

FILE No. 261/1974.

(39)

(16)

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

**IN THE MATTER of an Application by Prem
Jhamatmal Vaswani to register the
word "GIRALUX" in Class 14 in respect
of watches, watch cases, watch dials,
watch bands, watch crowns, and clocks**

AND

**IN THE MATTER of an Opposition by Langel
Watch Co., S.A.**

D E C I S I O N

of

The Registrar of Trade Marks, Mr P. Jacobs.

Hearing on 16th October 1975.

**Mr W.P.G. Double of Messrs Hastings & Co. appeared for the
Applicant.**

Mr P. Woods of Messrs Deacons appeared for the Opponents.

**On 4th March 1974 Mr Prem Jhamatmal Vaswani of 108,
Lok Shan Road, 4th Floor, D, Gee Chang Industrial Building,
Tokwawan, Kowloon, Hong Kong ("the Applicant") submitted an
application to the Registrar of Trade Marks ("the Registrar")
for the registration in Part A of the Register of the word
"GIRALUX" in class 14 in respect of watches, watch cases, watch
dials, watch bands, watch crowns and clocks.**

**The supporting Statutory Declaration made by the Appli-
cant, also on 4th March, stated that the trade mark had not**

hitherto been used by the Applicant either in Hong Kong or in a country or place other than Hong Kong. The Applicant stated that to the best of his knowledge and belief the trade mark was not at that time registered elsewhere in respect of the goods mentioned in the application.

On 15th May 1974 the Registrar issued to the Applicant a notice to advertise pursuant to section 14 of the Trade Marks Ordinance, and the mark was duly advertised in the Gazette on 21st June 1974.

On 16th September 1974 Messrs Deacons wrote to the Registrar indicating that they had been instructed to act as the agent of Langel Watch Co., S.A. ("the Opponents") in connection with a proposed opposition to the application, and on 17th October 1974 a formal Notice of Opposition was duly delivered to the Registrar pursuant to section 15 of the Ordinance. The Applicant appointed Messrs Hastings & Co. to act as his agents for pursuing the application.

The grounds of opposition as set forth in the Notice are as follows :

"1. We are the proprietors of the trade mark comprising the word "VIALUX" which has been registered in our name in Hong Kong under registration No. 1796 of 1972 covering a specification of goods "Horological and chronometric instruments and parts and fittings therefor; watch bracelets" as of 9th June, 1972.

2. The said registered trade mark has been used by us for many years throughout the world including Hong Kong.

3. The applicant is seeking to register the word "GIRALUX", the subject application herein in class 14 in

respect of "watches, watch cases, watch dials, watch bands, watch crowns, and clocks".

4. The alleged mark which the applicant has applied to register so resembles our said trade mark as to be likely to deceive.

5. The alleged mark which the applicant has applied to register so resembles our said trademark as to be likely to lead public into believing that the applicant's goods are our goods.

6. The use of the proposed mark "GIRALUX" by the applicant will constitute an infringement of our rights in our said trade mark "VIALUX".

7. By reason of the matters set forth the proposed mark "GIRALUX" is not a registrable trade mark within the terms of the Trade Mark Ordinance.

8. The Registrar should exercise his discretion adversely to the applicant and we ask that the application No. 261A of 1974 be refused with cost against the applicant."

The Counter-Statement filed by Messrs Hastings on behalf of the Applicant on 29th November 1974 states as follows :

"1. Paragraphs 1 and 3 of the Notice of Opposition are admitted.

2. No admission is made to paragraph 2 of the Notice of Opposition and the Opponent is put to strict proof thereof.

3. Paragraphs 4, 5 and 6 of the Notice of Opposition are denied. In reply thereto we say :-

(a) LUX is a common suffix for trade marks to which the opposition cannot claim exclusive use.

- (b) Visually the two marks are different. Our mark is "GIRALUX" containing 7 alphabets whilst the Opponent's mark is "VIALUX" containing 6 alphabets. The Alphabets G and R are sufficiently distinctive from V.
- (c) Phonetically the two marks are different. The pronunciation of our mark is "GEE RA LUX". The pronunciation of the Opponent's one is "VI A LUX".
- (d) "GIRA" is an invented word "VIA" has a dictionary meaning of its own.
- (e) Though the goods in respect of the two marks are applied are in the same class, the specification are not the same. Our mark is for watches, watch cases, watch dials, watch bands, watch crowns and clocks and the Opponent's mark concern more with the movements of watches.

4. In the premises paragraphs 7 and 8 of the Notice of Opposition are denied.

5. Save as herein before expressly admitted each and every one of the allegations contained in the Notice of Opposition is denied as if they have been set out and traversed seriatim."

