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File No. 355/1964  
"Lyforcin"

IN THE MATTER of the Trade Marks Ordinance  
AND

IN THE MATTER of an Application by U. S. Ethicals Inc., to register the trade mark "Lyforcin" in class 5 in respect of pharmaceutical products namely a nutritional supplement.

AND

IN THE MATTER of an Opposition by Ethols Chemicals Industries Limited the proprietors of the trade mark "Lipocidin" registered in H.K. under No. 340/63 in class 5 in respect of (inter alia) pharmaceutical, veterinary and sanitary substances.

D E C I S I O N

of

Mr A. R. Hearder, acting for the Registrar of Trade Marks  
Hearing on the 21st September, 1971

Mr L.C. Lo of Messrs H.H. Lau & W.S. Lo, Solicitors appeared for the Applicant  
Mr Charles Ching instructed by Messrs Wilkinson & Grist, Solicitors, appeared for the Opponent.

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On the 28th February 1964, U.S. Ethicals Inc., a corporation organized under the laws of the State of New York, U.S.A. (hereinafter referred to as "the Applicant") submitted an application for registration in Part A of the Register, of the word "Lyforcin" in respect of "pharmaceutical products, namely a nutritional supplement" in class 5. The Applicant's supporting declaration claimed the Applicant had used such mark in H.K. in respect of such goods since December 1963, but it was not registered at that time in any other country.

2. The mark was accepted for registration and was duly advertised in the H.K. Government Gazette of the 16th October 1964.

3. On the 11th December 1964 a letter was received from Messrs Wilkinson & Griot, Solicitors with instructions to oppose the said application for registration on behalf of their clients, Takeda Chemical Industries Limited (hereinafter referred to as "the Opponent"), and applying for an extension of time to file the Notice of Opposition. Further extensions were granted on the 5th March 1965 and the 10th June 1965.

4. The Notice of Opposition was finally filed on the 8th September 1965 and the grounds of opposition were as follows :-

- "1. That Messrs Takeda Chemical Industries, Limited, the Opponents herein, are a corporation duly organized and existing under the laws of Japan with its principal office at No. 27, Doshomachi 2-Chome, Higashi-Ku, Osaka, Japan and are the Proprietors of the Trade Mark "LIFCICIN" registered in Hong Kong under Registration No. 340/63 in class 5.
2. That the Opponents have been attaching the Mark "LIFCICIN" to their products sold in Hong Kong since August 1959.
3. That the Opponent's mark "LIFCICIN" and the mark "LIFOCICIN" of U.S. ETHICALS INC. are very similar in spelling and nearly identical in pronunciation and would therefore cause confusion and/or deceive unwary purchasers.
4. That in view of the goods sold under the respective marks belonging to the same description of goods obtainable over the same counter and the class of customers who purchase them it would be likely that unwary purchasers would be deceived and/or confused to buy the goods of one of the marks when they had intended to buy the goods of the other."

5. On the 29th June 1966, Messrs Kho and Lo, Solicitors, who in the meantime had been appointed the agents of the Applicant, filed a Counter-Statement setting out the grounds on which the Applicant relied in support of their application. In summary the Applicant denied paragraphs 2, 3 and

4 of the Notice of Opposition; and claimed (i) that there had been no incidents of confusion between the two marks; (ii) that its product is a tablet as well as a syrup for oral administration; (iii) is indicated as a "nutritional lysine hematinic and for a specific use as a nutritional supplement in stimulating appetite and promoting weight gain"; (iv) that the Opponent's product is available and manufactured only "in injectable form" and had various specific uses (which were set out); (v) administration of its product is effected orally either in the form of a tablet or a syrup whereas the Opponent's product is administered by means of an injection intravenously, intramuscularly and subcutaneously; (vi) the Opponent's product is prescribed by a physician; (vii) both products are available in a chemist's shop "from a highly trained person fully capable of differentiating between the two names" and the mode of administration; (viii) there is no similarity between the two names which differed in spelling, pronunciation and overall sound; (ix) that they are not goods of the same description as each has a different use and indication and (x) that the Opponent's mark should have not been permitted to be registered as it is "a description of a generic term, Lipoic Acid", and its mark used the first six letters of such generic term.

