registration of the mark in 1964, had been sold insignificantly in Jamaica between the years 1964 to 1970 or 1971, and most certainly had not been sold in Jamaica since 1971. Hence counsel for the respondent's submission that the likelihood of deception and/or confusion lay in the mark itself. Then, again, this was not a case involving a similarity between two trade marks as was the situation in the Bali Trade Mark, C.E. Trade Mark and Eno v. Dunn cases. It was not argued by counsel for the respondent that the appellant could lawfully have used their trade mark for the manufacture of products other than powdered preparations for making non-alcoholic beverages for which the mark was registered. In point of fact, in answer to the court during the hearing of this appeal, Mr. George said that this was not his contention. It cannot, I think, be gainsaid that the Trade mark TANG did not permit of the manufacture of a product differing basically from the product for which the mark was registered. Indeed it is on this basis that I should be prepared to distinguish from the instant case the Orlwoola and Chef cases so heavily relied on by counsel for the respondent. In the Orlwoola case the word 'Orlwoola' was held to be objectionable because it represented a trade mark which was for articles made not only of wool but of worsted and hair and the word as spoken was likely to deceive the public. Similarly in the Chef case the word 'Chef' was rejected as a trade mark on the ground that the use of the word on printed matter would have conveyed a direct reference that the goods concerned cookery or would be of interest to cooks when in fact the mark might have been used in respect of goods not so related. In the instant case the test of whether or not the appellant's product has a penetrating taste or flavour must, ultimately, be a subjective one. Just as beauty lies in the eye of the beholder, so does a penetrating taste or flavour (i.e. a tang) lie in the gustatory faculty of the consumer."

As all the grounds of appeal are in relation to the question, identified by Walker, J., in the passages quoted above, it is perhaps convenient to consider them comprehensively and

for easy reference I quote the operative parts:

- " (i) That the Learned Trial Judge erred when he held that:

'In the instant case the test of whether or not the appellant's product has a penetrating taste or flavour must, ultimately, be a subjective one. Just as beauty lies in the eye of the beholder, so does a penetrating taste or flavour (i.e. a tang) lie in the gustatory faculty of the consumer.'

The subjective nature of a tang is totally irrelevant to the case. The fact is that the word "Tang" has a meaning in the English language, namely a penetrating taste or flavour. Accordingly it must mean that some non-alcoholic beverages have a tang and some do not. The question is not which beverages have a tang and which do not. So long as the trade mark TANG can be used in relation to beverages which do not have a tang, then that of itself is enough to disqualify the mark and disentitle it to protection in a Court of Justice by reason of its being likely to deceive or cause confusion.

- (ii) The Learned Trial Judge erred in attempting to distinguish the case of H. N. BROCK & CO. LTD. (1910) 1 Ch. 130 (otherwise called the ORLWOOLA case) and the case of THE CHEF Trade Mark (1979) R.P.C. 143 from the instant case. It is submitted that these cases are on 'all fours' with the instant case.
- (iii) The Learned Trial Judge erred when he rejected the submission that at the date of the application for registration of the trade mark TANG its use was likely to deceive or confuse the public.
- (iv) Even if, which is denied, the subjective nature of a tang is relevant to the case as the Learned Trial Judge thought, it is submitted that this could not mean that it could not be ascertained whether or not a beverage had a tang. The proper test in those circumstances would be whether in the opinion of the normal, reasonable person the beverage had a penetrating taste or flavour.
- (iv) The learned Trial Judge held that (page 8 of his Judgment, lines 1 to 4):

'It cannot, I think, be gainsaid that the Trade Mark TANG did not permit of the manufacture of a product differing basically from the product for which the mark was registered.'

"In view of this, so long as the Trade Mark TANG could permit the manufacture of a product without a tang then such a trade mark should be disentitled to protection in a Court of Justice."

In support of these grounds Mr. George submitted that in view of Section 6 of the Act, registration gives exclusive right to the use of the mark in relation to all goods covered by it and accordingly the mark permits the manufacture of drinks not having a "Tang"; - that tang in the ordinary meaning of the word means "a penetrating taste or flavour," and therefore the subjective test used by Walker, J. was totally irrelevant. He then drew a distinction between cases where the original registration was unobjectionable but subsequent events tended to render it invalid by virtue of its likelihood to deceive or cause confusion to members of the public and cases where the registration was invalid at the start. He cited the G. E. Trade Mark (1973) (supra) as illustrative of the former and Berlei (U.K.) Ltd. v. Lali Brassiere Co. Inco. (1969) 2 All E.R. p. 812 of the latter; that the finding of the Registrar that the mark was likely to deceive or cause confusion ought to be respected. In this he relied on the case of H. N. Brock & Co. Ltd. (1910) 1 Ch. 130 (otherwise called the Orlwoola case).

Further, that real importance should be given to the question whether exploiting the trade mark to its fullest extent would permit the user to produce drinks without a 'tang.' He cited in support The Chef Trade Mark (1979) R.P.C. 143, and Huggars Trade Mark (1977) Fleet Street Reports 310.

In reply Mr. Henriques submitted that to expunge a registered mark the burden of proof lies upon the applicant, and that the registered mark enjoyed the benefit conferred by Section 46 of the Act. Therefore the applicant must satisfy the Court:

- (1) That the mark offends Section 13 of the Act in that -
 - (a) it was likely to cause confusion to or deceive members of the public and
 - (b) to the extent, that it would be disentitled to the protection of the Court.

The Court will only come to such a conclusion if there is real and tangible danger of confusion and that the mere fact that the word was descriptive was not sufficient. He submitted that the Orwoola case was distinguishable as the goods to be manufactured were specifically described and were not in keeping with the mark and the same may be said of The Chef case.

These contending submissions will now be considered against the background of certain cases cited or referred to in argument.

Now Mr. George's complaint concerning the learned judge's subjective treatment was based upon a critical interpretation of a sentence in the passage quoted above and containing the romantic notion "beauty lies in the eye of the beholder." As Shakespeare more specifically put it "[the lover] - sees Helen's beauty in a brow of Egypt." Notwithstanding the truism in such cliches were a beauty to be described as junoesque, even to Lilliputian eyes the phrase would conjure up a beautiful woman of magnificent proportions and queenly deportment. However, it would be a disservice to the judgment to interpret this passage as the sole basis for the decision. It should be considered in relation to what preceded. In so doing, I interpret Walker, J. to be saying that because of the impreciseness of "Tang" as a descriptive word the reality of its existence was so dependent upon the opinion of the consumer, that there was no likelihood of real or substantial deception to the public.

In my view, in cases of this nature, it would be unrealistic to ignore idiosyncratic considerations. The part played by personal opinion in determining cases where the senses of the ordinary man render him competent to express an opinion was recognised and expressed in lucid language by Lord Diplock in G. E. Trade Mark (1973) R.P.C. 297 at p. 321:

"My Lords, where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialised market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential. A judge, though he must use his common sense in assessing the credibility and probative value of that evidence is not entitled to supplement any deficiency in evidence of this kind by giving effect to his own subjective view as to whether or not he himself would be likely to be deceived or confused. In the instant case this would apply to the large industrial electrical machinery sold under the Rondel Mark. But where goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a 'jury question'. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused." (Emphasis supplied).

It is beyond debate that the product in the instant case is one "for the general public for consumption or domestic use." It was therefore perfectly proper for the learned judge to give his careful consideration to this aspect of the matter.

In deciding whether or not a registered mark should be expunged from the register, regard must be had to the burden of proof which lies upon the applicant.

