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**IN THE MATTER of the Trade Marks
Ordinance**

AND

**IN THE MATTER of an Application by
The Curtiss Candy Company for the
registration of the word mark
"Butterfinger" in class 30 in respect
of candy and confectionery.**

DECISION

of

**Mr P. Jacobs, Assistant Registrar General, after a hearing on
the 31st July 1970 at which Mr William Turnbull, Jr. of Messrs
Deacons appeared for the Applicants.**

**On the 28th February 1966, The Curtiss Candy Company
(hereinafter referred to as "the Applicants") submitted through
their agents, Messrs Deacons, an application for the registra-
tion in Part A of the register, of the word "Butterfinger" in
class 30 in respect of candy and confectionery.**

**The supporting statutory declaration made by Mr James
E. Sapp, Jr., the Applicants' Secretary, and dated the 28th
February 1966 stated that the mark had not been used by the
Applicants in Hong Kong in respect of the goods mentioned in
the application, but that it was the Applicants' intention so
to use it if and when it was registered. The declaration went
on to say that the mark was at that time registered in a number**

of other countries in the Applicants' name.

On the 27th July 1966 the Registrar informed Messrs Deacons that the mark was not acceptable for registration because the word "Butterfinger" would carry the meaning to the purchasing public that the candy and confectionery to which the mark was applied, contained a predominant proportion of butter and was in the shape of a finger. Such a degree of descriptiveness rendered the mark not registrable under section 9(1)(d).

On the 18th February 1970 after some correspondence Messrs Deacons applied for a hearing in accordance with section 74 of the Trade Marks Ordinance and rule 18 of the Trade Marks Rules. The hearing at which Mr Turnbull of Messrs Deacons appeared on behalf of the Applicants took place before me on 31st July 1970.

Mr Turnbull produced a wrapper used to contain the product concerned in this application. The wrapper is approximately 7" long by 1½" wide and the word "Butterfinger" appears along its length. On one side of the wrapper there is a description of its contents. This reads as follows :

"BUTTERFINGER is a delicious blend of SUGAR, CORN SYRUP, PEANUT BUTTER, HYDROGENATED VEGETABLE OIL, POWDERED SKIM MILK, COCOA, MOLASSES, CHOCOLATE, CONFECTIONERS CORN FLAKES, SALT, LECITHIN, STARCH, ARTIFICIAL FLAVOR, GLYCERIN, U.S. CERTIFIED ARTIFICIAL COLOR."

Apart from this description on the wrapper no evidence was adduced as to the composition or nature of the candy or con-

fectionary manufactured by the Applicants.

Mr Turnbull argued that the word "Butterfinger" should not be split into two words, "Butter" and "Finger", but should be treated as one, and that the word "Butterfinger" itself had a dictionary meaning quite distinct from the meanings of the component parts of the word; that the word "Butterfinger" means a person who did not catch things well. He said that this was the accepted meaning of the word and submitted that the mark should be considered as one word and not as two. This viewpoint had been put forward in correspondence in 1966. I cannot accept this argument. It is true that there is a word "butterfingered" and a word "butterfingers", the former defined in Webster's Third New International Dictionary as "apt to let things fall or slip through the fingers", and the latter as "a butterfingered person". The word "butterfingers" although plural in form is singular in construction. Webster's Third New International Dictionary does not explain the derivation of the word. However, the Shorter Oxford English Dictionary, in its definition of "butter-fingered" (incidentally appearing as a hyphenated word and not as one word) states that the meaning is "that takes hold as if with fingers greased with butter". I consider that the word "butterfingers" although having the particular meaning attributed to it in Webster's and the Shorter Oxford Dictionary, is derived from the quality of butter as a substance and, accordingly, if used in connection with a food product the dictionary meaning attributed to the word as quoted above should not prevail. Furthermore, as I have pointed out the word is used

in the plural form. Although the fact that a word is in the plural or in the singular should normally make no difference when examining it in connection with an application to register a trade mark, I consider that in the present case it can make a difference. The dictionary word "butterfingers" is not used in its singular form to bear the meaning "a butterfingered person". In relation to a food product, which could contain butter, I consider that the word "butterfinger" should be treated as phonetically indistinguishable from the two words "butter" and "finger". It is well established that a mark, which is the phonetic equivalent of an unregistrable mark is itself unregistrable. In the "Electrix" case [1959] 76 R.P.C. 282 at page 286 Viscount Simonds said :

" My Lords, I can conveniently state the problem to be solved by the citation of a single sentence from the judgment of the Court of Appeal : "The doctrine", they said, "As we understand it, is that, if a given word is for any reason unregistrable in its proper spelling, then, inasmuch as Trade Marks appeal to the ear as well as to the eye, the objection (whatever it may be) to the registration of the properly spelt word applies equally to a word which is merely its phonetic equivalent."
Applying that view of the law to the facts of the present case the Court of Appeal held that "electrix" being the phonetic equivalent of "electrics" and that word being unregistrable, "electrix" also was unregistrable.

