

File No. 587/81

17.9.90  
(15)  
(28)

IN THE MATTER of the Trade  
Marks Ordinance (Cap. 43)

and

IN THE MATTER of an  
application by Kabushiki  
Kaisha Murata Seisakusho  
for the rectification of  
the Register in respect of  
the trade mark No. 859 of  
1982 "CERALOCK" registered  
in Class 19 in respect of  
ceramic resonators.

DECISION

of

R.J. Perera acting for the Registrar of Trade Marks.

Hearing held on the 6th September 1990.

Miss Helen Peachey of Deacons appeared on behalf of the  
Applicant.

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These proceedings concern an application by Kabushiki Kaisha Murata Seisakusho (Murata Manufacturing Co. Ltd.) ("the Applicant") for the rectification of the Register in respect of trade mark No. 859 of 1982 "CERALOCK" registered in Class 19 for "ceramic resonators". The Certificate of Registration was sealed on the 27th of March 1982. On the 8th of December 1989 the Applicant filed a form TM-No. 30 (application to the Registrar for the rectification of the Register or the removal of the trade mark from the Register (Rule 63)).

Attached to the form TM-No. 30 is a Statement of Case which is as follows :-

"STATEMENT OF CASE"

1. Kabushiki Kaisha Murata Seisakusho (Murata Manufacturing Co., Limited), a corporation organized under the laws of Japan of 10-go, 26-ban, 2-chome, Tenjin, Nagaokakyo-shi, Kyoto-fu, Japan are the

registered proprietors of Trade Mark No. 859 of 1982 in respect of a specification of goods reading as follows :-

"ceramic resonators" in Class 19.

2. At the date of filing application for registration of "CERALOCK" in 1982 it was erroneously thought that the goods were classified in Class 19 due to the reference to "ceramic" in view of the fact that this class covers amongst other goods "building materials, natural and artificial stones".

3. When the registration for "CERALOCK" fell due for renewal on 5th March 1988 details of the actual goods covered by Trade Mark Registration No. 859 of 1982 were provided and it was realized that the goods should have been classified in Class 9. Leaflets showing the goods of interest have already been filed at the Trade Marks Registry for the Registrar's consideration on 16th March 1988.

4. In view of the foregoing, it is requested that Trade Mark Registration No. 859 of 1982 "CERALOCK" be transferred from Class 19 to Class 9".

Schedule IV of the Trade Marks Rules contains a classification of goods and I set out below details relating to Classes 9 and 19 :-

"Class 9

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

Class 19

Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal".

At the Hearing Miss Peachey said that her client was relying on section 48(1)(a) of the Trade Marks Ordinance and also on the Registrar's general power to change his mind. I shall refer to this matter later.

I also refer to a letter dated the 25th May 1988 from Messrs. Deacons to the Trade Marks Registry which draws attention to section 48(1)(a) of the Trade Marks Ordinance; I quote the following extract from this letter :-

"... We draw your attention to our Trade Marks Ordinance section 48(1)(a) by which the Registrar is entitled to rectify entries in the Register. It states :-

"any person aggrieved by ... any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the ... Registrar, and the Registrar may make such order for making, expunging or varying the entry as he may think fit" .....

I also refer to section 8 of the Trade Marks Ordinance which is in the following terms :-

"8(1) A trade mark must be registered in respect of particular goods or classes of goods.

(2) Any question arising as to the class within which any goods fall shall be determined by the Registrar, whose decision shall be final".

At the hearing Miss Peachey made the following arguments. She agreed that the question of classification was a matter for the Registrar of Trade Marks ("the Registrar") and that this was reflected in section 8(2) of the Trade Marks Ordinance. However, she said that the Registrar could change his own decision and had power to do so by virtue of section 48(1)(a) of the Trade Marks Ordinance. She also said that the Registrar had a general power to change his own mind, but she did not quote me any authority for this proposition.

Miss Peachey said that it was in the public interest for goods to be classified in the correct class. A bona fide 3rd party searching in Class 9 would not find the mark in question. She said that as far as she was aware Classes 9 and 19 were not cross-searched. It was unfair for a member of the public to end up infringing a mark. She said that section 8(2)

of the Trade Marks Ordinance did not prevent the Registrar from changing the classification of goods. She said classification was a matter of administrative convenience which did not jeopardise infringement rights. Infringement went to the goods. A registration of a mark in the right class would protect the general public and the particular registrant. She said that her client had registered the mark "CERALOCK" in Class 9 in the United Kingdom.

Section 48(1)(a) of the Trade Marks Ordinance makes it clear that the Registrar has a discretion whether to rectify the Register or not because of the wording "... and the tribunal may make such order for making, expunging or varying the entry as the tribunal may think fit ...". (My underlining). The presence of the word "may" indicates that the Registrar has a discretion. As Kerly (Law of Trade Marks and Trade Names, 12th Edition) puts it in para. 11-28 when discussing the English equivalent of section 48 of the Trade Marks Ordinance "... It seems clear ..... the court always has a discretion under section 32 to rectify or not ...".

In this particular case the mark "CERALOCK" has been registered for goods in Class 19. When the Registrar originally

made the decision to register the goods (i.e. ceramic resonators) in Class 19 he was determining the question of class referred to in section 8(2) of the Trade Marks Ordinance; section 3(2) of the Trade Marks Ordinance makes it clear that his determination of this question is a final one. In this respect, I rely on what appears in Mr. Moorby's decision in the "CAL-U-TEST" Trade Mark (1967 FSR 39, at page 44) :-

"... It was submitted by Mr. Lloyd at the hearing that for section 3 of the Act to apply there must have been a formal application to the Registrar for him to determine the classification into which the goods should be placed and that it does not follow that because a mark has passed through to registration, the Registrar has determined the classification. But the position is that no formal application to the Registrar, other than stating the goods required on the application form, is necessary, unless, of course, the applicant is in doubt about the class in which he should make his application. The determination of the correct classification is implied by the acceptance of the application for registration. If, for example, the applicant applies for "pharmaceutical preparations" in Class 5, the specification will be accepted as being properly classified. But if the applicant has the

intention of using his mark on some specific product which, he considers, comes within the scope of "pharmaceutical preparations", but which is subsequently determined by the Registrar in proceedings to be classified in another class, he cannot plead that the classification of his product has been determined by the Registrar when the application for the mark was originally filed".

I do not feel that I can order the rectification of the Register which the Applicant seeks. It is clear that I have a discretion under section 48(1)(a) of the Trade Marks Ordinance as to whether to rectify the Register. To rectify the Register in this case by transferring the registration of "CERALOCK" to Class 9 would be to run a coach and horses through section 8(2) of the Trade Marks Ordinance (which makes it clear that the Registrar's decision on any question arising as to class within which goods fall is "final") and I cannot see that there is any public interest in doing this. I therefore decline to exercise my discretion under section 48(1)(a) of the Trade Marks Ordinance. At the Hearing Miss Peachey made the point that a registration of the mark in the right class would be in the interests of the registrant and the general public. All I will say here is that there is, of course, nothing to prevent the Applicant from making an application to register "CERALOCK" for ceramic resonators in Class 9.

At the Hearing Miss Peachey referred to a general power of the Registrar to change his mind. She quoted me no authority for this proposition. Even if such a power existed, I would not exercise it in favour of the Applicant for the reasons mentioned in this Decision, and in particular the previous paragraph of this Decision.

R. J. Perera

R.J. PERERA

Date : 17/9/90