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IN THE MATTER OF the Trade Marks Ordinance  
(Cap. 43) Section 13(4) and IN THE MATTER OF  
an Application No. 519 of 1973 by The Dow  
Chemical Company to register the Trade Mark  
"RELDAN" in class 5

Statement of Grounds of Decision

1. On the 7th May 1973 Messrs. Deacons, Solicitors of Hong Kong, acting as agents on behalf of The Dow Chemical Company a corporation organised and existing under the laws of the State of Delaware and having its business address at Midland, Michigan, in the United States of America the Applicant herein submitted an application for the registration of the Trade Mark "RELDAN" in class 5 in respect of a specification of goods reading "chemical substances used as a tive ingredients in the manufacture of pesticides; pesticidal chemicals; preparations for killing plants and destroying animals; pesticides, parasiticides, insecticides, miticides, larvacides, fungicides, algacides, herbicides and soil sterilants and fumigants". On the 23rd July 1973 by request on Form T.M. No. 33 this specification of goods was amended to read "pesticidal products". The supporting statutory declaration dated 12th April 1973 made by Mr. William Miller Yates stated

- (a) that the Trade Mark had been used by the Company in the United States of America in respect of the goods mentioned in the application since the 28th June 1972;
- (b) that the Trade Mark had not hitherto been used by the Applicant in Hong Kong in respect of the goods mentioned in the application, but that it was the Applicant's intention to use the Trade Mark if and when it is registered, and
- (c) that the Trade Mark was at that time registered in Argentina.

2. After due consideration of the application in respect of the original specification of goods notification was sent on the 6th June 1973 to the Solicitors that the mark was considered to be in conflict with what was at that time Pending Application No. 1612 of 1972, since matured into registration No. 708 of 1973, contrary to Section 20 of the Trade Marks Ordinance. This cited mark "RELDAN" was proposed to be registered in respect of "pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; plasters, material for bandaging; material for stopping teeth dental wax; disinfectants; preparations for killing weeds and destroying vermin", but was in fact subsequently registered in respect of "pharmaceutical preparations for human use".

3. In response to the letter of the 8th June referred to in para. 2 above, the request for restriction of goods by the Applicants herein was submitted and the requested restriction effected, and at the same time the Applicants submitted a letter of consent from the proprietors of the then proposed mark "HELDAN" to the registration in Hong Kong of the applicants' mark "HELDAN" in respect of "pesticidal products".

4. Notwithstanding such restriction of goods and letter of consent the objection to the mark under Section 20 was maintained by a letter dated the 8th August 1973. Subsequent thereto, on the 16th August 1974 an informal meeting took place between Mr. R.M. Bridge of Messrs. Deacons and myself at which Mr. Bridge submitted arguments in favour of the acceptance of the mark. Nevertheless I maintained the objection to the application by letter dated the 9th September 1974 and subsequent thereto Messrs. Deacons submitted a letter dated the 14th September 1974 which I take to be a considered reply for the purposes of Trade Mark Rule No. 20(1). Thereafter, Messrs. Deacons by application on Form 5 dated the 7th October 1974 asked for this Statement of Grounds of Decision. There having been no formal hearing in connection with the registrability of this mark, this Statement is necessarily confined to the matters raised in correspondence between the Solicitors acting for the applicants and the Trade Marks Registry. Furthermore, no use of the mark prior to the date of the application for registration having been claimed in Hong Kong, and no special circumstances having been brought to my attention, as regards the cited registered Trade Mark, consideration under the terms of Section 22 of the Ordinance does not arise. The relevant part, therefore, of section 20 with which this Statement is concerned reads as follows:

"... 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.". In addition the Registrar may exercise his discretionary power under section 13(2) of the Ordinance adversely to an applicant if he considers that it would be against the public interest, as constituting a potential hazard to health, to register an applicant's mark if it is confusingly similar to a mark registered in respect of goods not of the same description but likely to be a hazard to health if confused with those of the applicant's mark, or vice versa. (see Edward's Application (1946) 63 R.P.C. 19).