Subsequently, Messrs H.H. Lau and W.S. Lo were appointed to act on behalf of the Applicant.

6. The Opponent submitted evidence in support and further evidence being three Declarations by Mr. Shoji Matsuji dated 27.2.67, 21.10.68 and 18.9.69 respectively; also Declarations by Miss Ella Cheong dated 26.5.70 and Mr Lou Hoi Pak and Mr Cheong Ng Cheong both dated the 14th May 1970.

7. The Applicant submitted evidence in support and further evidence being two Declarations by Mr Howard H. Berger dated 29.7.67 and 22.5.69 respectively; two Declarations by Mr. Abraham Taub dated 27.5.66 and 30.8.67 respectively; also Declarations by Mr. Arthur G. Greenberg dated 29.7.67 and Messrs Fung Kam Yip, Tam Hau Man and Ho Kwok Hoi all dated the 30.12.70.

8. It is accepted that the onus in an opposition case rests upon the Applicant for registration, who must establish that the opposition is not justified - see Kerly's Law of Trade Marks (9th Ed.) 122 and Farwell J. in Application by J. Bailey (Birmingham) Ltd. (1955) 52 R.P.C. 136 at p. 149.

9. The Opposition is founded upon the provisions of Section 12(1) and 20 of the Ordinance. Section 12 places a restriction on registration by stating that "it shall not be lawful to register as a trade mark ... any matter the use of which would be likely to deceive ...". Section 20 also restricts registration by stating that "no trade mark shall be registered in respect of any goods or description of goods" that so nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, "as to be likely to deceive or cause confusion".

10. The question arising under Section 20 may be set out as follows :

- (a) Are the goods in respect of which the Applicant intends to use his proposed trade mark, goods of the same description as those already covered by the Opponent's registration; and
- (b) If the answer to the above question is 'yes', then does the Applicant's mark so nearly resemble the Opponent's mark as to be likely to deceive or cause confusion?

11. Hence the first question to examine is whether the goods in respect of which these marks are used can be considered to be goods of the same description under Section 20 of the Ordinance? Much evidence has been submitted by the Applicant to say that they are not, whereas the Opponent naturally enough says the contrary as both marks are obviously *used for* pharmaceutical products. *also* Romer J. in Jellinek's Application (1946) 63 R.P.C. 59, quoted in Kerly at paragraph 332, classified the various matters which should be taken into account as follows :-

- 1. The nature and composition of the goods;
- 2. The respective uses of the articles;
- 3. The trade channels through which the commodities respectively are bought and sold.

Applying that classification to the facts of this case I find that :

- (a) The nature and composition of the goods are different and there was little argument on this aspect. LIPCICIM is marketed in an

ampoule which is only available in Hong Kong in an injectable form and is administered either intravenously, intramuscularly or subcutaneously. Furthermore on the packets produced to me at the hearing it is clearly printed at the top left-hand corner "Injection". LIFOCIN on the other hand comes in a tablet or syrup form and is administered orally. Mr Matsui did claim in his Declaration of 27.2.67 that LIFOCIN is also marketed in the form of granules and powders in Japan but Mr. H. Berger quite rightly objected to such evidence as irrelevant in this hearing, as there was no evidence that the product in that form was presently available in Hong Kong.

- (b) LIFOCIN according to a pamphlet produced in evidence by both sides has the following uses :-

" Prevention and treatment of hepatic diseases as acute and chronic hepatitis, cirrhosis of the liver, jaundice, hepatic coma, fatty liver, etc.

Intoxication of drugs and poisons, recovery from fatigue, radiation sickness, hyperemesis gravidarum.

Skin diseases as eczema, dermatitis, intoxication exanthema, etc.

Prevention and treatment of arteriosclerosis and hypercholesterolemia."

LIFOCIN is used as a nutritional lysine hematinic and used as a nutritional supplement in stimulating appetite and promoting weight gain. i.e. Mr H. S. Lo submitted it is not used as a medication but as a vitamin.