This burden is not discharged merely by showing that the mark is descriptive. The applicant has to rebut the presumption of validity conferred by Section 46 which reads:

"In all legal proceedings relating to a registered trade mark (including applications under section 34) the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof."

And that validity is impliedly strengthened by Section 15(1) which limits the area of assault on the validity of a mark that has been registered for over seven years as in the instant case.

In dealing with applications to expunge, Lord Diplock in the G.E. case had this to say (p. 321):

"Where the question of the likelihood of deception or confusion arises upon an application to expunge a registered mark which has already been the subject of substantial use, the absence of evidence of actual confusion having occurred is a potent factor in determining whether or not the court should exercise its discretion to expunge the mark from the register. But it does not decide the relevant hypothetical question which must be answered in the affirmative before any question of discretion to expunge the mark arises: Would any normal and fair future use of the mark, in the course of trade be likely to cause deception or confusion? If actual confusion in the past is proved, this is a strong indication that continued confusion is likely; but the absence of evidence of past confusion may be accounted for by the small extent to which the mark has been used or by special circumstances affecting its past use which may not continue to operate to prevent confusion in the future."

Now the finding of the Registrar that "Tang" though well known in the U.S.A. has not had the necessary popular and long term use in Jamaica to acquire "distinctiveness" has not been challenged. It is equally unarguable that "Tang" is a descriptive word. As the learned judge pointed out there is no evidence of actual confusion and therefore the answer must be to the hypothetical question defined by Lord Diplock in the passage quoted above. It will be of assistance in answering that question to consider the approach in the decided English cases in assessing the likelihood and the degree of confusion or

deception that may flow from a mark based upon a descriptive word or device. Though of different numbering the corresponding English provisions are the same as the Jamaican in terms and tenor. In that regard I consider the word "confusion" more appropriate to those cases where there are competing marks and the vital question is whether under the mark in question goods of one proprietor may be or likely to be confused with those of another and reserve "deception" and its cognates for those cases where the mark may create a misleading impression in some other way about the goods manufactured and sold under it. This case falls within the second category so that reported cases of competing marks will be referred to for dicta relating to propositions of a general nature.

In *The Chef Trade Mark*, (p. 143)

"The applicants applied to register 'THE CHEF' plus device in Part A of the Register in respect of 'Printed matter; newspapers and periodical publications, photographs; stationery; instructional and teaching material (other than apparatus)' in class 16. There had been no user of the mark. The Registrar, refusing registration in Part A, found that the use of the word "Chef" on printed matter would convey a direct reference that the goods concerned cookery or would be of interest to cooks; that the device did not lesson that direct reference; and that the mark was not prima facie distinctive when applied to goods on which it would probably be used. Registration in Part B was refused as the mark did not have sufficient inherent capacity to distinguish within the meaning of the Act; the offer to disclaim each of the separate parts of the mark made no difference. The Registrar further held that any limitation of the specification of goods covered by the registration to avoid the section 11 objection would emphasise the descriptive significance of the mark and thus reinforce the objections under sections 9 or 10. The applicants appealed.

Held, dismissing the appeal.

- (i) the reasoning of the Registrar was correct;
- (ii) the mark applied for, whether the device and the words were considered separately or in combination, was too

"descriptive of those goods within the specification relating to cookery to qualify for registration; and that if the mark was used on goods not so related, such use would be deceptive."

In his judgment the Registrar said (p. 144):

"Clearly the words THE CHEF cannot be regarded as invented and because of the meaning of the word CHEF it seems to me that when used in relation to for example printed matter they will convey a direct reference that the goods are of interest to cooks or are about cookery. The words are a prominent part of the mark being shown in solid black letters in contrast to the outline device and the mark is most likely to be referred to in speech as THE CHEF, since words 'speak' more than devices."

Now this case was an application by the proprietors to register a new mark. No presumptions run in their favour. They had to discharge the burden of proving that the mark was not offensive and did not transgress the provisions of the Act. The mark was held not only to be descriptive but to be deceptive in that the goods did not conform with the description of the mark.

It is however worthy of note, in that, in giving the judgment of the Board of Trade, D. W. Falconer, Esq., Q.C. ended thus (p. 147):

"I would, however, point out that the decision appealed from was in respect of an application to register a new and unused mark and is upheld on that basis. But in view of it having been conceded on behalf of the Registrar that the device part of the mark possessed some inherent distinctiveness, rejection of this appeal is not to be taken as excluding the possibility that the applicants may at some future date, after an appropriate period of use, be able to establish on a fresh application that the mark has, by such use, acquired sufficient distinctiveness or a sufficient capacity to distinguish as to qualify for registration."

From this case two principles may be extracted:

- (i) In determining the question whether or not there is the likelihood of deception the mark on the one hand and the description of the goods to be manufactured under the mark on the other are co-relative considerations, and

- (ii) A mark refused on an original application may nevertheless after long term use acquire sufficient distinctiveness that the goods manufactured thereunder are no longer deceptive.

The importance of the description of the goods in determining whether there was the likelihood of deception was illustrated in the case of the application of Ladislav Jelinek (1946) 53 R.P.C. 59:

"The Applicant applied on 6th May, 1941, to register the device of a panda together with the word 'Panda' in class 3 for shoe polish. The application was opposed by the proprietors of a similar 'Panda' mark registered in respect of shoes. The Opponents contended that, having regard to their own registration, it would be in contravention of Secs. 11 and 12 (1) if the Applicant's mark was allowed to be registered; they alleged that shoe polish was within the same description of goods as boots and shoes, and that a number of shoe manufacturers marketed shoes and shoe polish under the same mark, and that if the Applicant was allowed to register his mark, the Applicant's shoe polish would be believed by the public to be the manufacture or merchandise of the Opponents. They further alleged that boots and shoes under their trade mark 'Panda' were on the market at the date of the Applicant's application. The Applicant denied that shoe polish was within the same description of goods as boots or shoes, and contended that there were only a very few cases where a trader had the same mark for boots or shoes and also for polishes, that there were cases where different traders used the same mark for these two classes of articles, and that the main channels for the sale of shoe polishes were grocers' and dry-salters' shops and other shops where boots or shoes were not sold."

No evidence of actual confusion was adduced. Evershed, J. approved of the following amongst other propositions submitted by Counsel for the opponent (p. 78):

- "(1)
- (2) It is not necessary, in order to find that a mark offends against the section, to prove that there is an actual probability of deception leading to a passing-off. It is sufficient if the result of the user of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt."

but applied to it what I regard as a rider in the following passage, (p. 78):

"I would merely add, with regard to the second of them, the following extract from the judgment of the late Farwell, J., in Bailey's case, reported in 52 R.P.C., 136, at page 153: 'I think that the Court has to be satisfied not merely that there is a possibility of confusion; I think the Court must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the Register.' " (Emphasis supplied)

And after reviewing the evidence said inter alia, (p. 79):

"In my judgment, however, there is no real evidence, that any members of the public had, by the 6th May, 1941, become acquainted with 'Panda' footwear at all."

And concluded thus, (p. 80):

"Having decided, however, firstly that shoe polish, in respect of which the Applicant is seeking to register his mark, is not of the same description of goods as footwear, and secondly, that there is no reasonable likelihood of confusion if the Applicant's mark is registered, I do not think that any other ground of objection would justify me in concluding that the application should be refused. In my judgment it cannot be said in the words of Lord Wright in Aristoc, Ltd. v. Rysta, Ltd. 61 R.P.C. 121: ([1945] A.C. at p. 104) that 'there is here a general risk of confusion which in the public interest should not be authorised'."

This was a case of alleged confusion. Although there was similarity in the marks the products were different and the opponents had made such limited use of the mark that there was no general risks of confusion.

