

8.12.85 (30)

File Ref. No. 1824/76

IN THE MATTER of the Trade Marks Ordinance
AND

IN THE MATTER of an Application by
Toyo Contact Lens Co. Ltd.

to register the "Menicon" trade mark
in respect of contact lenses, components
and accessories included in Class 9 for
the aforesaid goods, in Class 9 in
Part A of the Register

AND

IN THE MATTER of an Opposition by
Nippon Kogaku K.K.

DECISION

of

- Mr. P. Murphy, acting for the Registrar of Trade Marks.
- Mr. A. Liao, instructed by Messrs. P.H. Sin & Co., represented the Applicants.
- Mr. P. Garland, instructed by Messrs. Deacons, represented the Opponents.

On 2nd July 1976, Messrs. P.H. Sin & Co., Solicitors, applied to the Registrar of Trade Marks (hereinafter referred to as "the Registrar") on Form TM No. 2 asking him under Rule 108(1) of the Trade Marks Rules

(hereinafter referred to "the Rules") to search in Class 9 in respect of optical apparatus and instruments, in particular contact lenses, their components and accessories, to ascertain whether there were any trade marks on the record which resembled the trade mark "Menicon". Messrs. P.H. Sin & Co. also enclosed a further application on Form TM No. 2 asking for a similar search to ascertain whether there were any trade marks on the record which resembled the device shown on the annex to the form.

The Registrar replied to Messrs. P.H. Sin & Co. on 9th August 1976 informing them that the trade mark "Menicon" appeared to be prima facie inherently adapted to distinguish their client's goods so as to comply with the requirements of Section 9 of the Trade Marks Ordinance (hereinafter referred to as "the Ordinance") for registrability in Part A of the register subject to amendment of the specification of goods to read "contact lenses; components and accessories included in Class 9 for the aforesaid goods". In the same letter, the Registrar gave a similar confirmation in respect of the enquiry about the device trade mark, subject to amendment of the specification of goods as aforesaid and subject also to disclaimer of the letter "f".

On 10th December 1976, Messrs. P.H. Sin & Co., acting on behalf of Toyo Contact Lens Co. Ltd., a company incorporated in Japan, of 5 Higashibiwajima-cho, Nishi-ku, Nagoya, Japan (hereinafter referred to "the Applicants") submitted an application to the Registrar for registration in Part A of the register of the "Menicon" trade mark in Class 9 in respect of contact lenses; components and accessories included in Class 9 for the aforesaid goods.

The supporting (undated) Statutory Declaration made by Kyoichi Tanaka, President of the Applicants, stated that the trade mark had been used by the Applicants in Japan in respect of the goods mentioned in their application since February 1975, that the trade mark had not hitherto 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 and that the trade mark was at that time registered in Switzerland in the Applicants' name in respect of the goods mentioned in the application.

The Applicants also submitted on 10th December 1976 an application for registration of the device mark in respect of the same goods. The supporting Statutory Declaration was also made by the President of the Applicants and was in similar terms to that supporting the application for registration of the trade mark "Menicon".

On 20th October 1977, the Registrar wrote to Messrs. P.H. Sin & Co. granting consent to an advertisement of their application in respect of the trade mark "Menicon" in the Gazette. He also wrote to them on the same date granting consent to advertisement in the Gazette of the application in respect of the device mark, subject to the condition that registration of the mark would give no right to the exclusive use of a letter "f".

Both marks were duly advertised in the Gazette of 4th November 1977, page PN 2204.

No objection was received to the advertisement of the application in respect of the device mark and the Certificate of Registration of this mark was issued by the Registrar on 18th March 1978.

However, with regard to the application in respect of the "Menicon" trade mark, on 29th December 1977 Nippon Kogaku K.K., a Japanese company, of 2-3, 3-chome, Marunouchi, Chiyoda-ku, Tokyo, Japan (hereinafter referred to "the Opponents") gave notice of intended opposition to the application through their agent Messrs. Deacons, Solicitors.

Formal Notice of the Opposition was filed on 29th May 1978.

The grounds of opposition to the mark were given as

"1. We are the proprietors of the trade marks "NIKON" and "MIKRON" registered in Hong Kong under registrations Nos. 1101/1954 and 1103/1954 both registered in respect of "Cameras, binoculars, optical lenses, microscopes, surveying transits, surveying levels, telescopes and optical glasses".