- (c) When it comes to considering the trade channels through which the commodities respectively are bought and sold, difficult problems arise. It is clear that both being pharmaceutical products they can only be sold by the manufacturers to chemists, and that the ultimate purchasers, the general public can only buy them from chemists, assuming all druggist shops in Hong Kong

do in fact have a licensed chemist in charge thereof. It is also possible that the two marks could be alongside each other on the same shelf. Nevertheless Mr W.S. Lo argued they were different products, and laid much stress on his submission that LIPOICIN could only be obtained through a doctor's prescription, and that a doctor would be careful to differentiate between the two products and this view was supported by the evidence of two American experts, Mr. A. Taub (a consulting chemist) and Mr. A.C. Greenberg (a retail pharmacist) on behalf of the Applicant. However, Mr Ching pointed out that this argument had been destroyed by the Applicant's other witnesses : Messrs Fung Kam Yip, Tam Hau Man and Ho Kwok Hoi in paragraph 3 of their respective Declarations stated that both marks were available for sale without prescription. Maybe Mr. Fung Kam Yip is employed by a wholesaler, but the other two gentlemen are salesmen serving behind the counter in medicine shops in Hong Kong. Furthermore Messrs Lau Hoi Pak (a proprietor) and Cheong Ng Cheong (a manager), in paragraph 3 of their Declarations on behalf of the Opponent, confirmed this fact. This is not surprising when one considers that there are many pharmaceuticals and allied products available for sale here without prescription which is certainly not the case in other countries, e.g. antipregnancy pills and sleeping pills. Nevertheless if a doctor's prescription is used, there still might be confusion bearing in mind the similar wording and pronunciation of both marks. As the Assistant-Comptroller said in Ana Laboratories Ltd.'s Appn. (1951) 69 R.P.C. 146 at p. 150 :-

"Again I consider that in badly or hastily written orders there is a reasonable possibility that confusion between the words might occur, particularly if a chemist or other retailer stocked the goods sold under one mark only, and an order were given for goods sold under the other mark."  
(Here "Vanildene" was refused registration on the likelihood of confusion with "Vaseline").

The Applicant's exhibit (No. 2 in Mr. H. Berger's Declaration of 29.7.67) of a printed prescription can be rejected as no evidence was adduced that such printed form is always used by Hong Kong doctors.

12. The Applicant also argued that their product differed from the Opponent's in its packaging, its colour, form and size. Now it must be borne in mind that neither side has registered or is seeking to register, a device in combination with their respective word marks. Here we have two word marks in block letters, and nothing more. Note can also be taken of the situation in the modern business world where marketing is a vibrant part of any company, and there is nothing to stop either side from changing the get-up of their packaging. Accordingly I do not consider this to be a relevant factor in these proceedings, although it may be in a passing off action - see Kerly paragraphs 855-856. There is no colour limitation on the Opponent's registration, nor are there any other limitations. All that the Opponent is required to do is to place the word mark LIFCICIN on its goods in order to obtain protection.

13. Kay J. in the Australian Wine Importers' case (1889) 41 Ch. D at p. 281 put the test of same description of goods in the terms of a question :-

"Are the two sets of goods so commonly dealt in by the same trader that his customers, knowing his mark in connection with one set and seeing it upon the other, would be likely to suppose that it was used upon them also to indicate that they were his goods?"

Therefore, would the customers of LIFCICIN be likely to suppose that goods bearing the mark LIFCICIN were goods of the same trader, and vice versa?

14. Finally I must consider the remarks of Lloyd - Jacob J. in relation to pharmaceutical preparations in Barker Stagg Ltd.'s Application (1953) 70 R.P.C. at p. 240 :-

"... Had the matter been one for my initial consideration, I should, I hope, have appreciated that, having regard to the absence of any restriction upon the means of distributing these goods, and the fact that all sorts and conditions of people may be either visited with complaints which require their consumption or may be sent to procure supplies of these goods, the matter properly falls to be considered by an examination of the two marks, and, if there were, or is, any reasonable

ground for supposing that by reason of their similarity confusion or deception is likely to arise, the fact that they are used in relation to a pharmaceutical preparation is, perhaps, all the more reason for seeing that the public are protected from the consequences of deception and confusion."