5. There have been no submissions in the correspondence between the Registry and Messrs. Deacons regarding the similarity of the applicants' mark and the cited mark and in the circumstances of this case I do not consider this surprising. In my view the close similarity between the words "Reidan" and "Reledan" is obvious and I do not think that I need to go to great lengths to establish this point. I must of course consider the cases of telephone orders and handwritten orders as well as orders from a visual inspection of the goods bearing the marks, and I do not think that in any of these cases the presence of the additional letter "O" in the middle of the cited mark "Reledan" will prevent the confusion that I consider to be highly probable. I concede that in some cases the addition of a single letter, which may result in one mark being one syllable longer than another, may make a meaningful difference, but I do not consider that to be the case here.

6. The principal factor on which reliance has been based by the applicants in urging the acceptability of the mark is the difference in the goods to be covered by their mark and those covered by the cited mark, and the granting of consent to the registration by the proprietor of that cited mark. This question of whether the goods of the application, "pesticidal products", not being the same goods as those in respect of which Reledan is already on the Register i.e. "pharmaceutical preparations for human use", are of the same description as those goods is in my view the important question for decision under section 20. In considering this question I also take into consideration that it has been indicated that the applicants are willing to restrict their specification of goods to those "for agricultural use" or to "pesticidal products namely insecticides for agricultural use". The factors to be considered in deciding whether specified goods are of the same description as other specified goods were set out in the judgment of *Viscount J. in Jellinek's Application (1946) 63 R.P.C. 59 at P.70* as follows:

- (i) the nature of the respective goods
- (ii) the uses of the respective goods
- (iii) the trade channels through which the respective goods are bought and sold.

In applying these criteria, the practice of the T.M. Registry in Hong Kong is based on that established and maintained over a period of many years in the United Kingdom, and to detail and explain this practice I refer to the decision of *Mr. Ward Dyer in "Floradix" Trade Mark 1974 R.P.C. 583 at P.586* where he states:

"the Registrar holds, and has consistently held for many years, that all goods covered by the class heading to class 5 of schedule IV except "plasters, material for bandaging; material for stopping teeth, dental wax" are goods of the same description. The reasons for so holding are that although the uses of the wide range of goods concerned vary their nature is the same in that all of them have or are intended to have a specific effect or specific effects, curative, palliative, inhibitory, diagnostic, fortifying or destructive, in relation to living organisms; and that all of them pass through the same channels of trade, for the most part at the manufacturing level and without exception (in so far as they are traded in by wholesale or retail) at the wholesale and retail levels. ... Based as it is on accepted tests for the purpose of section 12 the longstanding practice of the Registrar so far as concerns most of the goods included in class 5 of schedule IV (and in classes 2 and 3 of schedule III) has the additional, if incidental, advantage that so far as lies within the Registrar's power it tends to reduce the risk of physical confusion between different goods in this field, with possible harmful results, which would otherwise have to be considered separately under the discretionary aspect".

Some argument has been submitted, in Messrs. Deacons letter of 14.9.74, regarding the use of, and trade channels through which, the respective goods of the applicant and registered proprietor of the cited mark would pass. I therefore now consider the 3 factors or tests laid down in Jellinek's application, although in different order

- (1) the uses of the respective goods - as stated above the applicant has indicated its willingness to restrict the goods effectively to pesticidal or insecticidal products for agricultural use, which is a reasonably specific and limited range of goods. Unfortunately the specification of the cited registered mark is far wider, covering as it does "pharmaceutical preparations for human use". I have no evidence or information before me as to the actual goods on which that mark is used, but the proprietor thereof F. Hoffmann-La Roche & Co. Ltd. being a well known and large pharmaceutical manufacturer, I consider it likely that the range of goods now covered, or likely to be covered in the future, by the mark is wide. It could for example cover anthelmintics for human use which to my mind, although I have no knowledge of the respective chemical composition of the two items of goods, would be similar to pesticides or insecticides, in that their purpose is to destroy living organisms.

- (2) the nature of the respective goods - again, as a result of no evidence having been put forward to me as to the precise goods covered by the registered proprietor's cited mark, a comparison of the nature of the respective goods is difficult, and I do not consider that the application of this sub heading can be conclusively decided one way or the other.
- (3) the trade channels through which the respective goods are bought and sold - it has been submitted that the goods the subject of the application will be marketed through different channels of commerce or distribution and to a different purchasing public. It is my experience in Hong Kong that goods of both sorts which I am now considering are commonly sold side by side in the many stores which carry a vast and varied stock of goods. Furthermore I take into account the recent increase in the number of "supermarkets" opening which as their name correctly implies attempt to sell as many different items as possible under one roof. I do not think therefore that it can be assumed that the respective goods will not pass through the same channels.