The case however, demonstrates that there must be established a real and general risk of confusion or deception in the goods to be produced under the mark.

In the matter of the application by Otto Seligmann for the Registration of a Trade Mark LXXI R.P.C. 52:

"3. having applied for registration of 'instant Dip' for all goods in Class 3, without evidence of user, registration was refused on the grounds that the words had direct reference to the character or quality of the goods; were neither 'adapted to distinguish' nor inherently 'capable of distinguishing' the goods of the Applicant; would be deceptive if applied to goods which did not form 'dips' and were liable to cause confusion with an earlier 'Dip' mark. The Applicant appealed to the Court.

Held on appeal (1) That since the combination 'Instant Dip' might possibly (though not necessarily) be understood as a direct reference to the character or quality of the goods, the decision of the Hearing Officer that the mark was not registrable in Part A could not be disturbed, but (2) that the application should be remitted to the Office for further consideration of its registrability in Part E."

In his judgment Lloyd-Jacob, J. said, (p. 54):

"It was conceded that the material objection so far as Sec. 9 was concerned was that contained in Section 9 (1) (d) of the Act." [Section 11 (1) (d) - Jamaican Act]. "The Applicant accepted the burden that he must satisfy the Registrar that the mark applied for did not contain or consist of a word or words having direct reference to the character or quality of the goods. As I have already indicated, the mark applied for consisted of the two words 'Instant Dip', and it was applied for in respect of all goods in Class 3, but that included a number of liquid preparations for cleansing, colouring, polishing and cleaning, and to that extent it would appear to be reasonably plain that, if the word 'dip' is used in the connotation which is set out in 'Webster's' dictionary, the mark applied for did contain a word having a direct reference to the character or quality of the goods, except in so far as its meaning was modified by the presence in the mark applied for of the word 'instant'."

He then considered and accepted the meaning of "Dip" in Webster's Dictionary - "A liquid preparation into which objects may be dipped or immersed, as for cleansing, colouring, lacquering, for example, as a staining dip," and held that the Registrar was justified in concluding that the use of the mark in relation to cleaning, bleaching and dyeing preparations must be regarded as having a reference to the character and quality of the goods. The goods as originally described in the application were

"preparations made from plastics for use as substitutes for laundry "starch". However at the appeal stage, the applicant desired that registration of the mark be limited to "liquid cleaning and polishing preparations."

The learned trial judge then held that the Registrar came to the right conclusion when he held, (p. 55):

"..... that the mark as applied for was not susceptible of registration, having regard to the fact that it did include matter the use of which would be likely to deceive; and he did so because the classification of goods in respect of which the registration was sought included materials which could not, in any circumstances, be the subject matter of a dip in the sense that they could not be converted into or did not constitute liquid preparations."

With respect to the amended description he went on to say, (p. 56):

"In those circumstances, the best way of dealing with the case will be that I should support the decision so far as it deals with the application under Sec. 9 of the Act, but to say that, having regard to the application to amend the classification of goods introduced on the appeal, the matter should be referred to the Registrar of Trade Marks for consideration of that application under Sec. 10 of the Act; and that, as far as concerns the passages in the decision which deal with objections to an application under Sec. 10, they are not conclusive against success for such an application."

In the course of his judgment Lloyd-Jacob, J. observed:

".... I do not necessarily accept the view that the inclusion in the trade mark of some indirect reference to a quality must necessarily exclude registration, by reason of the possibility that the user of the trade mark will apply it to goods which have not that characteristic. That is a matter which must depend upon the facts of each case." (Emphasis mine)

In re Huggars Trade Mark - (1979) Fleet Street Reports, 310:

"The applicants applied on motion to expunge the mark HUGGARS from the register pursuant to section 26 of the Trade Marks Act 1938 on the ground of non-use. They contended, in the alternative, that the respondents had never proposed to use the mark in relation to goods and that HUGGARS was therefore not a trade mark within the definition of section 68 of the Act

"and ought to be removed from the register pursuant to section 32.

It was clear from the evidence that in 1971 the respondents had decided to adopt the name HUGGERS for a range of casual clothing and that since that time they had made extensive use of that name. The respondents had applied to register the mark HUGGERS. However, following objection from the Registry, they had in fact registered the mark HUGGARS.

The respondents contended, inter alia, that pursuant to section 30 of the Act, account should be taken of the use of the mark HUGGERS, since it was a mark not substantially different from HUGGARS."

In granting the application it was held:

- " (1) That the applicants were persons aggrieved with a sufficient interest to sustain the application.
- (2) That in all the circumstances it was right to regard the mark HUGGERS primarily in a visual context. HUGGERS was immediately suggestive of the quality of the clothing, a suggestion much less likely to be derived from HUGGARS. HUGGARS could not, therefore be accepted as HUGGERS with an alteration not substantially affecting its identity.
- (3) They were no sufficient grounds for the exercise of the court's discretion to refuse the relief sought."

Golding, J. in the course of the judgment said, (p. 316):

"HUGGARS to my mind (and the point occurred to me before I had heard it developed in speeches of counsel or had seen any of the evidence or exhibits) in relation to such clothing as the respondent sells, if spelt with an "E" is immediately suggestive of a quality of the clothing. Those who have walked along the pavements behind young people, or who have sat in underground trains opposite young people are well aware that it is or has been the fashion, particularly with jeans, to have tight and close fitting garments. HUGGERS, spelt in the ordinary way with an "E", is plainly suggestive of that. My view, which I think is that of the Registrar's officer, though no doubt I have had much longer to consider it, is that that suggestion is much less likely to be derived from HUGGARS spelt with an "A". No doubt someone looking closely and consciously at the words in connection with jeans or other casual clothing, and accustomed to thinking about words, would get the point. However, it is very far from obvious, as it is when HUGGERS is spelt with an "E". Therefore, slight in one way though

"the difference is, and accepting as I do that ordinarily a change of vowel in an unstressed syllable could not be a material difference, nonetheless in this case, and in the circumstances I have tried to indicate."

And later observed, (p. 318):

"For one thing, after more than seven years' use of HUGGERS, the respondent is about to obtain registration of that mark in Part A of the Register. I say 'is about to obtain registration' because the application relating to HUGGERS has been advertised and the time for opposition, so I am informed, has passed without any opposition on the part of the applicant or anyone else. Accordingly, the mark that the respondent has actually used will shortly have the protection of the Register, subject of course to any attack that may be made on the validity of the registration."

Implicit in that observation is that a mark that is merely descriptive is not per se wrongfully on the register. In my view, the cases indicate that for removal of a registered mark, after seven years on the register, it must be shown that the mark considered, vis-a-vis, the goods to be manufactured under it would cause deception on the general public to a real and substantial degree.

This brings me to the Orlwoola case on which Mr. George relied so heavily. For comparative analysis the facts are important:

"In 1901 the business of Orlwoola, Limited, including the trade marks, was purchased by the Leigh Mills Company, Limited, in whose name the trade marks now stood. In 1898 J. N. Brock & Co, had applied to register the word 'Osowoolo' as a trade mark in class 38. The application was opposed by the Leigh Mills Company on the ground of the similarity of the word to 'Orlwoola,' and the applicants retaliated by moving to have the 'Orlwoola' marks struck off the register. The application for registration was refused by the registrar, and his refusal was affirmed by Eve J., and there was no appeal against that decision.

The motion to rectify was based upon the ground that the word 'Orlwoola' had none of the essentials necessary for a registrable trade mark, inasmuch as it was merely a misspelling of the words 'all wool' with the addition of the letter 'a' and that it was

"descriptive of the goods to which it was applied if they were composed wholly of wool, and, if they were not so composed, was deceptive.