15. Although the goods in this case are each sold through the same trade channels and both products are available without any prescription, it is clear that these marks differ in their nature and composition and in their respective uses. It is an attractive argument to say that nobody is going to buy goods which can only be injected unless he is absolutely sure of the same, but it is also true that very few salesmen (if any) are going to question a customer as to why he needs a particular product and whether he is aware of the fact that it is to be administered only by injection. Therefore, bearing in mind all the evidence and the dicta of Lloyd - Jacob J. above, I find that these two marks are <sup>being used in</sup> goods of the same description, and therefore the Applicant fails in its submission that LYFOSCIN are different goods to LIFOCIN, and that Section 20 of the Ordinance does not apply.

16. Hence the next question is whether the Applicant's mark "so nearly resembles" the Opponent's mark "as to be likely to deceive or cause confusion" in terms of Section 20. At the same time the application of the restrictions contained in Section 12(1) may be considered. It is apparent that Section 12(1) is wider in scope than Section 20 because in Section 12(1) there need be no question of the two marks being used in respect of the same description of goods or necessarily having a resemblance the one to the other. Under Section 12(1) the only question broadly speaking, is whether the use of the proposed mark would be likely to deceive. In considering that question one necessarily takes into account the similarity of the goods covered by the marks, and the degree of resemblance between the two marks.

17. In considering the question of whether the use of a particular mark is likely to deceive or cause confusion one must take into account those persons "who are likely to become purchasers of the goods upon which the marks are used, provided that such persons use ordinary care and

intelligence. It is clearly not enough to show that retail dealers buying goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade mark to deceive their customers, the ultimate purchasers" - see Kerly paragraphs 835-836. It is not necessary that the purchasers have knowledge of the manufacturer's name but only that the purchasers recognize the goods as that of a particular class - Powell v Birmingham Vinegar (1897) 14 R.F.C. 720 and E. Edge v Nicolls (1911) 28 R.F.C. 582, whereas there was only a limited class of people involved in C. Ash Sons & Co. Ltd. (1942) 29 R.F.C. 465, but as Mr Ching mentioned although these 3 cases were all passing off actions, they are of some relevance on the question of deceptiveness.

18. I now turn to the question of the spelling of these two word marks. Mr Howard H. Berger in his Declaration of 22.5.69 noted they were both 8 letter words, but the Opponent's mark contains the letter F and two letter I's whereas the Applicant's mark contains the letters Y, F and N, with the letter O and the suffix "CIN" being common to both these word marks. Mr Shoji Matsui in his Declarations of 27.2.67 and 24.10.68 went further by saying that the only difference was in the middle part of the marks which were "FOR" and "FOI" respectively, and that because little emphasis is given to each middle letters, this would lead to confusion of the marks by being misspelled or misread by dealers and consumers. But is this the right approach, to take each syllable and letter and compare the two marks?

It is clearly not a correct approach when the authorities are examined and they lay down the test that the marks should be compared as a whole including appearance, the idea of the mark, reference to the ear as well as to the eye, and the recollection by a customer of the mark as a general impression. These useful rules of comparison can be found in Kerly at paragraphs 837-858.

19. The classic test was laid down by Parker J. in the case of Pianotist Co. Ltd.'s Appn. (1906) 23 R.F.C. 774 at p. 777 :-

"You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy

those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

and this has been followed by Farwell J. in W. Bailey (Birmingham) Ltd.'s Appn. (1935) 52 R.P.C. 136 (the "Erectiko" case) :-

"I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole .... I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word."

and again by Luxmoore J. (who was upheld by the House of Lords) in Byeta Ltd.'s Appn. (1943) 60 R.P.C. 87 at p. 108 :-

"It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description but also of the shop assistant ministering to that person's wants."

See also similar remarks as to general recollection and general impressions by Sargent J. in Sander's Application (1914) 31 R.P.C. 196 at p.205; and Lord Lindcliffe in de Cordova v Vick Chemical Company (1951) 68 R.P.C. at p. 106.

20. The test of imperfect recollection in the last quoted case is quite an important one when considering whether there is likely to be any

deceptive resemblance in the minds of the ultimate purchasers. "It would be a mistake however to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical use." per Lord Cranworth in Seixo v. Provesende (1866) L.R. 1 Ch 192 at p. 196.