During the course of the hearing Mr Double told me that the mark "GIRALUX" had been used for some time. He had no specific records relating to the use of the mark, but said that a certificate of origin was available. Apparently, the goods were mainly exported to Saudi Arabia. I considered whether I should look at this evidence. Mr Woods objected to its production on the basis that the Applicant had had ample time in which to give details, but had chosen not to do so. I took the view that for the purposes

of ensuring that all information was before me at the hearing I should look at the evidence. However, on examination it appeared that most of the evidence related to user after the date of the application, although the certificate of origin was obtained before that date. Having regard to the fact that under section 20 of the Ordinance the enquiry embraces the notional use of the goods in question it seems to me that the evidence produced by Mr Double has no real bearing on the question before me, and the decision I have reached is not influenced by the production of that evidence. Subject to this neither party presented any further evidence by way of Statutory Declaration or otherwise. Both relied upon the statements made in the Notice of Opposition and Counter-Statement in reply. Accordingly, the facts are very simple, and at the Hearing I relied on the information contained in the Application, the Statutory Declaration in support, the Notice of Opposition and the Counter-Statement.

In view of the fact that the Opponents' mark is already registered it appears that the objection must be dealt with under section 20 of the Ordinance. This section provides as follows :

"20. Except as provided by section 22 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."

It is made clear in paragraph 10-03 of Kerly, Tenth Edition, ("Kerly") that the enquiry under section 12 of the Trade Marks Act 1938 (being the equivalent of section 20 of the Ordinance),

embracing as it does notional use upon any of the goods concerned, is wider than that under section 11 (the equivalent of section 12(1) of the Ordinance). Thus, if the Applicant succeeds under section 20 of the Ordinance he will also succeed under section 12(1).

At the hearing I invited the parties to agree that the goods involved in these proceedings were of the same description. However, it was suggested by Mr Double that the specification of the Applicant's goods and the Opponents' goods were not the same. The Opponents' products were time pieces of great accuracy and parts and fittings therefor, whereas the Applicant's goods consisted of simple watches, watch cases etc. Mr Woods on behalf of the Opponents argued that the specification of his clients' goods including as it did all horological and chronometric instruments and parts and fittings therefor and watch bracelets embraced all types of time-keeping device. The specification was not limited to highly accurate time pieces. "Chronometry" is defined in the Shorter Oxford English Dictionary as meaning the art or science of accurately measuring time; measurement of time; and "chronometric" means of or pertaining to chronometry.

The test as to whether goods are of the same description is discussed in paragraph 10-12 of Kerly. I must have regard to the following matters :

- (a) the nature and composition of the goods;
- (b) the respective uses of the articles; and
- (c) the trade channels through which the commodities are respectively bought and sold.

In default of any evidence as to the actual goods involved I consider that I must look only at the specifications in the

application and in the certificate of registration of the Opponents' mark. Having regard to the meaning of the words used as indicated above I am satisfied that both the Applicant and the Opponents are engaged in the manufacture or sale of time-keeping devices, which are goods of the same description. As far as this point is concerned I rule in favour of the Opponents.

The principles upon which the Tribunal should decide cases of deceptive resemblance are set out in Chapter 17 of Kerly, and I shall refer briefly to those which I think have particular reference to these opposition proceedings.

In proceedings under sections 12(1) and 20 of the Trade Marks Ordinance, the onus is on the applicant to satisfy the Registrar that the trade mark applied for is not reasonably likely to deceive or cause confusion. In cases in which the Tribunal insists that there is doubt as to whether deception is likely the application should be refused (paragraph 17-03). However, the question whether one mark so nearly resembles another as to be likely to deceive is a question for the Tribunal and is not a matter for a witness. Thus, where the case turns on phonetic resemblance, once the evidence has established how the marks are pronounced in use, the judicial ear has the final say. In the case of *Electrolux Ltd. v. Electrix Ltd* (1954) 71 R.P.C. 23 the Master of the Rolls, Lord Evershed, stated :

"The question of infringement, the question whether one mark is likely to cause confusion with another, is a matter upon which the judge must make up his mind and which, he and he alone, must decide. He cannot abdicate the decision in that matter to witnesses before him. On the other hand, it is equally true that he must be guided in all

these matters by the evidence before him and where the evidence is that there has been no confusion that is a material which the judge must take into account."

