

IN THE SUPREME COURT OF JUDICATURE OF JAMAICA

MISCELLANEOUS

SUIT NO. M50 OF 1981

IN THE MATTER OF THE TRADE MARKS ACT

AND

IN THE MATTER OF THE REMOVAL OF TRADE

MARK TANG, ENTRY NO. 10527 FROM THE

REGISTER OF TRADE MARKS.

Mr. R.N.A. Henriques Q.C. and Mr. Andrew Rattray instructed by Livingston, Alexander and Levy for the Appellant.

Mr. Emile George Q.C. instructed by Myers, Fletcher and Gordon, Manton and Hart for the Respondent.

Heard: June 1 and 2, 1982 and October 4 and 5, 1982

Delivered: December 10, 1982

Walker J:

This is an appeal by Notice of Motion by General Foods Corporation of the United States of America, registered proprietor of the Trade Mark TANG, from a decision of the Registrar of Companies given on the 18th day of June, 1981. On the application of the respondent, Guinness Jamaica Limited, the Registrar on that date ordered that the appellant's trade mark TANG, entry No. 10527 be expunged from the Register of trade marks pursuant to section 34 of the Trade Marks Act. The trade mark TANG was first registered on 2nd November, 1964.

Hereafter in this judgment when I refer to any section of a statute by number the reference will be to the Trade Marks Act unless I indicate to the contrary.

In giving her decision the Registrar delivered herself in the following terms:

"I come now to the application pursuant to section 34 to expunge the mark from the register on the ground that it offends against section 13 and is not within section 11 (1) (d). I agree with the applicants that the mark is utterly descriptive of the opponents' product or otherwise deceptive.

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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 Tang No. 10527 be expunged from the register pursuant to section 34 of the Trade Marks Act and direct that the opponents pay the costs of the applicants on Certificate of Counsel."

The sections of the Trade Marks Act to which the Registrar made reference read 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 -
 - (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."
- "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."

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"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."

The record discloses that the respondent made two applications to have the appellant's trade mark removed from the Register. Of the two, the earlier application which was dated 2nd March, 1977 was made 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."

The later application bearing the date 24th April, 1979 was based on two grounds, namely:-

"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.

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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."

These applications having been heard together, the Registrar rejected the earlier application but found in favour of the respondent on the later application, which latter finding is now the subject of this appeal.

In presenting his case counsel for the appellant submitted, firstly, that taking into account the date of its original registration, the appellant's trade mark was, by virtue of section 15, absolutely protected from expunction from the Register on the ground only of non-distinctiveness. Section 15 is 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."

If authority were needed as to the proper interpretation of section 15, Mr. Henriques cited the case of G.E. Trade Mark [1973] R.P.C. 297, and particularly the dictum of Lord Diplock at lines 10 - 12 of page 333 of the report, as providing such authority. With this submission counsel for the respondent agreed. 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. However, this is not an end of the

matter since the further question remains as to whether the Registrar's decision is sustainable on the ground that 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 disentitle such use to protection in a court of justice.

With regard to this aspect of the matter counsel for the appellant argued negatively while counsel for the respondent argued affirmatively. Counsel for the appellant submitted that in the proceedings before the Registrar, the respondent produced no evidence of actual deception or confusion or of the likelihood of either vice. He maintained that the onus was on the respondent to do so and pointed to section 46 which he contended presumed the validity of the registration of the appellant's trade mark. Section 46 reads as follows:-

"46. 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."

In the final analysis Mr. Henriques submitted that having determined, albeit wrongly, that the appellant's trade mark offended against section 13, the Registrar did not direct her mind to exercising her discretion on the question whether having regard to all the circumstances of the case the mark should in fact be expunged. On the other hand, the main submission of counsel for the respondent was that inherent in the appellant's trade mark TANG was a vice. Registration of the mark was for the manufacture of "powdered preparations for making non-alcoholic beverages," and the vice, so Mr. George argued, lay in the fact that the appellant, as proprietor of the mark, could, consistent with the terms of registration of the mark, lawfully manufacture beverages of the permitted description which did, or did not, have a tang. Counsel for the respondent

referred to the definition of the word "Tang" in the Oxford Dictionary, the word being there defined as meaning "a penetrating taste or flavour." He contended that a member of the public who purchased the product TANG would normally expect to receive a beverage with a tang i.e. with a penetrating taste or flavour. If such a beverage did not have a tang that would mean, said Mr. George, that the appellant's trade mark was being used in a manner which was likely to deceive or confuse the public and which would disentitle the use of the mark to protection in a court of justice. Counsel for the respondent said that it was an irrelevant consideration whether in the past the appellant's mark had been used to produce only non-alcoholic beverages with a tang. What was important was whether the mark could be used to produce non-alcoholic beverages without a tang, and the fact of the matter was that it could be so used, argued Mr. George. Mr. George cited the case of In re H.N. Brock & Co. Ltd. (otherwise Orwoola Trade Marks) [1910] 1 Ch. 130 which he submitted was on "all fours" with the instant case and also the case of Chef Trade Mark [1979] R.P.C. 143. As illustrative of an instance in which the court ordered the expunction of the registration of a trade mark on the ground of the existence of a likelihood of deception or confusion in its use Mr. George cited the case of Bali Trade Mark [1969] R.P.C. 472, and he also referred in argument to the cases of Eno v. Dunn [1980] 7 R.P.C. 311 and Huggars Trade Mark [1979] Fleet Street Reports 310.

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. In dealing with this question, and having regard to the

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way in which this appeal has been argued by counsel on both sides, I think I may omit to consider the words "or otherwise," the words "or would be contrary to law or morality" and also the words "or any scandalous design" in section 13 and confine myself to a consideration of the objection that the appellant's trade mark offends against that part of section 13 which enacts that 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, be disentitled to protection in a court of justice. Before the Registrar the onus was on the respondent (then the applicant) to produce evidence in support of that objection (see section 46). 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, G.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

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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 Orwoola and Chef cases so heavily relied on by counsel for the respondent. In the Orwoola case the word "Orwoola" 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. I do not accept the submission of counsel for the respondent that the appellant's trade mark is inherently vicious and that, as such, its use was at the date of application for registration likely to deceive or confuse the public. In my judgment the Registrar's decision is altogether erroneous and cannot stand.

Accordingly, this appeal is allowed, the Registrar's decision is set aside and the court orders that the appellant's trade mark TANG, entry No. 10527 be restored forthwith to the Register of trade marks. Costs of this appeal and of the proceedings before the Registrar are awarded to the appellant.