21. Obviously a relevant point in respect to a person's impression and recollection of a mark will be whether the sound of one word too nearly resembles the sound of another word, and how the respective word marks are or can be pronounced will have a bearing as to whether there is any resemblance between the marks.

One of the most difficult problems in this hearing has been how to pronounce the respective words LYFORCIN and LIPCICIN.

The Applicant's mark Lyforcin is open to various alternatives : "ly" can be pronounced as a short "i" as in "lynix" and "lyric", or as a long "i" (making it "lie") as in "lying", "lysine" and "lycous", and being a three syllable word, can conceivably be Ly-for-cin or Lyf-or-cin. The three Declarations by Messrs Fung Kam Yip, Tam Hau Man and Ho Kwok Hoi (all filed on behalf of the Applicant) pronounced it with a long "i" by saying it was as if spelt "Lye-for-cin", which would be consistent with "lysine" which is a major ingredient of Lyforcin. Miss Cheong in her Declaration pronounced it as "Lif" and the two Declarations by Mr Lau Hoi Pak and Mr Cheong Ng Cheong (all filed by the Opponent) said "it was pronounced either "Lif" or "Lye" but more often that not the former pronunciation is used by purchasers of the goods bearing this mark", which is also quite possible if a person does not know the correct grammatical pronunciation of "lysine". The Opponent's mark has a slightly different alternative : it can be pronounced as either Li-poi-cin, or by taking the first three letters as in the word "Lip", and become Lip-oi-cin. The five Declarations by Messrs Fung Kam Yip, Tam Hau Man, Ho Kwok Hoi, Lau Hoi Pak and Cheong Ng Cheong all pronounced it as "Lip-oi-cin" as did Mr Ching, counsel for the Opponent. I rejected the comment by Mr C.S. Lo that it would have a different pronunciation in Japan, because we are dealing with an English word in Hong Kong and there are no Japanese characters forming part of the mark. However an examination of the various dictionaries as to the word "Lipoic Acid" (from which

the mark is obviously derived) states the word 'lipoic' is pronounced with a short "i", and with the emphasis on the first two letters (see Webster's Third New International Dictionary) and therefore could be Li-poi-cin.

22. As there seems to be general agreement in the evidence on pronouncing these marks as "Lip-oi-cin" and some agreement on "Lye-for-cin", do I have to accept these views? The evidentiary value of statutory declarations was discussed by Morton J. in Hack's Application (1941) 58 H.F.C. 91 at p. 110 :-

"But in my view, it is not the right or proper way of preparing evidence for a case of this kind to put before members of the trade, or members of the public, a statutory declaration already drafted containing statements of fact and (as in the present case) statements as to what the witness would have thought if certain things had happened or impressions of the witness without ascertaining by means of non-leading questions and answers that it represents his views."

A statutory declaration drafted by a solicitor and not accompanied or preceded by a questionnaire may be of little weight but it is admissible evidence - Morney Ltd.'s T.M. (1951) 68 R.P.C. 131. It is also clear that the hearing officer has to exercise an independent judgment on the questions at issue yet any evidence tending to show probability of confusion or its absence must be considered - Application by G. Angus & Co. Ltd. (1943) 60 R.P.C. 29 at p. 32. Here the Declarations by Mr Lau Hoi Pak and Mr Cheong Ng Cheong on behalf of the Opponent are exactly the same, whilst that of Miss Ella Cheong, the Solicitor for the Opponent, was properly objected to by Mr B.L. Lo as being an interested party. Again the Declarations filed by the Applicant and made by Messrs Fung Kam Yip, Tau Hau Man and Ho Kwok Hoi are all exactly the same. This leads to the suspicion that neither side preceded any of these Declarations by a questionnaire.