In these proceedings neither party has placed any evidence before me, and I am faced with the problem of deciding myself whether there is any possibility of confusion. The test was best summed up by Mr Justice Parker in a case involving the comparison of two words. Pianotist Co. Ltd's application (1906) 23 R.P.C. 774 at p. 777. He said :

"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."

Lastly, I must consider the case of imperfect recollection. Kerly in paragraph 17-23 sets out the principles upon which I rely and quotes from the case of Sandow's application (1914) 31 R.P.C. 196 as follows :

"The question is not whether if a person is looking at two trade marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to

be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection."

The learned Judge in the "Pianotist" case emphasised that the Tribunal must consider the customer who would be likely to buy the goods and all the surrounding circumstances. I must consider the attitude of potential customers and the nature of goods involved. It seems to me that having regard to the fact that both marks are used in respect of watches or other horological instruments I must take into account the fact that customers are unlikely to buy the goods without some fairly careful examination of what they are buying. Accordingly, the risk of imperfect recollection is, in my view, much reduced. When a person buys a watch he is generally interested in the name of the manufacturer and that manufacturer's reputation. It was suggested to me that the Applicant's products were not in the expensive range, but nevertheless, I think that there is little doubt that a customer would be concerned to some degree with the name of the manufacturer and would distinguish that name from names on other goods of a similar character.

Mr Woods suggested that if the marks were side by side confusion could easily result. As I have said, I take the view that I must have some regard to the nature of the goods involved in this application. The application deals with watches and watch cases etc. These are not goods bought on the spur of the

moment by someone who is not interested in the make. When a person buys a watch, however cheap that watch may be, he will normally examine it carefully and will take ample time to ensure that he is buying the watch he wants. Whilst he might not be able to remember the name of the brand exactly I think there is little doubt that he would clearly see the mark on the watch he was buying and satisfy himself that he was getting the brand he wanted.

Mr Woods addressed me regarding the similarity between the two marks. He said that they were both visually and phonetically similar. From the visual point of view it appears to me that there is a distinct difference between the two marks. "Vialux" consists of six letters whereas "Giralux" consists of seven - this in itself is a modest difference. However, the only similarity in the first syllable lies in the letter "i". It is, of course, true that the suffix of the word is "lux", and furthermore the letter "a" appears immediately before that suffix. However, the visual impression made by the two marks is, in my view, quite different. Mr Woods stressed the difference in pronunciation. He said that both marks end in "alux" and that the prefixes "Via" and "Gir" have a similar sound. He said that the "r" sound in "Giralux" was slurred and that the pronunciation of the word is therefore closer to "Vialux". I think that this view is incorrect. The letters "v" and "g" however pronounced have an entirely different sound. Furthermore, the letter "r", which appears in the Applicant's mark, cannot be ignored. The word would be pronounced either with a long "i" as in "gyro" or with a short "i" as in "jeer". However the "i" is pronounced, the

"r" is given distinct value coming as it does before the vowel "a". This pronunciation can be contrasted with that of the Opponents' mark in which the word is pronounced either "vie-a-lux" as in "eye", or "vee-a-lux". In either case there is no "r" sound whatsoever.

Kerly makes it quite clear that the resemblance between the marks must be considered with reference to the ear as well as to the eye, but for the reasons given above I am also of the view that there is no phonetic resemblance between the two marks. I am of the view that the marks in these proceedings are sufficiently different both visually and phonetically that even in a case where a person was familiar with one but not with the other he would still not be deceived. As I have indicated, I consider that a person buying a watch is more concerned with visual aspects of a mark because he would look carefully at the watch before buying it. The visual distinction in particular between these marks is quite clear.

It was suggested that I should break up the word into its component parts. However, I think that this is a wrong approach. In the case of an application to register "Erectiko" (William Bailey (Birmingham) Ltd's Application (1935) 52 RPC 136) Mr Justice Farwell said "

"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."

Lastly, it has been accepted in several reported cases that the first syllable of a word mark is generally the most important. See paragraph 17-20 of Kerly. For the reasons indicated above it appears to me that there is a quite clear distinction between the first syllable of the word "Giralux" and the first syllable of the word "Vialux".

In all the circumstances of this case and having regard to the views I have taken I do not consider that I should exercise my discretion to refuse this application. I therefore reject the Opponents' case and accept the mark "Giralux" for registration in accordance with the application herein.

I find that the Applicant is entitled to an award of costs, that any representations which either party may wish to make as to the amount of those costs will be considered if received within 21 days from the date of this decision and that failing such representation or subject to any representations calling for special treatment, costs will be calculated on the usual scale.



(P. Jacobs)
Registrar General

21st June 1976

Dated the 21st day of June 1976

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