The motion was opposed by the Leigh Mills Company, Limited, and s. 2 sub-s. 5 and s. 36 of the Trade Marks Act, 1905, were relied on as shewing that these trade marks could not be removed. Eve J., after referring to the sale of the business to the respondents in 1901, stated the effect of the evidence as follows:

'The respondents have ever since continued to use the trade for goods sold in this country, in the colonies, and abroad. The sales have been considered, and a sum of £8000 or thereabouts has been expended in advertising their goods in connection with the mark. On the evidence I have come to the conclusion that the word has become identified with the goods of the respondents, that is to say, that persons to whom the name was known recognized it as identifying goods of a common origin. There is no evidence that the registration of the mark has caused any deception, or given rise to any confusion, or inflicted any hardship upon other traders!.'

On further appeal to the Court of Appeal (Cozens-Hardy, M.R., Fletcher Moulton, L.J. and Farwell, L.J.) the appeal was allowed and the decision of Eve J. reversed, (p. 142):

"It is not unimportant to observe that a laudatory, epithet, if allowed to be registered, cannot be removed after seven years. It may be applied to any goods of the proprietor, although the character of such goods may in course of time have changed for the worse; and the sanction of a Government department ought not to be given to that which might thus be calculated to deceive: see s. 11.

There is one important distinction between word marks and other marks. The former appeal to the ear as well as, and indeed more than, to the eye. The latter appeal to the eye only. It seems to follow that a word, not being an invented word, ought not to be put on the register if the spelling is phonetic and resembles in sound a word which in its proper spelling could not be put on the register."

And further, (pp. 143-144):

" 'Orlwoola' was registered under the old law as applied to woollen goods. An application was made to remove it from the register. It

"was not contended before us that it was properly registered, but it was argued, and the learned judge has held, that under s. 36 it cannot be removed, because it is a mark which under the Act of 1905 is registrable. I cannot accede to this argument. It is plain that 'all wool' could not be registered, and indeed these words are disclaimed on the face of the register. This word is a mark which appeals to the ear far more than to the eye, and for the reasons which I stated in my general observations I think it is obviously not distinctive. There are further difficulties in the way, because the mark is applied to other than woollen goods, but I prefer to base my judgment on general grounds. I think this appeal must be allowed." (Per Cozens-Lardy, M.R.)

With due deference to the eminent Master of the Rolls he has not met head-on the point made by Eve J. that there was no evidence of deception or likely hardship on the traders and basing his judgment as he did on "general grounds" left unanswered the specific question in relation to the probability of deception.

Fletcher Moulton, L.J. was more directly in point when he said, (p. 146):

"But the question whether a word is or is not capable of becoming distinctive of the goods of a particular maker is a question of fact, and is not determined by its being or not being descriptive. The law has never refused to recognize that this is the case, or to give protection to descriptive trade marks when once duly established in fact, although (except in the case of old marks) they refused registration and left the owners to obtain protection in another form of action. This is now changed, and under the provisions of the present Act the Court clearly has power to allow descriptive words to be registered if a case on the merits is proved before it sufficiently strong to induce it to do so."

He then considered Section 44 of the English Act and in relation to the Orwoola case and continued, (p. 150):

"It is in substance a case of registration of the words 'all wool' grotesquely misspelt as a trade mark for textile fabrics. When a trade mark consists solely of words it will be used orally as well as in writing, and to be proper to constitute a trade mark such words must be suitable, whether spoken or written. The misspelling does not affect the words when spoken, so that we have only to decide whether the words 'all wool' are proper for registration in respect of such goods. To this there can be but one answer. If the goods are wholly made of wool, the words are the natural

"and almost necessary description of them. If they are not wholly made of wool, it is a misdescription which is so certain to deceive that its use can hardly be otherwise than fraudulent. In either case the words are utterly unfit for registration as a trade mark."

Farwell, L.J. in his judgment clearly identified the two areas of attack upon the registration of the mark. He held that "Orlwoola" to ear meant "all wool" and was clearly descriptive; he disagreed with the finding of Eve J. that the evidence of user was sufficient to give it distinctness. He then considered the question of deception as an additional ground for rejection thus p. (455):

"Again, the registration is for articles made not only of wool, but of worsted and hair; the word 'Orlwoola' as spoken is calculated to deceive under s. 11. This is another reason for removing the mark."

In the Orlwoola case, the likely deception was that under the mark goods containing little or no wool could be foisted on the purchasers who would expect them to be made of wool with all the advantages including warmth and durability, which one would expect of woollen goods. The most important constituent of the goods would then be missing from the product. The deception in this case was manifestly real and substantial.

What expectations would "Tang" raise in the minds of purchasers of the powdered preparations for making non-alcoholic beverage. I accept the dictionary meaning of "Tang" - "a penetrating taste or flavour" - as an appropriate meaning in the food and beverage trade. But by what measures one assesses whether a taste or flavour is penetrating? I apprehend that the particular flavour or flavouring agent, as is customary, would be indicated on the particular label and that in my view is the taste a purchaser would expect. How strong the taste in the beverage when mixed well undoubtedly depend on the proportion of powder used. It may very well be a case of mixing to taste.

Mr. George as illustrative of the meaning of "Tang" referred to lemonade or limeade and tamarind drink as beverages with a tang. While acerbity in drink may undoubtedly give a tang, there is no good reason to limit the word to bitterness or acidity in taste. Further he makes the point that the generality of the description of ^{the} goods in the instant case should not place the proprietors of the mark in a better position than those in cases like the Chef and the Orlwoola cases where the goods are more specifically described.

It seems to me that the real point in those cases is that the description of the goods expressly indicate that they will not meet the description of the mark in some essential ingredient as in the Orlwoola case or some important feature as in the ^{case.} Chef/. In such cases the likely deception to the public is an inescapable inference. Frank disclosure in the application for registration is therefore irrelevant.

In my view neither to the stroller on the strands of the City nor the farmer in far off Pisgah; neither to the simple, nor to the sophisticated Jamaican, a powdered preparation bearing the mark "Tang" would raise a higher expectation than the particular flavour indicated thereon.

To the ordinary man this keenly contested litigation may seem a proverbial "storm in a teacup" and although in a wider sense the public welfare is an essential consideration in determining this question, it would be unrealistic not to appreciate that the motives of the parties are not entirely altruistic. In a keenly competitive trade where appealing device or catchy phrase may enhance the popularity of a product, the desire to ensure protection

or otherwise for a mark by persons in the particular trade is understandable and to be expected.

In my view, the word "Tang" though descriptive is too indefinite in its meaning and the existence of a "tang" in a drink so dependent on individual taste that I am constrained to hold that there is not that likelihood of real and substantial deception to the general public as would disentitle the mark to protection in the Court.

Finally, I am moved to commend both the Registrar and the learned trial judge for their earnest efforts to deal with the intricate issues and testing questions of law raised before them. We too have been put to anxious consideration by arguments astutely presented and in which the lines of divergence were finely drawn. That I have preferred the line presented by Counsel for the respondent does not in any way affect my appreciation of nor detract from the commendable performance of Counsel on the other side.

For the reasons that I have essayed to set out above, I would dismiss the appeal and affirm the decision of Walker, J.

CARBERRY J.A.