Accordingly, considering the above points and also taking into account

- (1) the practice of the Registrar in the U.K. and
- (2) the fact that it is not essential that all 3 criteria set out in Jellinek's Application be satisfied (see that case at P.72 lines 7-13)

I reach the conclusion that the goods of the application and the goods covered by the cited mark are goods of the same description and that registration of the mark must be refused under section 20.

7. Even assuming that I am wrong in that conclusion, I consider that the refusal of the application under the discretion contained in section 13(2) is entirely justified, and I now turn to this particular point. The applicant has stated that the goods to be covered by the mark "Seldan" are "pesticidal products" or "insecticides" and I do not think it is necessary to make detailed research into the uses and purposes of such goods - they are intended to destroy in the one case pests (which I take to mean plague, plants or animals detrimental to man) and in the other insects. The goods covered by the cited application are less specific and can cover a multitude of pharmaceutical preparations which may be for internal or external use. It is therefore obvious that there is a serious danger to human health if goods of the applicant, under this mark, are mistaken for goods of the proprietor of the cited mark which are intended e.g. for internal consumption. As stated above, I consider such confusion likely in view of the very close similarity between the 2 marks with which I am now concerned. In my consideration under this section I do not think that the consent of the proprietor of the cited mark is of any assistance

as it does not remove the possible risk of physical confusion between the respective goods. I find support for this view in the statement in the 10th Edition of Kerly at Para. 10.08 P. 178 which reads "the restrictions on registration of deceptive marks are not only for the protection of owners of marks on the Register but also of the public. Therefore, notwithstanding the consents of owners who might oppose the registration, a mark may be refused on the ground of the likelihood of confusion with their marks, and the consents are only some evidence as to the probability of deception". I also note the remark of Mr. Ward Dyer in the cited case at Page 586 line 26 et. seq. where he says "For the same reason [ a risk of physical confusion between the respective goods themselves which could well result in harm to human health ] I would not be willing to allow the application to proceed even if the written consent of the proprietor of these registrations were proffered, ...". It is well established that in the case of products falling within of as 5 it is all the more important that the public should be protected from the consequences of deception and confusion (Kerly op. cit. at Para. 17.07 P. 459).

8. The applicants have also informed me that the mark applied for, "Reidan", has been accepted for registration in the U. S. in spite of 2 marks "Reidan" and "Reidar" existing on the Register there. These 2 marks, of course, differ from the present cited mark, I have no evidence before me as to the details of the goods covered by the respective marks, the basis on which the registrations were obtained or of the law subject to which the registrations were obtained. I do not therefore consider that my present decision can be influenced by this consideration. For authority I would refer to the dicta of Buckley J. in the Buler T.M. (1966) R.P.C. 141 at P. 144: "the fact that those registrations stand side by side in those registers does not appear to assist me in any way, for I do not know what the law may be in those various countries with regard to registration of similar marks, nor do I know what the circumstances would be in those particular countries whether or not the marks should be regarded as similar."

9. Finally the applicants also suggested that, in addition to restricting the goods as mentioned above, they would be prepared to label their product so that the nature of the goods and the active constituency (constituents?) thereof and specific use of the produce with directions for employment and suitable cautions are prominently displayed. As I have indicated above, I do not consider such measures to be of assistance insofar as the goods of the registered proprietor of the cited mark remain of a wide category and also without restrictions upon their distribution. In any event I consider that my task is to compare the mark applied for with the cited mark and the question of proposed labelling, which cannot be enforced by restriction or condition on the Register, is not a factor to be taken into account.

10. Accordingly, upon the grounds mentioned above, the application is refused under section 20 of the Ordinance because of the presence on the Register of the cited mark No. 700 of 1973, or alternatively in exercise of the Registrar's discretion under section 15(2).



(J.M. CATTLE)  
Acting Senior Solicitor

27th January 1977