2. We are also owners of the following trade marks :-

| <u>Trade Mark</u> | <u>Regn. No.</u> | <u>Goods</u> |
|-------------------|------------------|---|
| NIKKOR | 1102/1954 | Cameras, binoculars, optical lenses, microscopes, surveying transits, surveying levels, telescopes and optical glasses. |
| NIKKOREX | 239/1961 | Optical instruments, particularly photographic instruments, and parts thereof and accessories. |
| NIKKORMAT | 625/1966 | Still and motion picture cameras; motion picture and transparency slide projectors; cinematograph and projector lenses; light shutters; bellows; light filters; hoods; range and view finder; exposure meters; film magazines; tripods; photographic flash guns and lamps; tilting heads for panoramic cameras; photographic self-timers; developing, printing, enlarging and finishing apparatus; ophthalmoscopic cameras; telescopes and microscopes. |

| | | |
|---------|-----------|--|
| NIKOMAT | 1395/1966 | Physical and chemical apparatus and instruments, optical apparatus and instruments, photographic apparatus and instruments, motion picture apparatus and instruments, measuring apparatus and instruments. |
| NIKONOS | 1131/1971 | Scientific, nautical, surveying and electrical apparatus and instruments (including wireless): photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; coin or counterfreed apparatus; talking machines; cash registers; calculating machines; fire-extinguishing apparatus. |

3. The Applicant is seeking to register the word "MENICON" the subject of this application herein in Class 9 in respect of "Contact lenses; components and accessories included in Class 9 for the aforesaid goods".

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

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

6. The use of the proposed mark "MENICON" by the Applicant will constitute an infringement of our rights in our said marks.

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

8. The Registrar should exercise his discretion adversely to the Applicant and we ask that the Application No. 1824A of 1976 be refused with costs against the Applicant."

The Counter Statement filed on 5th July 1978 by the Applicants set out the grounds in which the Applicants relied as supporting their application as follows:

- "(1) The mark "Menicon" has a different visual and oral appeal from the marks set out in paragraphs 1 & 2 of the Grounds of Opposition.
- (2) The goods covered by the mark "Menicon" are contact lenses and component and accessories thereof included in Class 9 whilst none of the trade marks referred to in paragraphs 1 & 2 of the Grounds of Opposition are registered in respect of contact lenses.
- (3) The opponent Nippon Kogaku K.K. has not been manufacturing, selling or dealing with contact lenses.
- (4) That there is no or no sufficient resemblance of the mark in the above application and the trade marks referred to in paragraphs 1 & 2 of the Grounds of Opposition as is likely to cause confusion to the public.
- (5) The mark "Menicon" is world-famous as a trade mark indicating contact lenses and their accessories manufactured and sold by the applicant company, and has already been registered in the following countries :-

| <u>Country</u> | <u>Registration Date</u> | <u>Registration No.</u> |
|----------------|--------------------------|-------------------------|
| West Germany | June 8, 1977 | 958,824 |
| Switzerland | July 15, 1976 | 282,764 |
| Spain | June 30, 1977 | 808,445 |
| Singapore | August 13, 1975 | 66,833 |
| England | October 13, 1977 | 1,061,936 |
| Indonesia | February 27, 1978 | 126,873 |
| Thailand | August 10, 1977 | 59,206 |

We admit the following allegations in the notice of opposition: namely, paragraphs 1, 2 & 3 of the Grounds of Opposition but deny each and every allegation contained in the remaining paragraphs."

The evidence filed by the Opponents in respect of their opposition consisted of two Statutory Declarations by Mr. Shigetada Fukuoka, their Managing Director, dated 18th January 1979 and 9th November 1979 respectively, a Statutory Declaration by the Managing Director of their sales and distribution agent in Hong Kong dated 23rd May 1980, a Statutory Declaration by the Manager of the Camera Division of the said sales and distribution agent in Hong Kong dated 23rd May 1980 and a Statutory Declaration by the Manageress of a company which carries on business as importers, exporters and wholesalers of spectacles, lenses, optical and ophthalmic instruments and equipment, dated 26th May 1980.

The Applicants' evidence consisted of two Statutory Declarations by Mr. Kyoichi Tanaka, as Representative Director, dated 28th March 1979 and 22nd January 1980 respectively.