We get few cases on Trade Marks in Jamaica, and a full study of many of the cases reported in the United Kingdom leaves the impression that in this field of law, perhaps more than any other, there appears to be a high percentage of "upsets" and that opinions differ or vary greatly. The reason perhaps is that it is a highly technical branch of our law, and one of comparatively recent growth. Some light on its history appears in the speech of Lord Diplock in the leading case of General Electric Co., v. The General Electric Co., Ltd [1972] 2 All E.R. 507 (H.L.), reported as G.E. Trade Mark [1973] R.P.C. 297. At page 325 of the latter report, under the caption "The Common Law of Trade Marks before 1875," at line 40 et seq. Lord Diplock remarked:

"The right of property in a trade mark had special characteristics. One, which it shared with patents and with copyright, was that it was a monopoly, that is to say, it was a right to restrain other persons from using the mark. But it was an adjunct of the goodwill of a business and incapable of separate existence dissociated from that goodwill. To be capable of being the subject matter or property a trade mark had to be distinctive, that is to say, it had to be recognisable by a purchaser of goods to which it was affixed as indicating that they were of the same origin as other goods which bore the same mark and whose quality had engendered goodwill. Property in a trade mark could therefore only be acquired by public use of it as such by the proprietor and was lost by disuse."

After commenting on the nature of the remedies then available, Lord Diplock continued:

"A right of property of this character calls for an accommodation between the conflicting interests of the owner of the monopoly, of the general public as purchasers of goods to which the trade mark is affixed, and of other traders. This accommodation had been substantially worked out by the Court of Chancery by 1875. The interest of the general public requires that they should not be deceived by the trade mark. It ought not to tell a lie about the goods. Two main kinds of deception had been the subject of consideration. These were misrepresentation (a) of the character of the goods to which the trade mark was attached, and (b) as to their origin, i.e. that they were the product of some other manufacturer."

After commenting on the origin of the doctrine of "honest concurrent user" Lord Diplock continued (page 327)

"The requirement that a mark must be distinctive in order to qualify as the subject matter of proprietary rights is another instance of the accommodation between the conflicting rights of traders. One trader could not pre-empt the use of ordinary words which were descriptive of his product so as to prevent their use by other traders as an honest description of their own similar products."

Lord Diplock then traced the legislative history of the Trade Mark Acts, observing that at (page 331)

"With the passing of the Act of 1905 the law of trade marks assumed what is substantially its modern form. The basic change effected by the Act was that registration of a person as proprietor of a mark became the source of his title to the exclusive right to the use of the mark and not mere evidence of a title acquired at common law by actual public use of the mark; but this exclusive right was expressly made subject to the concurrent rights of other registered owners of the same or substantially the same trade mark. The Act also authorised the registration of marks prior to their actual use, by introducing a statutory definition of a trade mark as meaning:
 'A mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale.'

"But it contained express provisions for removal of a mark from the register for non-user"

He also noted at page 332:

"After a mark had remained upon the register for seven years it was no longer open to any court to hold that at the time when it was registered it was not of such a character as to be a proper subject matter of proprietary rights, unless its registration had been obtained by fraud. Section 41 was thus a provision which vested substantive rights in whoever was for the time being validly registered as proprietor of the mark....."

and at page 333:

"What section 41 did was to preclude the removal of a trade mark from the register after seven years upon any ground of invalidity, such as lack of distinctiveness, which would have applied to the original registration."

Lord Diplock then turned to the provisions of the U.K. Trade Marks Act, 1938. It is sufficient to point out that the Jamaican Trade Marks Act, as introduced in December 1958 by Law 32 of 1957 and amended by Act 11 of 1975, reproduces exactly, with the omission of two sections (38 and 39 dealing with Sheffield and Manchester marks) the provisions of the U.K. Trade Marks Act, 1938.

Before turning to consideration of our own Act and the facts of this case after this preliminary look at the history of and some of the leading characteristics of Trade Mark law, I should add that, as far as I can see, the recurring phrase "likely to deceive or cause confusion" which appears in several sections of the Act, has in practice largely dealt with confusion and deception arising from the similarity of competing marks rather than protecting the public from confusion or deception in relation to the character of the goods themselves. It should however be remembered that independently of the Trade Marks Acts, there are the Merchandise Marks Acts dealing with false trade marks and false trade descriptions, and that it is those acts which largely protect the public against "misrepresentations as to the character of the goods to which the trade mark was attached."

Kerr J.A. in his judgment has fully set out the history and facts of the present case, and I therefore say no more than is necessary to make what follows intelligible.

The appellants, Guinness Jamaica Ltd., (hereinafter called Guinness) produce a grape-fruit based drink which they market under the name "TING". They have done so for some years, and they applied to register "TING" as a trade mark under the Act. The Registrar of Trade Marks (hereinafter called the Registrar) had some misgivings as to its similarity to another mark previously registered, namely the word "TANG", but allowed the application to go forward, at which stage the respondents, General Foods Corporation, an American corporation registered in the state of Delaware, (hereinafter called General Foods), and which was the proprietor of the registered trade mark "TANG" opposed the application. "TANG" had been registered as a trade mark on 2nd November, 1964 in respect to Class 32 Schedule (iv) in respect of powdered preparations for making non-alcoholic beverages. It appears that they have a large business in the United States and Canada in making powdered mixtures of lime, grape fruit, orange and grape and other juices which mixed with water can be used as breakfast drinks. "TANG" is there used as a trade mark indicating the origin of the preparations and presumably the particular fruit juice being offered is also indicated on the container. In contrast, it appears that "TING" is not to be used as a brand name, but as the name of Guinness's grape fruit drink.

Faced with this opposition Guinness replied by moving to expunge the trade mark "TANG". They made two such applications, which have so to speak been consolidated. Shortly put the grounds advanced for expunging "TANG" are (1) non-user of the trade mark in Jamaica for a continuous period of five years or longer, under section 28 (1) (b) of the Act; (2) that "TANG" should never have been registered, it is descriptive of the goods, and not distinctive, nor has it

become distinctive in view of its non-user and so is in breach of section 11 of the Act (section 9 of the U.K. Act of 1938); (3) That if it be held not descriptive then it is in breach of section 13 of the Act (section 11 of the U.K. Act) in that it is "likely to deceive or cause confusion" to the public who expect a drink with a "TANG" and many find the flavour offered has none, but is bland.

The application by Guinness was made under sections 34 and 35 of the Act. (They correspond to sections 32 and 33 of the U.K. Act.) They read as follows:

"34. (1) Any person aggrieved by the non-insertion in or omission from the Register of any entry, or by any entry made in the Register without sufficient cause, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, and the Court or the Registrar, as the case may be, may make such order for making, expunging or varying the entry as they may think fit.

(2) The Court or the Registrar may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the Register.

(3) In case of fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section.

(4) Any order of the Court rectifying the Register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall, on receipt of the notice rectify the Register accordingly.

(5) The power to rectify the Register conferred by this section shall include power to remove a registration in Part A of the Register to Part B.

35. On application by any person aggrieved to the Court, or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, or on application by the Registrar to the Court, the Court or the Registrar, as the case may be, may make such order as they may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the Register in relation thereto."

As to ground (1) of the application, non-user of the mark "TANG" the relevant section is section 28, and set out below are those parts of the section which were relevant for consideration. (It corresponds to section 26 of the U.K. Act).

"28 (1) Subject to the provisions of section 29, a registered trade mark may be taken off the Register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, on the ground either -

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or

(b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to these goods by any proprietor thereof for the time being:

Provided that (except where the applicant has been permitted under subsection (2) of section 14 to register an identical or nearly resembling trade mark in respect of the goods in question or where the Court or the Registrar is of opinion that he might properly be permitted so to register such a trade mark) the Court or the Registrar, as the case may be, may refuse an application made under paragraph (a) or (b) in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

.....

"(3) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1), or for the purposes of subsection (2), on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates."