23. It is relevant to note that some people will have a tendency to slur the terminations of words - London Lubricants (1920) Ltd.'s Application (1925) 42 R.P.C. 264. One must consider the likelihood of

confusion in the situation where an order involving two similar word marks is placed by telephone when, as is very often the case, people do not speak clearly or slowly enough to enunciate the difference in the words - British Drug Houses Ltd.'s Application (1913) 30 R.P.C. 73, Magdalena Securities Ltd.'s Application (1913) 48 R.P.C. 477, and Salz & Org. v. Sutton & Org. (1934) 51 R.P.C. 129. Also, when in a chemist's shop amongst the probable noise and bustle of other people, there is the chance that the attendant will not give his full and proper attention to the exact order. In either of these situations there must inevitably be many occasions when an order is imperfectly heard. Kerly also notes at paragraph 849 that it has been accepted in several reported cases that the first syllable of a word mark is generally the most important, but there is considerable doubt with these two words as to what constitutes the first syllable. Both the marks are in my view, three syllable words (Lipoicin is not four syllables as claimed by the Applicant in their Counter-Statement) and this similarity is relevant as to whether there is likely to be confusion or deceptive resemblance. Precedents of words which have been found to be too similar to one another are given in Appendix 12 of Kerly at p. 710-714 e.g. Gernosea - Germalene, Emollie - Emolline, Securine - Seccotine, Murrilo - Muralo, Honomol - Honyol etc. Those examples of course have no direct bearing upon this decision which has to be decided on its own merits and the evidence.

24. Mr Ching submitted that the Applicant's mark can be pronounced either as Lye-for-cin or as Lif-or-cin, but if pronounced as "Lif-or-cin" then the difference with lipoicin is marginal bearing in mind the difficulty Chinese people find in pronouncing English words.

25. It is therefore clear to me that no matter which way these two word marks are pronounced (whether it be Lye-for-cin or Ly-for-cin, or whether it be Lip-oi-cin or Li-poi-cin) I am satisfied that there is likely to be confusion between LIFORCIN and LIFCICIN, without making a ruling as to what is the correct pronunciation of each mark. Even if they were pronounced as Lye-for-cin and Lip-oi-cin the resemblance between the respective sounds and taking the marks as a whole is such that a person would, in my opinion, be confused when trying to recollect the mark.

26. So far as the appearance of the marks in actual use when fairly and honestly used are concerned (see Smith Hayden & Co. Appn. (1946) 63 R.P.C. 97), I have examined the specific uses of these goods but the question remains as to whether there is a risk of a purchaser obtaining the wrong product, remembering that both are available in Hong Kong without a doctor's prescription? It is true to say that the average person when he goes to a chemist shop has a specific requirement in mind which will determine the type of product he wants to buy. It is, therefore, unlikely that he is going to accept a nutritional lysine hematinic when in fact he wants something for treatment of hepatitis, cirrhosis or jaundice which he can only use by means of an injection. However, Messrs Cheong Ng Cheong and Lau Hoi Pak on behalf of the Opponent in paragraph 5 of their respective Declarations stated that there had been many cases of confusion between the respective marks and it was necessary to ask the customer the purpose for which he required the goods. On the other hand Messrs Fung Kam Yip, Tam Hau Man and Ho Kwok Hoi on behalf of the Applicant in paragraph 5 of their respective Declarations stated that there has been no case of confusion "...owing to the two distinctive pronunciations of the marks in question" but I doubt whether that statement has much value in view of my finding - in paragraph 25 hereof that whichever way these two word marks were pronounced, there would be confusion. Accordingly the evidence of the Opponent is to be preferred on this point. The remarks of these five declarants are nevertheless interesting because the Applicant's mark has only been used in Hong Kong since December, 1963 and these opposition proceedings commenced one year later, which does not allow much time to see if there has been any cases of confusion between these two marks. Kerly examines the question as to the evidence necessary to establish actual deception at paragraph 868 and points out that where a mark is new or nearly new there can have been little or no opportunity for deception to occur. However, it is clear that any decision as to deception is for the Court to decide and it should not abdicate its powers in favour of witnesses. - see Harker Stag Ltd.'s T.M. 71 R.P.C. 136 at p. 140. Nevertheless the question of deceptive resemblance or confusion is not an exercise of discretion by a tribunal but a finding of fact - see Byata Ltd. Appn. (Ibid) at p. 105. Finally, the remarks of Kerly at paragraph 833 must also be considered :

"In cases in which the tribunal considers that there is doubt as to whether deception is likely the application should be refused."