Neither of the parties filed any evidence from an ordinary member of the public.

During the Hearing, Mr. Garland stated that the Opponents would only really rely upon the alleged conflict of "Menicon" with their registration of "Nikon" in respect of "cameras, binoculars, optical lenses, microscopes, surveying transits, surveying levels, telescopes and optical glasses" (Registration No. 1101/1954). This seemed to me a sensible approach having regard to all the circumstances because not only is "Nikon" the mark which is, of all those cited by the Opponents in their Notice of Opposition, the closest in resemblance to "Menicon", in my opinion, but it is also the mark which the Opponents use most often on their products, by a wide margin in terms of both numbers and value.

I think that the first point which has to be decided in this case is whether the opposition comes within the provisions of section 20 of the Ordinance which is, for all practical purposes, in the same terms as section 12(1) of the Trade Marks Act 1938 ("the 1938 Act") in Britain. Section 20 reads:

" 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."

Since the goods in the specification in respect of which "Nikon" is registered do not specifically include contact lenses, I have to consider whether they include goods "of the same description" as contact lenses. The various matters to be taken into account in testing whether or not goods are "of the same description" were decided in the "Panda" case (Jellinek's Application (1946) 63 RPC 59) and are set out in section 10-12, page 182, of Kerly's Law of Trade Marks and Trade Names (10th Edition) ("Kerly") as follows:

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

Taking these matters into consideration, I have no difficulty in deciding that cameras, binoculars, microscopes, surveying transits, and surveying levels and telescopes are not goods of the same description as contact lenses. They are very different in nature and composition from contact lenses, have different uses and in Hong Kong are seldom sold on the same premises as contact lenses.

With regard to "optical glasses" in the specification of goods for which 'Nkion' is registered, I note from Collins English Dictionary that "optical glass" is "any of several types of homogeneous glass of known refractive index used in the construction of lenses etc". The term is defined in Chambers Technical Dictionary as "Glass made expressly for its optical qualities. The composition varies widely both as to constituents and amounts, and the requirements as regards freedom from streaks and bubbles are very exacting." These goods are the raw materials from which lenses are made but they are obviously not bought or sold on retail premises and I doubt if they are ever bought or sold by anyone except lens manufacturers. I consider that these goods also are not goods of the same description as contact lenses.

However, taking the same criteria into consideration, I have reached the conclusion that optical lenses are goods of the same description as contact lenses. Optical lenses used in spectacles are made of the same or similar materials as contact lenses. It is true that the physical sizes of spectacle lenses and contact lenses differ somewhat but they are both used for the purpose of correcting defects in vision and are sold side by side on the same retail premises. They are in fact interchangeable and I know a number of people who use spectacles for most of the time but wear contact lenses for special purposes in connection with their professions or while playing sports.

Indeed, it may well be that the classification "optical lenses" includes contact lenses, but I have been unable to find an authority on the point and propose to proceed on the basis that, as already indicated, they are only goods of the same description as contact lenses.

At the Hearing, Mr. Liao tried to persuade me otherwise i.e. that contact lenses are not goods of the same description as optical lenses. He argued that contact lenses are highly specialised even within the category of optical lenses. In support of his argument he referred me to the Seahorse Tm (1980) RPC 250, where all the goods concerned were marine engines of greatly differing capacities (outboard engines as against engines suitable for merchant ships) and were held to be not goods of the same description. I was also referred to the Sunline Tm (1970) RPC 207 where it was held that steel hot water radiators for central heating systems are not goods of the same description as electrical heating apparatus. As already indicated, however, I cannot see any basic differences in the respective functions and capacities of contact lenses and ordinary lenses in spectacles and, taking this into account with all the other criteria laid down in the "Panda" case, I adhere to my view that they are goods of the same description.

Having decided that goods covered by the "Nikon" registration, i.e. "optical lenses", are goods of the same description as those for which registration of "Menicon" is sought and since "Menicon" obviously is not identical to "Nikon", I have to consider whether it so nearly resembles "Nikon" as to be likely to deceive or cause confusion.