As to non-use the evidence showed that the product(s) "TANG" had not been marketed in Jamaica since 1971 to date, and this was not challenged. What was set up by way of defence was this had been due to "special circumstances in the trade and not to any intention not to use or to abandon the trade mark" within subsection (3) above. The special circumstances appear to have been that there were said to have been in the first place restrictions on the import of "TANG" into Jamaica, and that General Foods had then attempted to have the product made and marketed (under licence) in Jamaica by other food manufacturing companies. This failed because one went out of business and its successor was in any event unable to produce a satisfactory product. This apparently took place between 1972 and 1977, when the last Jamaican licensee also went into liquidation. Unfortunately it does not appear what happened after the last attempt to make the product in Jamaica failed in 1977. It is not clear whether the original import restrictions continued, or whether any further attempt was made to have the product imported or not.

In the result we have the unhappy spectacle of a Trade Mark registered for a product which (whatever was the situation before that) has not been marketed in Jamaica since 1971 to date.

On the face of it some period in the five years and one month preceding the applications to expunge which were made on 24th April, 1979 (and originally on 2nd March 1977) was covered by the difficulties experienced in importing the product and attempting to make it here. The Registrar however accepted that the respondent was protected by section 28 (3), i.e. that these were special circumstances in the trade, that satisfactorily

explained non-use. There was no appeal against this part of the Registrar's decision, and Walker J. expressed no views on the matter, nor was it canvassed before us.

The position is however unsatisfactory and I think that a few comments on the matter are called for. Originally, as pointed out by Lord Diplock (supra) trade marks had to earn their keep so to speak by positive user. Now that they can attain their status by mere registration as a proposed mark it is important that the provisions dealing with non-user should be strictly enforced. It is true that mere non-use does not necessarily point to abandonment: Mousen v. Boehm (1884) 26 Ch. D. 398. It is equally clear that the non-user must be in fact due to the special circumstances in the trade, and not to special circumstances which relate only to the proprietor's business: Trade Mark of James Crean & Sons Ltd. [1921] 38 R.P.C. 155.

There was at one time a suggestion that the "special circumstances" must cover the whole of the five year period; see Columbia Gramophone Co. Ltd's Trade Mark (1932) 49 R.P.C. 483 and on appeal under the name Columbia Pictures Corporation's Application [1932] 49 R.P.C. 621 (C.A.) (following James Crean & Sons (supra)).

However the modern view since the 1938 Act is that it is no longer necessary to show that the special circumstances covered the whole of the five year period of non-user, but it is clear that the running of the five year period will recommence when the special circumstances have ceased to operate: See in re Marshall's Application (1943) 60 R.P.C. 147, at 148-149.

Certainly import restrictions have been accepted as "special circumstances" Akt. Manus v. R.J. Fullwood & Bland Ltd [1949] Ch. 208; 65 R.P.C. 329; "Daiquiri Rum" Trade Mark (1966) R.P.C. 582; and "Bulova" Trade Mark [1967] R.P.C. 229. It is not however clear that unsuccessful attempts to produce the

the product locally qualify; are these due to circumstances in the trade? or are they due to matters personal to the manufacturer? In any event for how long are these manufacturing difficulties of the past to continue into the future as an excuse for non-user?

Finally it also may be noted that section 28 confers a discretion, the mark "may" be taken off the register: In Lever Bros. Port Sunlight Ltd. v. Sunniwhite products Ltd. [1949] 66 R.P.C. 84, the court exercised its discretion in favour of the proprietor of the mark, while in J. Lyons & Co. Ltd's application [1958] R.P.C. 466; reversed on appeal [1959] R.P.C. 120 (C.A.) the discretion was exercised against the registered proprietor and in favour of the applicant seeking removal of the trade mark. The case is notable for the full discussion of the discretion by Lord Evershed M.R. See too Huggars Trade Mark [1979] Fleet Street Reports 310 where the trade mark was struck out.

As to Ground 2: that the mark was descriptive and not distinctive. Section II of the Act (which corresponds to section 9 of the U.K. Act) set out the requirements of a Trade Mark to establish registrability in Part A of the Register. It reads as follows:

- "11. (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the Register, it 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;

" (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.

(2) For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the Registrar may have regard to the extent to which -

(a) the trade mark is inherently adapted to distinguish as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid."

Section 12 deals with registrability in Part B of the register. It does not apply here as we are dealing with a trade mark registered in Part A.

It is convenient to mention at this juncture two other sections. Section 13 contains an overall prohibition against the registration of trade marks the use of which would be "likely to deceive or cause confusion" or otherwise to be disentitled to protection in a court of justice. It is set out in full below. Section 14 prohibits the registration of a trade mark identical with one already registered, or so closely resembling it as to be "likely to deceive or cause confusion." It contains however an exemption or reservation covering the case of honest concurrent user. The two sections correspond to sections 11 and 12 of the U.K. Act. Finally it is convenient to mention two "follow up"

sections which deal with the effect of registration: Section 46 provides that registration of a trade mark is to be prima facie evidence of the validity of the original registration; this throws the onus of proving invalidity or non-registrability on those who attack the mark already registered. It corresponds to section 46 of the U.K. Act. Section 15 carries the effect of registration still further: it provides that after seven years on Part A of the register the trade mark shall be taken to be valid in all respects, unless it offends section 13 or was obtained by fraud. It would, however, be still vulnerable for non-use under section 28. This section corresponded to section 41 of the U.K. Act of 1905, and section 13 of the U.K. Act of 1938.

Section 13 reads as follows:

"13. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Section 15 reads as follows:

"15. (1) In all legal proceedings relating to a trade mark registered in Part A of the Register (including applications under section 34) the original registration in Part A of the Register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless -

- (a) that registration was obtained by fraud; or
- (b) the trade mark offends against the provisions of section 13.

(2) Nothing in subsection (1) of section 7 shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the Register, the foregoing provisions of this section relating to a trade mark registered in Part A of the Register.

Arguing for the appellant, **Guinness**, who sought to attack the registration of "TANG", Mr. George sought to establish what would in chess be called a "fork attack" by the Knight. He argued that "TANG" was disqualified from registration because it was a word which had a direct reference to the character or quality of the goods within section 11 (1) (d) i.e. to the taste of the product, and that it did not qualify under 11 (1) (e) "any other distinctive mark," because it was not "adapted to distinguish the goods" and due to its never having been used in Jamaica for so long a period (if it ever was used) no regard could be paid to actual user, granted that actual user may sometimes be such as to show that a word originally descriptive of the goods has acquired a secondary meaning as referring to the goods of the trade mark user: see for example Reddaway & Co v. Banham & Co. [1896] A.C. 199 (H.L.) and the remarks of Lord Herschell at page 212-213 ("camel hair belting" found to have become distinctive of the Plaintiff's goods).

Alternatively, argued Mr. George, if the word was not one that referred directly to the character or quality of the goods, then it should be struck out under section 13 as "likely to deceive or cause confusion," because the word would suggest a "penetrating taste" while the mark might be applied to some powder producing a bland or non penetrating taste, e.g. a product like icing sugar. It is to be observed that in his choice of examples Mr. George tended to equate "TANG" with acidic drinks, though it is possible to have a penetrating taste which is not acid, e.g. liquorice, or pepper-mint.

It is not I think necessary to review all the cases cited on the first limb of this proposition. Mr. Henriques for the respondent though not conceding the first limb of the argument was content to rely on the immunity afforded by section 15 to marks that had been on Part A of the register for over seven years.