27. To summarise the evidence under Section 20 of the Ordinance I find that LYFORCIN and LIPCICIN are goods of the same description, and bearing in mind that both marks are available without prescription, the tendency of people to slur their words, the possibility of confusion in hastily or badly written orders, and that whichever way the marks are pronounced people would be confused when trying to recollect the mark, and accordingly that LYFORCIN so nearly resembles LIPCICIN as to be likely to deceive or cause confusion. Thus the Applicant fails in its submission that the second part of Section 20 does not apply.

28. Even if I am wrong in my finding that the marks are goods of the same description under Section 20, then taking all the evidence into account, and the remarks of Kerly at paragraph 833 (at paragraph 26 hereof), I am of the opinion that the use of LYFORCIN "would be likely to deceive" within Section 12(1) of the Ordinance, and is therefore unregistrable.

29. One of the most interesting questions in this hearing was the submission by Mr W.S. Lo that the Opponent's mark should not have been permitted to be registered as it was descriptive of the generic term "Lipoic Acid". I take this to mean an implied application for rectification and correction of the register under Section 48(1) of the Ordinance, but on the other hand I can only deal with such a matter if a formal application has been submitted under Trade Mark Rule 63 and the various forms and documents which should have been lodged thereunder had been filed prior to this hearing. Nevertheless Mr Ching addressed me on the registrability of the Opponent's mark under Section 12(1). He submitted that it would not be likely to deceive nor would be disentitled to protection in the Court of Justice. He argued that the Opponent's mark was an invented word and that it had accordingly been registered in respect of (inter alia) "pharmaceutical, veterinary and sanitary substances". There is little doubt in my mind that by adding the distinctive suffix "cin" onto part of the word "Lipoi" then it is entitled to the protection of the proviso to Section 12(2) of the Ordinance in that it is a word denoting only the brand or marks of the element or compound of the proprietor. By acquiring distinctiveness as an invented word, the mark does not offend against the provisions of Section 9(1)(d) of the Ordinance. But when it comes to the

question of deceptiveness then it is open to doubt that by having such a wide specification for which Lipoinin is registered the mark can obviously not be used on all pharmaceutical or other products if they do not contain Lipoinic Acid, and accordingly the mark ought to be limited in its specification to goods consisting of or containing the chemical element or compound which forms part of the mark. Hence Mr Ching's claim to protection as to the whole class of goods for which Lipoinin has been registered must be rejected except for a limited range of pharmaceuticals. However, I have no powers at this hearing to amend the specification of the Opponent's mark which I could only have done if there had been an application for rectification under Section 48 by the Applicant or an application under Section 50(1)(d) for amendment by the Opponent. This does not mean to say that Lipoinin is unregistrable under Section 12(1) in respect of pharmaceuticals because it would not be deceptive for that limited class of goods, and the Applicant has not produced any evidence to show that Lipoinin has been causing deception in the minds of the purchasing public.

30. The Applicant went on in its submission to note that as "LIPICIN" has only been registered in those places where English was not the predominant language of the country, and this established that it was non-distinctive and not qualified for registration in Hong Kong (although one of the countries where the Opponent's mark is registered is Singapore whose Trade Marks Ordinance is similar to our own). The Opponent replied that the interpretation of the registrability of a mark under the Trade Mark laws of other countries is not a relevant factor to be taken into account at this hearing, and equally speaking, its non-registration in other countries, and with that I agree.

31. I find, therefore, that the Opponent's mark was correctly accepted for registration but should have its specification amended to read "pharmaceutical preparations, containing lipoinic acid" to make it absolutely clear that it would not be deceptive nor would it be disentitled to protection in a Court of Justice, and the Opponent should make an application to do so with all possible despatch.

32. Having limited the specification of goods in respect of each mark, the interesting problem then arises as to whether the Applicant could succeed in its submission that each mark is used in respect of goods or a

description of goods, that are different, the one from the other. If so, then of course the restrictions contained in Section 20 will not apply. The Applicant argued that LYFORCIN being "pharmaceutical products namely a nutritional supplement" are not the same goods as LIPOICIN being "pharmaceutical preparations containing Lipic Acid".