The question which I have to ask myself was summarised by Evershed J. in Smith Hayden & Co.'s Application (1946) 63 RPC 97, page 101 and is reproduced in section 10-02, pages 172 and 173 of Kerly. It can, I think, be paraphrased for the purposes of the present case as follows:

"Assuming user by Nippon Kogaku K.K. of their trade mark "Nikon" in a normal and fair manner for any of the goods covered by the registration of that mark (and including particularly goods also covered by the proposed registration of the mark "Menicon"), am I satisfied that there will be no reasonable likelihood of deception and confusion amongst a substantial number of persons if Toyo Contact Lens Co. Ltd. also use their mark "Menicon" normally and fairly in respect of any goods covered by their proposed registration?"

It is pointed out in section 10-06, page 176 of Kerly that: "It is well settled that the onus of proving that there is no reasonable probability of deception is cast on an applicant for registration of a mark." Kerly also points out in section 17-03, page 451 that "In such cases 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, so that refusal to register does not involve the conclusion that the resemblance is such that either an infringement action or a passing off would succeed. In case in which the tribunal considers that there is doubt as to whether deception is likely the application should be refused."

The rules for comparison of two words alleged to have a deceptive resemblance are set out in Chapter 17 of Kerly. The first important point to be considered is "Who are the people whom the mark must be calculated to deceive". In Chapter 17, section 17-05, the answers given by the courts in past cases are summarised as "All of those who are likely to become purchasers of the goods upon which the marks are used, provided that such persons use ordinary care and intelligence". At section 17-06, Kerly states "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." In the present case, I consider that there is no likelihood of retail dealers, i.e. those dispensing spectacles and contact lenses, being confused. With regard to the public, however, no evidence was produced by either side as to "the circumstances usually attending distribution and sale of the goods under consideration, of the type of customer and of the degree of discrimination commonly portrayed" (Kerly 17-35). It is tempting for me to turn to what individual knowledge I have of the optical trade in Hong Kong but the courts have warned in the past about the dangers involved in this approach. In the "Buler" Tm (1966) RPC 141, Buckley, J. made the following comments, at page 147, on the Registrar of Trade Marks views on the manner in which the goods concerned, watches, were bought:

"These are aspects of the matter which I think it was right for the learned Assistant Controller to take into consideration, but it must be appreciated that they are merely his own views on the position unsupported by any direct evidence that was before him."

In the court of appeal, Russell, LJ stated at page 150 "There is no evidence dealing with the circumstances in which watches are bought and the members of the court can only, and with I think great caution, turn to their individual knowledge or imagination, for what those may be worth."

In view of the lack of evidence on the point, however, I have decided that I should proceed on the basis that members of the public display a much higher standard of discrimination when buying spectacles and contact lenses than when buying day-to-day goods. I also think it highly likely that they rely to a large extent on the recommendations either of their opticians or of the owner of the retail outlet.

Similarly, there was no evidence presented as to the type of customers but I think it reasonable to assume that they will be a cross-section of the whole community. It is a matter of everyday observation that the wearing of spectacles and contact lenses is very common indeed in Hong Kong.

The second important question dealt with in Chapter 17 of Kerly is "What amount of resemblance is likely to deceive." The rules to be applied in comparing two words were summarised by Parker J. in Pianotist Co.'s Application (1906) 23 RPC 774 at page 777 as set out in section 17-07, page 456 of Kerly:

"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."

The circumstances of this case relevant to the above matters are:

(1) Look

The original registration of "Nikon" (1101/1954) shows that mark in simple block letters. The form in which it appears to be normally used is:



Nikon

(Reproduced from the Opponents' leaflet on "Subnormal vision aids" enclosed with Mr. Fukuoka's first Statutory Declaration.)

The specimen of the mark applied for, as annexed to the Application for registration, is:



Menicon

(2) Sound

The question of the respective pronunciations of these marks was dealt with in some detail in the Statutory Declarations filed by both sides. The main point in dispute was the pronunciation of the Opponents' mark "Nikon". Mr. Tanaka argued in his second Statutory Declaration that it is pronounced as "náikon" not "níkon" (Under the system used in the Concise Oxford English Dictionary, the equivalent of "naikon" is "nÍkon", "I" as in "mite", and the equivalent

of "nikon" is "níkon", "í" as in "rick"). He produced evidence to show the Opponents' mark was pronounced "náikon" in a song originally recorded by an American singer, Paul Simon, and also recorded by a Hong Kong artiste. On the other hand, he argued that the Applicants' mark would be pronounced "ménikon" thus clearly differentiating the sounds of the two marks. He also claimed that the first syllable "Me" of the mark applied for would be "clearly pronounced with emphasis in comparison with the remaining part". This point was also stressed at the Hearing by Mr. Liao. He reminded me of the statement in section 17-20, page 467 of Kerly "It has been accepted in several reported cases that the first syllable of a word mark is generally the most important. It has been observed in many cases that there is a "tendency of persons using the English language to slur the termination of words."