In support he referred to the remarks in the speech of Lord Diplock in the G.E. Trade mark case at page 332 and 333, and which were referred to earlier. In addition it is useful to refer to the case of Imperial Tobacco Co. v. de Pasquali [1912] 35 R.P.C. 185 (C.A.). In that case Imperial Tobacco Co. were the owners (by succession) of two trade marks in respect of cigarettes, "Regimental Cigarettes" and "Regimental." The marks had been on the register since 1885 and 1908. Imperial sought to restrain dePasquali from marketing cigarettes under the name "Pasquali's" The Regiment" claiming that this amounted to "passing off" or at any rate to infringement of the Trade Marks. Both the passing off ^{and} / Trade Mark infringement actions failed. de Pasquali for his part, like Guinness in the present case, countered by moving to delete the two trademarks, claiming that they should never have been registered, as they were unregistrable as being descriptive, referring directly to the goods, and not distinctive or adapted to distinguish the cigarettes in question. Astbury J ordered the two marks to be expunged. On appeal, Swinfen Eady M.R., though noting the validity of the attack on the two marks, pointed out the protection given by section 41 of the U.K. Act (which corresponds to our own section 15), which had the effect of protecting the marks which had been on the register for over seven years, unless it could be said that they also offended section 11 (which corresponds to our section 13). Construing the two sections together, he concluded that a mark did not offend section 11 merely because it did not at the time of original registration contain one or more of the essential particulars required for registrability. Section 11 was directed at something more than merely lack of one of the statutory essential particulars. He put the matter thus:

"although, if the facts had been known, it might well be it was a mark that ought not to have been registered, still, having once been registered, it does not come within the provisions of section 11 as being disentitled to protection in a court of justice.

The contention put forward that every mark not properly registered -- that is to say, every mark to the registration of which there was originally a valid objection - is disentitled to protection in a court of justice, within the meaning of section 11, cannot be maintained."

The judgments in the case discuss the relationship between the U.K. sections 9 and 11 (Jamaica Sections 11 and 13 above) and suggest that the latter is aiming at a mark which has some defect or vice other than merely failing to qualify under section 9. It was intended to subject trade marks which do comply with the requirements of section 9, to additional requirements in respect of legality.

It is clear then that section 15 of our act conferred after 7 years an immunity on the mark "TANG" which could be expunged only if it was in breach of section 13, as being "Likely to deceive or cause confusion." This brings us to the alternative argument of Mr. George and the third ground on which the attack on "TANG" was based, viz that it was likely to deceive or cause confusion.

In construing section 13 which was set out above, it is useful to keep in mind the provisions of section 14, which are set out below:

"14. (1) 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 trade mark as to be likely to deceive or cause confusion.

"(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or, on an appeal, by the Court.

It will be noticed that both section 13 and 14 use the phrase "likely to deceive or cause confusion" but that section 14 uses it specifically with regard to the similarity between trade marks, while section 13 is general in application. This led Viscount Maugham in Aristoc Ltd. v. Rysta Ltd [1945] A.C. 68; 62 R.P.C. 65 to form the view that the two sections (section 11 and 12 in the U.K. Act of 1938) were dealing with different situations; he said at page 85 that:

"There is nothing in section 11 to show that the legislature is there dealing with competing marks. It has been regarded (like s. 11 of the Act of 1905) as a general provision which is to be contrasted with the present s. 12. The latter section is concerned with the competition of the proposed mark with some trade mark belonging to a different proprietor already on the register in respect of the same goods or description of goods, and with the likelihood of deception or confusion between the two marks."

Viscount Maugham went on to cite Lord Russell of Killowen in Bass, Ratcliffe & Gretton v. Nicholson & Sons Ltd [1932] A.C. 130 at 152 as saying of section 11:

"It is to be observed that the likelihood of deception which is contemplated by s. 11 need not necessarily flow from any resemblance between the matter proposed to be registered and other matter or another mark. It might flow from something contained in the matter proposed to be registered. ...

(and he added)

"In short s. 11 (so far as relevant) is a prohibition in general terms of the registration of matter the use of which would not be protected in a court of justice."

Despite this observation by Viscount Maugham, the general view as set out in Texts such as Kerly's Law of Trade marks, 10th Edition (1972) paragraph 10 - 26 et seq. is that the two sections overlap. It is observed further "this section is directed to some positive objection to registration and not to mere lack of qualification. It contemplates some illegality or other disentitlement inherent in the mark itself." It is also observed that this section exists not merely for the benefit of the traders, but for the benefit of the public at large.

It is this aspect of the section that is being invoked by Mr. George, and it should be noted that this is being done not at the stage of applying for registration but in a case in which it is being invoked to remove from the register a mark that has been there unchallenged for nearly 20 years.

As I said earlier there are remarkably few cases in which section 13 (U.K. section 11) has been invoked for the purpose of protecting the public against confusion and deception other than that arising from competition between trade marks that are said to too closely resemble one another and to be competing in goods belonging to the same field or description. I review briefly those which have been drawn to our attention.

Aristoc Ltd v. Rysta Ltd already referred to was one such case. There it was proposed to register as a trade mark a mark hitherto used to indicate that stockings had been repaired by the applicant. It appeared that the applicant proposed to enlarge his activities by also entering the field of manufacturing stockings, and it was held (a) that a repairer's mark was not registrable as a trade mark, (b) that the mark too closely resembled that of his opponent, and (c) that a situation which saw registered as a manufacturer's mark one that had hitherto been used to indicate repair only would be confusing and deceptive to the public: they would not know whether stockings bearing such a mark were second-hand i.e. repaired, or new. It was in connection with (c) that Viscount Maugham discussed the ambit of section 11 (our section 13) and his views appear at page 87 and 88 of the report in the Appeal Cases. See too Lord Macmillan at page 99 and Lord Simmonds at page 107. The case however turned on (a) above, rather than the question of confusion or deception of the public. It confirmed that the Registrar had a discretion in registering or refusing to register trade marks, and that that discretion had been properly exercised in refusing registration here.

Re Hack's application [1940] 58 R.P.C. 91 saw an applicant seeking to register "Black magic" in respect of laxatives. It was opposed by the proprietors of "Black magic" in respect of **chocolates** who complained that the proposed registration was in breach of both sections 11 and 12, in that it would cause confusion in the minds of the public between the opponent's **chocolates** and the proposed laxatives; Morton J. on appeal from the Registrar, upheld the objection see page 101, and again at 106, and refused registration.

Re Edwards' Trade Mark application [1945] R.P.C. 19 saw an applicant seeking to register the trade mark "Jardex" in respect of disinfectants; it was opposed by the proprietors of the mark "Jardox" registered in respect of meat extract used in nursing homes for invalids and elderly people. The goods were in quite different categories, and under normal conditions the risk of confusion slight. Nevertheless both categories or types of goods might well be stored in the same store room of institutions caring for the ill or the elderly and the possibility of serious consequences arising through mistakes or negligence could not be ignored, and the Registrar exercised his discretion to refuse the application. The reference to section 11 appears in the Registrar's judgment at page 21 et seq.

The Chef Trade Mark [1979] R.P.C. 143 saw an applicant seeking to register "The Chef" and a device consisting largely of a Chef's hat as a Trade Mark, in respect of printed matter. The Registrar refused registration on the ground that in so far as its use would relate to cook books and the like, the mark was one having direct reference to the character or quality of the goods, and that in so far as it did not, it was likely to confuse the public who would expect matter related to cooking or to chefs.

These were cases of applications to register involving refusal based on the possibility of confusion or deception of the public, separate and apart from confusion arising out of competing trade marks. In these case the onus lay on the applicant for registration to disprove the likelihood of confusion or deception of the public.

