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Decision file

IN THE MATTER of the Trade Marks Ordinance  
(Cap 43) Section 13(4)

AND

IN THE MATTER of Application no. 161(1)  
of 1978 by Wella Aktiengesellschaft to  
register the Trade Mark 'FAVORIT' in  
Class 7.

STATEMENT OF GROUNDS OF DECISION

On 25th January 1978 Wella Aktiengesellschaft, a joint stock company organised under the laws of the Federal Republic of Germany, whose business address is Berliner Allee 65, 61 Darmstadt, Germany, (hereinafter referred to as 'the Applicants') submitted through their agents, Messrs. Deacons, solicitors, Hong Kong ('the Agents'), an application to the Registrar of Trade Marks ('the Registrar') for registration in PART A of the Register of the mark 'FAVORIT' in class 9 in respect of '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 counter-freed apparatus; talking machines; cash registers; calculating machines; fire extinguishing apparatus; apparatus for body and beauty care.'

Following an exchange of correspondence between the Registrar and the Applicants regarding the actual goods for which the Trade Mark 'FAVORIT' was proposed to be used and the classification of such goods, the Applicants filed a request on form TX-No 33 and dated 29th June 1978 whereby the class number of the application was amended to Class 7 and the specification amended to read 'Hair drying machines.'

A statement dated 17th February 1978 made in support of the application by the Applicants Manager, Dr. Gerhard Kalden stated:

- (a) that the mark had been used by the Applicants in Germany in respect of the goods mentioned in the application since 1957;
- (b) that the mark had been used by the Applicants in Hong Kong in respect of the goods mentioned in the application since 1971; and
- (c) that the mark was at that time registered in Austria, Chile, China (Taiwan), Denmark, Iran, Lebanon and South Korea.

On 17th July 1978 the Registrar wrote to the Agents stating that the mark was phonetically indistinguishable from the laudatory word 'favourite' and was accordingly open to objection under s. 9(1)(d) of the Ordinance.

The Agents replied by letter dated 13th October 1978 stating:

- (a) that they appreciated the word 'Favourite' was not registrable per se but that their clients were not seeking to register the same, and
- (b) the mark sought to be registered was 'Favorit' which was not similar to the word 'Favourite.'

By letter dated 31st October 1978 the Registrar replied and advised that the mark was still considered to be unacceptable for registration on the grounds that:

- (i) The simple omission of the last letter 'E' would not qualify the subject mark as an invented word under s.9(1)(c) of the Ordinance;
- (ii) following such omission, the mark is still left as one easily or readily understood as its derivative i.e. 'FAVORITE' or one intended to convey the meaning of 'FAVORITE.'

On 16th December 1978 the Agents submitted Form TX-No 5, requesting that, pursuant to Trade Marks Rule s. 20(1), I state in writing the grounds for, and the materials used by me, in arriving at my decision.—Those now follow.

As no formal hearing took place in connection with the registrability of this mark the statement will be confined to those matters raised in correspondence

between the Agents and the Registrar. Furthermore, no evidence of use of the mark having been filed nor other special circumstances having been brought to my attention I deem a prima facie case only to consider.

I will deal first with the registrability of the mark 'FAVORIT' under s. 9(1)(c) of the Ordinance as an invented word. The section provides, inter alia, that a registrable trade mark may contain or consist of an invented word or invented words. In interpreting that section I am assisted by a wealth of judicial and authoritative dicta. For the purposes of this decision however, I shall rely upon the leading case: Eastman Photographic Materials Co. Ltd's Application (1898) 15 RPC 475, perhaps better known as 'the Solio case'. The case has been cited on a number of previous occasions and I will, therefore, restrict myself to those passages which are directly material to the matter at hand.

At page 483, the Lord Chancellor states, inter alia:

'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. Of course, also, words which are misspelt but which are nevertheless in sound ordinary English words, and the use of which may tend to deceive, ought not to be permitted.'

Lord Herschell, at page 485 states:

'I do not think the combination of two English words is an invented word, even although the combination may not have been in use before, nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form.'

In a similar vein, Lord Shand at page 487:

'the Comptroller General will be fully warranted in taking care that there shall not be admitted, under the guise or cover of words called 'invented' by the applicant, words really in ordinary use, which might, in a disguised form, have reference to the character or quality of the goods. There must be invention, and not the appearance of invention only. It is not possible to define the extent of 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 case, 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 'invented' which, with some trifling addition or very trifling variation, still leaves the word one which is well known in ordinary use, and which would be quite understood as intended to convey the meaning of such a word.'