The Opponents, on the other hand, argued that their mark is pronounced "níkon". This was supported by the three Statutory Declarations already referred to. In the Declaration by Mr. Dobrenky, Managing Director of Shriro (China) Ltd., the Opponents' sale and distribution agent in Hong Kong, Mr. Dobrenky said that whilst he had, in the United States and Canada, heard the Opponents' mark pronounced as "náikon", he could confirm that within his personal experience the Opponents' mark is pronounced by person originating from Hong Kong and other countries and territories in the world with whom he

had conducted business, as "níkon". He said that he himself had always adopted the pronunciation "níkon", as had all members of his sales staff and he had never encountered the pronunciation "naikon" except by persons originating from the United States and Canada. He produced copies of cassettes used by the Opponents for promoting sales of their products in Hong Kong and pointed out that the pronunciation of the mark on these cassettes was always "níkon". The Statutory Declaration by Mr. Poon Pui Lam, Manager of the camera division of Shriro (China) Ltd., confirmed from his personal experience whilst employed by Shriro and in the camera trade generally during the previous seventeen years, that the Opponents' trade mark was and always had been during that time pronounced in Hong Kong as "níkon". He had never encountered the pronunciation "naikon" except by some persons from the United States and Canada. The Statutory Declaration by Annie Cheung Yick, Manageress of the Universal Company in Man Yee Building, Queen's Road Central, Hong Kong, importers, exporters and wholesalers of spectacles, lenses, optical and ophthalmic instruments and equipment, also confirmed from her personal experience whilst employed by the firm that the Opponents' trade mark was and had been during that period generally pronounced in Hong Kong amongst both members of the public and of the trade as "níkon". She herself and her colleagues had always used that pronunciation.

The Opponents did not dispute the Applicants' claim that "Menicon" is pronounced "ménikon" ("ménícon" under the system used in the Concise O.E.D.)

I asked at the Hearing whether Mr. Tanaka had ever resided in Hong Kong but the information was not available. I therefore have to weigh the views of a resident of Tokyo as to how the mark is pronounced in Hong Kong against those of three local residents and have decided that I should accept the views of the latter. I might add that I have been interested in cameras for many years and my experience both in Britain and during eighteen years' residence in Hong Kong has always been that the Opponents' mark is pronounced as "nikon". I accept, however, that it is sometimes, or even usually or invariably, pronounced "naikon" in the United States and Canada.

(3) Goods to which the marks are to be applied

In practice, of course, trade marks are not actually applied to optical lenses of any sort, either ordinary spectacles or contact lenses, or at least are not applied in a form readily visible to the layman. Presumably, application of trade marks would cause serious deterioration in the light-transmitting properties of the lenses. The marks are either applied to the packaging for the lenses or, in the case of the special types of lenses which are used for dealing with abnormal vision and are thick or complicated enough to require to have definite casings or barrels, on the casings. I am sure that to the vast majority of laymen, different manufacturers' lenses are indistinguishable if taken out of their packaging and laid in a group on a table.

(4) Nature and kind of customer

I have already indicated that I consider that I have to proceed on the basis that customers for these goods will be from all sectors of the community.

At the Hearing, Mr. Liao referred me to a number of cases in support of the Application to register. He was of the view that Darwin's Application (1945) 63 RPC 1 was a very relevant case. It was held in that case that "Morex" did not so nearly resemble "Rex" as to be likely to cause confusion if they were used respectively as the marks for goods of the same description. Other cases to which he referred me as emphasising the importance of the first syllable in word marks were: Enoch's Application (1947) 64 RPC 119 where "Vivicyllin" was allowed notwithstanding the existing registration of "Cyllin"; Fitchetts Ltd. v Loubet & Co. Ltd. (1919) 36 RPC 296 where "Vito" was allowed notwithstanding the existing registration of "Lito" and "Yto"; Cal-U-Test Tm (1967) FSR 39 where "Cal-U-Test" was allowed notwithstanding twelve other existing "T_est" registrations with different paraphrases and Oreal Tm (1980) RPC 107 where "Oreal" was allowed notwithstanding the existing registration of "L'Oreal".