In my opinion the proposition or doctrine of law, upon which the Court of Appeal founded, is accurately stated and supported by authority and reason, and it was correctly applied."

If the mark in this application is to be accepted for registration it could only be on the basis of para. (c) or para. (d) of section 9(1) of the Trade Marks Ordinance; that is to say, either as an invented word or invented words or as a word or words having no direct reference to the character or quality of the goods. I do not think that the word "butterfinger" can be correctly treated as an invented word. In the Solie case, Eastman Photographic Materials Co. Ltd's Application [1898] 15 R.P.C. 476 at page 483 Lord Halsbury said :

"I desire to give my opinion with reference to the particular word, and not go behind it. I can quite understand suggesting other words - compound words, or foreign words - as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word 'Cheapandgood' or even without taking so gross an example, using a word so slightly differing from an ordinary and recognised word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character

or quality. The line must be sometimes difficult to draw; but, to my mind, the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in substance there has been an infringement of the rule."

In the same case, at page 487 Lord Shand said :

" ... There must be invention, and not the appearance of invention only. It is not possible to define the extent of the invention required, but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two ^{known} words, would not be an "invented" word; and a word would not be an "invented" which, with some trifling addition or very trifling variation, still leaves the word one which is well-known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word."

(The underlining is mine)

In my opinion, therefore, the word "butterfinger" should be treated not as the word "butterfingers" having the special meaning "a butterfingered person" but as the separate words "butter" and "finger", and for the reasons given in the passages from the Solio case set forth above, I do not consider that the single word can be treated as an invented word.

The question is then whether the words have a direct reference to the character or the quality of the goods. In Webster's Third New International Dictionary "butter" is defined inter alia as "1. an important food consisting of a solid emulsion mainly of fat globules, air bubbles, and water droplets made to coalesce by churning the cream obtained from milk and used esp. as a spread on bread and in cooking 2: a substance resembling butter esp. in consistency: as c: a smooth food spread made from fruit, nuts, or other food". I think that this definition is wide enough to embrace the peanut butter used by the Applicants in manufacturing their product. Mr Turnbull drew my attention to the word "butterscotch" in Webster's where it is defined as "a hard candy made by boiling together brown sugar, corn syrup, and water". However, the Shorter Oxford English Dictionary defines "butterscotch" as having a butter content, and this is borne out by the definition in Chamber's Twentieth Century Dictionary. Regrettably, we had no opportunity either to sample or to analyse butterscotch and I cannot therefore say whether or not butterscotch, in fact, contains any butter. However, I do not consider that the composition of butterscotch is important for two reasons. Firstly, as I have mentioned above, the definition of "butter" given in Webster's includes a substance resembling butter especially in consistency, and also a smooth food spread made from fruit, nuts, etc. Secondly, the wording of section 9(1)(d) of the Trade Marks Ordinance prohibits the registration of words having a direct reference to the "character or quality" of the goods. I think that the word

could have a direct reference to the character of ^{the} goods notwithstanding the fact that it did not give an exact and scientific description of those goods. I think that the word "butter" could therefore indicate the character of the goods even though there was no actual butter content. If I am wrong in this and if the definition of "butter" could not be taken to include peanut butter I consider that the mark applied for would offend the provisions of section 12(1) of the Trade Marks Ordinance which provides :

"12(1) It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would be likely to deceive or would be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design."

As far as the word "finger" is concerned Webster's gives amongst others these definitions : "one of the five terminating members of the hand; something that resembles or does the work of a finger (a finger of toast) (a finger of land extending into the sea) (a finger of a clock)". In the Ribbon case - Colgate & Co.'s Application [1913] 30 R.P.C. 262 at page 265 Mr Justice Parker said:

"It appears to me that it is absolutely clear that the word "Ribbon," as already in use by the Applicants, is descriptive of the form or character of their goods. It is descriptive of their form or character in this respect: that it in effect states

the manner in which the cream comes out of the tube, and lies upon the brush, namely, in the shape of a ribbon."

Clearly, the use of the word "finger" in the present application is designed to indicate the shape of the product, and the use of the word therefore has a direct reference to the character or quality of the goods.

For the above reasons I hold that the mark cannot be treated as an invented word under para. (c) of subsection (1) of section 9 of the Ordinance and that the word "Butterfinger" has a direct reference to the character or quality of the goods and is therefore not registrable under para. (d) of subsection (1) of section 9 of the Ordinance. Alternatively, if I am wrong in my reasons given above regarding the definition of "butter", the mark would not be registrable by virtue of section 12(1) of the Ordinance.

I accordingly refuse the application.



(P. Jacobs)
Assistant Registrar General
10th October 1970

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D E C I S I O N

by

Mr P. Jacobs

Acting for

the Registrar of Trade Marks

dated 10th October 1970

TRADE MARKS REGISTER

HONG KONG