The word must, per se, convey no obvious meaning to an 'ordinary Englishman,' and neither is it sufficient for registration purposes to rely upon a visual difference, only. I am guided in this respect by the decision of Kekewich J. in the case of Edward Ripley & Son's Application (1898) 15 RPC (s) who concluded that the word 'Pearl' was, in the circumstances of that case, unregistrable. He went on to say:

'That seems to me to put an insuperable difficulty in the Applicants way when they come to register 'Pirle'. Of course, it is a different word to the eye, and if the eye only were concerned, there might be a good deal to be said in favour of (the) argument. But it is not the eye only....that is consulted....the ear must be consulted and to any ordinary person the difference between 'Pearl' and 'Pirle' is not to be perceived....I base my decision simply on the ground that 'Pearl' being now at any rate, not capable of registration another word, which is precisely the same in tone and sound, so that every ear would be deceived, is equally incapable of registration and on that ground I refuse the motion with costs.'

When applying the above authoritative dicta to the application at hand I find little merit to warrant the claim of inventiveness. No real attempt has been made to disguise the word 'Favourite' especially when the American spelling of the word which omits the letter 'u' is taken into consideration. Phonetically, the words 'Favorit' and 'Favourate' are identical. There is at best, a misspelt word and that, in my opinion, does not bestow upon the mark the requisite degree of inventiveness to justify registration.

Turning now to the question of whether or not the mark offends against s. 9(1)(d) of the Ordinance my task is to consider whether the mark applied for has a direct reference to the character or quality of the goods specified. In reaching my decision I am guided largely by the following excerpts from Kerly's Law of Trade Marks, 10th Edn., Section 8-29, pages 111 and 112 regarding decisions on the corresponding section of the UK Act:-

'The various decisions are listed below. Few of them are of value as laying down any definite principle; nor would they seem to imply any very consistent practice. One reason may lie in this, that almost every immediately attractive trade mark is, in some sense, descriptive or laudatory of the goods and so in some degree has reference to their character or quality. The difficulty is to decide whether that reference is a direct reference: one that seriously affects the words' capacity for distinguishing goods from a particular source, as distinct from the sort of reference that can be found only as an academic exercise. This is at best a somewhat metaphorical question and one depending ultimately upon the reaction of the public to the chosen word. In these circumstances, the Registrar, who has a duty to maintain the purity of the Register, may well incline to rely upon possibilities of interpretation of a mark which later experience may show to be fanciful. Sometimes he can be persuaded by argument; but in general, the applicant's proper course is to apply again when the mark has been tested by use. This is by no means to be regarded as a hardship upon applicants: it must not be forgotten that if the Registrar registers under s. 9(1)(d) without evidence of distinctiveness, the mark may (until seven years have

elapsed since registration) be struck off as wrongly registered.'

In deciding whether a word has a direct reference to the character or quality of the goods it is necessary both to have regard to the goods to which the mark relates but to not limit that consideration to the marks' strict grammatical meaning only. In other words, I have to 'decide' whether the word can be used to signify or to call up in the minds of those who read it the character or quality of the goods.

To my mind the word 'Favorit' is all but indistinguishable from its phonetic equivalent 'Favourite' ('Favorite'), and can only be regarded as intending to convey the same meaning of that word.

Websters Third New International Dictionary accords the word 'Favorite' with, inter alia, the following meanings:

(i) As a Noun

(a) something treated or regarded with special favour; something especially liked or loved; one unusually loved, trusted, or provided with favours by; a person of high rank or authority;

(b) something having marked esp. lasting popularity.

(ii) An an Adjective

constituting a favorite; accorded special treatment or attention usu. loving or affectionate; markedly popular esp. over an extended period of time.

The accepted and common meaning of the word 'favorite' is that which is regarded with particular favour. The word has been defined variously as:

'a person or thing regarded with special liking, or more highly than others...held in special regard; best liked, preferred:' (Webster).

something treated or regarded with special favour; something esp. liked or loved: something having marked esp. lasting, popularity; constituting a favorite' (Concise Oxford).

'Preferred above others' (Shorter Oxford).

These various definitions are, of course, well known to the ordinary man on the street. It seems to me inescapable therefore, that to the average purchaser the proposed mark could only suggest that the goods to which the mark relates are preferable to other like goods. That being so the word has direct reference to

the character or quality of those goods.

I have not been asked to comment on the registrability of this mark in Part B of the Register pursuant to s. 10(1) of the Ordinance. It would appear from the statement dated 17th February 1978 that there has been over two years bona fide user but as no evidence in that connection has been produced to substantiate the claim, I do not propose to comment on the matter.

Accordingly for the abovementioned reasons, the application is refused under sections 9(1)(c) and 9(1)(d) of the Trade Marks Ordinance, or alternatively in exercise of the Registrar's discretion under s. 13(2) of the Ordinance.

*J. R. Booth*

(J. R. Booth)  
Acting Senior Solicitor  
7th June, 1982