Mr. Liao also stressed the differences in the appearance of the mark applied and the Opponents' mark "Nikon".

He argued that in view of the nature and prices of contact lenses, no one would buy or sell them carelessly.

Returning to Kerly for further guidance on how to compare these word marks, section 17-08 states that the "Idea of the Mark" is to be regarded. My reactions to "Menicon" on first seeing it were (a) that it was a combination of the English words "men" and "icon" and (b) that it might also be a Greek word (it is not). My reaction to "Nikon" was that it was an invented word with no implied meaning. The ideas conveyed to

me were therefore very different and I cannot see any risk of confusion between them.

Kerly also emphasises that the marks have to be treated as a whole and quotes, in section 17-17, Farwell J. in William Bailey (Birmingham) Ltd.'s Application (1935) 52 RPC 136:

"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."

On this basis, I do not think that anyone looking at the two marks side by side would run any risk of being confused or deceived. The respective first 3 letters are different in each case, the total number of letters used is different in each case and the type of script used is very different.

With regard to the risk of phonetic confusion, I have been persuaded by the decisions in the cases referred to me by Mr. Liao that considerable emphasis must be given to the first syllables of the marks i.e. "Men" and "Nik" respectively. I do not think that anyone would confuse the marks if he heard them repeated in succession.

However, as Mr. Garland reminded me at the Hearing, I also have to take into account the possibility of imperfect recollection and careless pronunciation on the part of members of the public. These points are summarised in section 17-23 of Kerly and Mr. Garland referred me in detail to the leading case on the subject, Rysta Ltd.'s Application (1943) 60 RPC 87 where "Rysta" was held not registrable because of the existing registration of "Aristoc". The views of Luxmoore L.J. (in a dissenting judgment) were upheld by the House of Lords on appeal and

are quoted in section 17-23. They include: "The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of section 12 of the Trade Marks Act 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. 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." Luxmoore L.J. added a little later "The tendency to slur a word beginning with "a" is, generally speaking, very common, and the similarity between "Rysta" and Ristoc" would, I think, be fairly obvious. It would not be surprising to learn that a person asking for "Aristoc" stockings from a shop assistant who only knew of "Rysta" stockings had been supplied with the latter and vice versa."

The decision in Rysta Ltd.'s Application was considered by Cohen J. in Enoch's Application (1947) 64 RPC 119, which was one of the authorities to which Mr. Liao referred to me in support of his case.

Cohen J. stated at page 123:

"Now, of course, I respectfully accept the principles there laid down, and I go further and say I should have arrived at the same conclusion, and, indeed, Mr. Lloyd-Jacob did not seek to suggest that that was in any way inconsistent with the decision upon which he relies. But I confess that while it is

common to slur a word beginning with "a" - and, indeed, I think some poets put an apostrophe at the beginning instead of the letter "a" - I cannot conceive that anybody would slur "Vivi". Therefore, had the matter come before me in the first instance I should have said that there was nothing in sight or in sound to justify me in holding as a matter of first impression - I say that because this has to be considered entirely as an independent view - that "Vivicillin" so nearly resembles "Cyllin" as to be likely to deceive or cause confusion."

There are two reported cases where, it seems to me, the differences between the marks involved were comparable to the differences between "Menicon" and "Nikon". The first case is Darwin's Application (1945) 63 RPC 1 where the mark applied for was "Morex" and one of the two marks cited in the objection was "Rex". The application for registration of "Morex" was approved. As already mentioned, Mr. Liao referred me to this case at the Hearing. The second case is Kidax (Shirts) Ltd.'s Application (1960) RPC 117 (CA) where "Kidax" was accepted for registration notwithstanding the existing registration of "Daks". Lord Evershed MR said at page 119:

" So far as the mark tendered for registration, "Kidax", is concerned, when compared with "Daks", I feel no doubt whatever that in the absence of any other context no likelihood of deception or confusion could be said to arise, whether the comparison is made visually or by speech; and, indeed, Mr. Aldous has not contended to the contrary."

After careful consideration of all the circumstances of the present case, I find it difficult to conceive that anyone would slur the initial letters "Me" of "Menicon".