There are other cases in which section 11 has been invoked in respect of the likelihood of confusion and deception arising out of similarity of trade marks, registered and proposed. These do not seem to me to be of assistance where what is at issue is confusion or deception of the public simpliciter, but I mention them to show that they have in fact been considered:

See GoRay Ltd v. Gilray Skirts Ltd [1952] 69 R.P.C. 99 and 199 (C.A.); Baume & Co. Ltd v. A.H. Moore Ltd [1958] Ch. 137 & 907; [1957] 3 All E.R. 416; [1958] 2 All E.R.113 (C.A.) Parker - Knoll Ltd. v. Knoll International Ltd. (1961) R.P.C. 31; 346 (C.A.) [1962] R.P.C. 265 (H.L.); Berlei (U.K.) Ltd v. Bali Brassiere Co. [1969] 2 All E.R. 812; [1969] R.P.C. 472 (H.L.) General Electric Co. v. The General Electric Co. Ltd. [1972] 2 All E.R. 507; [1973] R.P.C. 297 (H.L.) (referred to earlier for the general remarks of Lord Diplock with relation to the history of Trade mark law.)

See also Eno v. Dunn [1890] 15 App. Cas. 252: application to register "fruit salts" as a trade mark for baking powder, successfully opposed by proprietor of that mark for laxatives: a case illustrating the uncertainties of trade mark law. Kay J dismissed the application to register, Lindley, Fry and Cotton LJJ unanimously ordered registration; the House of Lords by 3 to 2, overruled the Court of Appeal and upheld Kay J's refusal of registration.

Finally I mention a case greatly relied on by Mr. George, namely Re H.N. Brock & Co. Ltd [1910] Ch. 118 & 130 (C.A.). This was an application to remove from the register the trade mark "Orlwoola" registered in respect of clothing or textile fabrics on the grounds that the marks were descriptive (i.e. constituted a direct reference to the character and quality of the goods), and were also deceptive in so far as they referred to goods not made of wool. The application succeeded. It was plain that "all wool" was not registrable, and so too was a misspelling of it: it was obviously not distinctive. Two of their Lordships also accepted the argument that in so far as it was applied to textiles not made of wool it was deceptive see Fletcher Moulton LJ at p. 150 and Farwell LJ at p. 155. Cozens Hardy M.R. left the point open: see p. 144.

In response to the argument on section 13 and the suggestion that "TANG" was likely to cause confusion and deceive the public Mr. Henriques drew attention to the effect of section 46 (Registration to be prima facie evidence of validity) and of section 15, (the immunity afforded by seven years registration). He submitted, and correctly, that these sections place the onus on the applicant seeking to expunge the mark to show the likelihood of confusion or deception to the public. This is not an application to register, where there is an onus on the applicant to show that registration of his mark will not cause confusion or deception. And as to the weight of the evidence required to establish confusion or deception he submitted that there must be a real and tangible danger of confusion or deception caused by the use of the mark. In my view this submission is also well founded. There was no evidence of confusion or deception offered, but it is true that none was available having regard to the fact that the goods and the mark have not been on the Jamaican market since 1971.

The question of whether there is a likelihood of confusion or deception within section 11 was discussed at some length by Lord Diplock in General Electric Co. v. The General Electric Co. Ltd at pages 320 - 322. He described it as a hypothetical question which first arises on an original application for registration, and may arise later on an application to expunge the registered mark. He described it as a "jury question" to be now decided by the Judge (there being no juries in these cases now). He noted:

"That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself."

In the case before us Walker J. accepted the submission of Mr. Henriques that the Registrar having decided that the mark referred directly to the nature and quality of the goods, failed to take into effect the immunity given by section 15 in respect of the mark having been on the register for over seven years, and went on to find it in breach of section 13 without ever having considered that as a separate issue. The Registrar's findings are to be found at pages 62-63 of the Record, and the final sentence expressed the finding thus:

"The mark is descriptive without being distinctive, or otherwise offends against section 13 of the Act."

In my opinion Walker J. correctly rejected the Registrar's finding on ground 2 that the mark was descriptive without being distinctive, in view of the immunity granted by section 15. He went on to answer the "jury question" as to the likelihood of confusion or deception unfavourably to the appellant. In that too I think that he was correct. Section 52 confers on the Court the same discretionary powers enjoyed originally by the Registrar. I do not think that I would myself have put the matter as he did when he suggested that the test of whether or not the "TANG" product has a penetrating taste is a subjective one. It is however a "jury question" for the judge as to whether there is a likelihood of confusion or deception.

In re Otto Seligman's application [1953] 71 R.P.C. 52
Lloyd Jacobs J. said at p. 56 (dealing with section 11):

"I do not necessarily accept the view that the inclusion in the trade mark of some indirect reference to a quality must necessarily exclude registration, by reason of the possibility that the user of the trade mark will apply it to goods which have not that characteristic. That is a matter which must depend upon the facts of each case."

WHITE, J.A.:

I have read the judgment of Kerr, P. (Ag.) and Carberry, J.A. I agree with their conclusion and therefore I agree that the appeal should be dismissed.

KERR, P. (AG.):

Appeal dismissed. Judgment in Court below affirmed with cost to the respondent to be taxed if not agreed.

Section 35 of the Act refers to section 53 (section 54 of the U.K. Act). Also set out below are the immediately preceding sections, 51 and 52, (which correspond to sections 51 and 52 of the U.K. Act) which deal with the court's power to review the Registrar's decision, and provides that on appeals to the Court, the Court shall have and exercise the same discretionary powers that the Act confers on the Registrar. The three sections read thus:

- "51. The Court in dealing with any question of the rectification of the Register (including all applications under the provisions of section 34) shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.
- 52. In any appeal from a decision of the Registrar to the Court under this Act, the Court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.
- 53. Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the Court or to the Registrar -
 - (a) if an action concerning the trade mark in question is pending, the application must be made to the Court;
 - (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the Court, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court."

The application by **Guinness** to expunge the trade mark "TANG" was made in the first place to the Registrar, as provided above. That hearing commenced on the 7th January, 1981, continued on the 8th and 9th January, and 10th and 11th June, and the written decision of the Registrar was given on the 18th June, 1981.

This dictum has been cited and accepted in some of the Text Books dealing with the subject; for example Halsbury, 3rd Edition Volume 38, page 521 paragraph 864 observes:

"A mark having an indirect reference to a quality of the goods is not necessarily deceptive because the owner might apply it to goods not having such a quality."

Kerly Law of Trade Marks, 10th Edition [1972] paragraph 10-32:

"A mark having an indirect reference to a quality of the goods is not necessarily deceptive because the owner might apply it to goods not having such quality."

I have pointed out in reviewing the cases that instances where a mark has been held "likely to deceive or cause confusion" to the public simpliciter, and distinct from questions of confusion of similar or competing marks, are rare. Such as they are they have arisen on applications to register, rather than applications to expunge, and in my judgment the fact that the mark "TANG" could be applied by the proprietor to a powdered mixture which did not have an acid flavour, or was not considered "penetrating" is not such a source of deception or confusion as to bring it within the provisions of section 13. It is a matter which must depend on the facts of each case. It was a "jury question" and I am not prepared to say that the conclusion reached by Walker J. was wrong. This was clearly a different sort of situation to that in marking "erlwoola" on textiles that contained no wool, or for that matter allowing the registration of "black magic" for both chocolates and a mixture containing cascara sagrada, a potent laxative.

Any attack on "TANG" must at this stage be mounted on the question of non-user, an attack which in this case on the facts put in evidence has up to now been unsuccessful.

I have had the opportunity of reading in draft the judgment of Kerr J.A. and I agree with it. I too am of the view that the appeal should be dismissed, the judgment of Walker J. confirmed, with the usual order for costs to be paid by the Appellant.