In my opinion there is no substantial difference for the reasons that I have already explained and they would still be goods of the same description which so nearly resemble each other as to be likely to deceive or cause confusion, and thus the Applicant's mark is prohibited from registration. Also viewing the two marks as a whole and bearing in mind the difficulties of pronunciation by the populace of Hong Kong who speak Chinese as their first language, the use of LYFORCIN would also be likely to deceive under Section 12(1).

It is interesting to note that the "Diasil - Alasil" case (River's Products Ltd.'s Appn. (1947) R.F.C. 125) was distinguished in the "Aludrox - Algelox" case (Harker Stagg Ltd.'s Appn. (Ibid - paragraph 14 hereof)) on the grounds that "Diasil" was allowed registration for a limited class of user but could not be sold except under a doctor's prescription, whereas "Aludrox" was available to all and sundry persons, and failed to have "Algelox" removed from the register. This point is relevant because LYFORCIN is also available without a prescription to all and sundry.

35. The final submission by Mr W.S. Lo was that the Applicant's mark could nevertheless be registered under Section 22 in that it is a case of honest concurrent user. Mr Ching objected that this point had not been pleaded but bearing in mind the decision of Brown Shoe Co. Appn. (1959) R.F.C. 29 at p. 34 where a similar objection was dismissed as a technicality of non-substance the point having been clearly raised in the evidence, I asked him for a reply. Mr Ching submitted that Section 22 could only be applied in the light of the evidence on the date of the application - see Jellinecks Appn. (Ibid) at p. 78 and the Applicant had claimed on the 28th February, 1964 that it had used the mark in Hong Kong in respect of such goods only since December 1963 (i.e. 3 months) and this, therefore, was an insufficient period of use - see Peddie's Appn. (1944) 61 R.F.C. where exceptional circumstances existed and a period of two and quarter

years was treated as sufficient, whereas 9 months was not a long enough period in Smith Hayden & Co. Ltd. Appn. (1946) 63 R.P.C. at p. 98. The main matters to be taken into account under Section 22 were laid down by Lord Tomlin in Pirie's Appn. (1932) 50 R.P.C. 147 and the list is set out in Kerly at paragraphs 338. Whilst I find that the Applicant has been entirely honest in its user as there has been no evidence of any intention to deceive on its part, I consider that the measure of confusion which I have explained before and the protection of the public who will be considerably inconvenienced if a person obtains the wrong product, and particularly the short period of time of user will debar the Applicant from succeeding on this ground. There is also the alternative in Section 22 "of other special circumstances" but I cannot find any here so as to allow registration. This does not debar the Applicant from making a new submission under Section 22 at a later stage in order to obtain the advantage of a longer period of time - see Portogrom Radio Electrical Co. Ltd. Appn. (1952) 63 R.P.C. 241.

34. Bearing in mind all the circumstances of this case and the evidence which has been submitted and which I have fully examined in accordance with the various sections of the Ordinance, I therefore find that the Applicant has not discharged the onus upon it that LYFCRCIN is not likely to deceive or cause confusion. Accordingly I refuse the application.

35. Under Section 82 of the Ordinance I award costs to the Opponent on the scale set out in Order 62 of the Supreme Court Rules.

*A. R. Harder*

A. R. HARDER  
p. Registrar of Trade Marks

Dated the *6<sup>th</sup>* day of March 1972.

IN THE MATTER of the Trade Marks Ordinance

AND

IN THE MATTER of an Application by C. S. Ethicals Inc., to register the trade mark "Lyforcin" in class 5 in respect of pharmaceutical products namely a nutritional supplement.

AND

IN THE MATTER of an Opposition by Takeda Chemicals Industries Limited the proprietors of the trade mark "Lipoicin" registered in H.K. under No. 340/63 in class 5 in respect of (inter alia) pharmaceutical, veterinary and sanitary substances.

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D E C I S I O N

of

Mr A. N. Hearder,

acting for the Registrar of Trade Marks

Dated the 6<sup>th</sup> day of March 1972.

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Trade Marks Registry,  
Saxmally Building,  
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