There is, therefore, nothing in either the sight or the sound of the mark to justify me in holding that "Menicon" so nearly resembles "Nikon" as to be likely to deceive or cause confusion and I find that the application succeeds under section 20 of the Ordinance. Kerly points out at section 10-03, page 173, that: "There may also be cases in which an opponent's mark has been used in a special way, or a special context, so as to increase the likelihood of confusion. In any ordinary case, however, of an opposition based upon a registered mark, the inquiry under section 12, embracing as it does notional use upon any of the goods concerned, is wider than that under section 11: so that if the applicant succeeds under section 12 he succeeds under section 11 too." I consider that notwithstanding the differences between section 11 of the Act and the corresponding section 12(1) of the Ordinance this statement applies in Hong Kong also. I also consider that this is "an ordinary case" in that there has not been any evidence that the Opponents' mark has been used in a special way, or in a special context, so as to increase the likelihood of confusion and I therefore find that the Applicants succeed under section 12(1) of the Ordinance also.

I would mention that both marks coexist on the register in the United Kingdom and, since our respective system of registration of trade marks are, in most respects, basically the same, this is a point which has to be considered. At the Hearing, however, no evidence was laid by

either party as to the circumstances which led to such coexistence in the United Kingdom and I have reached the conclusion that I cannot regard the bare fact that both marks have been registered in the United Kingdom as being of any real use in supporting the decision which I have reached independently on the basis of the circumstances applying in Hong Kong. I feel encouraged to take this attitude by the dicta of Falconer Q.C. in Needle Tip Tm (1973) RPC 113 at page 118:

"It may be that, in a case where a mark applied for here has already been registered in a foreign country with a system of trade mark law similar to our own, if a written decision of the foreign tribunal allowing registration in the foreign country and which showed the grounds of the decision and the matters taken into consideration were to be adduced on the application here, it might be persuasive as a piece of reasoning as to whether the mark should be registered here, if, but only if, similar considerations applied in this country; but that, it seems to me is as far as registration in a foreign country could be relevant to registrability here."

It was also drawn to my attention that there appears that there has been a series of proceedings between the Applicants and the Opponents in Japan involving their trade marks. In his second Statutory Declaration, Mr. Fukuoku produced a translation of a decision by a Patent Office Examiner in Tokyo dated October 1976 on a successful objection by the Opponents to an application by the Applicants for the registration of a mark consisting partly of English words including "Menicon" and partly of Katakana characters.

However, I consider that I should be guided by the views of Buckley, J. in the Buler Tm (1966) RPC 141 at pages 144 and 145. The

circumstances of that case were different in that Buckley, J. was considering the coexistence of marks in other jurisdictions which have a different legal system, but I think that the views apply equally well to rejection of an application for registration in a foreign jurisdiction which has a different legal system. The views were:

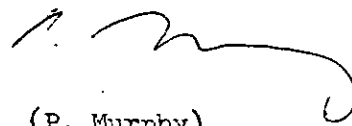
"Both companies have obtained registration of their respective marks in a considerable number of registers in other jurisdictions, but how far they have traded in competition in those various countries I do not know. The fact that those registrations stand side by side in those registers does not appear 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 which might influence the tribunals there in deciding whether or not the marks should be regarded as similar. Quite different considerations might arise in countries which talk different languages and pronounce words in different ways."

I have therefore not taken the position in Japan into account in reaching my conclusion.

Since I have found that the mark applied for is not, when compared with "Nikon", likely to deceive or cause confusion, I think that it follows that the same conclusion applies to the other marks cited by the Opponents in their Notice of Opposition because they are, in my opinion, clearly more different from the mark applied for.

I think that the Opponents recognised this when, as already explained, Mr. Garland confirmed at the Hearing that he would only really rely upon the registration of "Nikon" in his arguments against the application. I do not think it necessary to take each of the other marks in turn and explain ad longum why I have reached the above conclusion.

I find that the Applicants are entitled to an award of costs, that any representations which either party may wish to make as to the amount of these costs will be considered if received within one month from the date of this decision and that failing such representations or subject to any representations calling for special treatment, costs will be calculated on the usual scale, namely on the basis set forth in Part I of the First Schedule to Order No. 62 of the Rules of the Supreme Court (Cap. 4) as applied to trade mark matters unless otherwise agreed between the parties.



(P. Murphy)

Assistant Principal Solicitor

8th February 1985