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An application was made by Wenping & Co, Trade Mark Agents, on the 9th November 1981 on behalf of Maglificio Biellese Fratelli Fila S.p.a. ("the Applicants") for the following device mark ("the Fila mark") :-



This application was for Class 3 and was in respect of cosmetics, perfumes, soaps, dentifrices, hair lotions and shampoos.

2. On the 2nd February 1982, the Trade Marks Registry wrote to Messrs. Wenping advising them that the Fila device mark was not acceptable for registration in Part A of the Register because :-

- (1) It was considered in conflict with a "logo mark" Trade Mark No. 196 of 1973 registered in the name of Faberge, Incorporated ("the Faberge mark") and therefore likely to deceive or cause confusion pursuant to Section 20 of the Trade Marks Ordinance.
- (2) It consisted of "F", a letter of the alphabet in which it was not possible to acquire a monopoly by registration.

3. Messrs. Wenping have made various submissions on behalf of their clients by letters to the Trade Marks Registry dated 1st April 1982 and 29th June 1982.

4. The Trade Marks Registry has continued to maintain its objections to the Fila mark and so informed Messrs. Wenping by two letters dated 5th May 1982 and 14th July 1982. By a letter dated 18th March 1983 to Messrs. Wenping, the Trade Marks Registry advised that it would not accept a colour limitation nor a disclaimer of a letter "F" to overcome the objection taken that the Fila mark was a letter "F".

5. The Applicants asked for a hearing. A hearing took place before me on the 2nd November 1983 at which the Applicants were represented by Mr. Andrew Liao of Counsel and Mr. J. Kee of Messrs. Michael Cheuk & Co (who had been instructed by Messrs. Wenping).

6. Mr. Liao began his submissions by saying that you had to look at the Fila mark. He said :-

- (a) It had distinctive colouring. It was red and blue against a background of white. The upper portion and the lower portion of the Fila mark were in contrasting colours. The lower portion was a sort of inverted L. The ends were rounded. There was a tube-like effect. It was a visual mark. Someone shown the mark would realise that it was a mark recognised by appearance and colouring.

(b) There were two objections by the Trade Marks Registry.

The first was that the Fila mark was in conflict with the Faberge mark. The second objection was that it stands for the letter "F", being a letter of the alphabet.

7. Mr. Liao then referred to S. 9(1)(e) of the Trade Marks Ordinance. He referred to "any other distinctive mark". He said that question of distinctiveness was dealt with in S. 9(2) and S. 9(3) of the Trade Marks Ordinance.

8. Mr. Liao said that the mark had to be inherently distinctive. This was a quality in itself. Mr. Liao said that the objections by the Registry was that the Fila mark was not inherently distinctive.

9. Mr. Liao said that the Registry had not talked about colour. Here he referred to S. 11 of the Trade Marks Ordinance and stressed that colour was important. Mr. Liao said that it was clear that a letter of the alphabet was not registrable as it was not distinctive. Mr. Liao said that this matter did not concern the letter "F" but a device.

10. Mr. Liao said that if you looked at the device then firstly, it was clear that it was a device mark; or if it was a letter "F", it was so fanciful or original that the alphabet significance faded into the background.

11. The Fila mark must be looked at for immediate impact. Would someone on the street looking at the applied for mark see a letter "F" or a distinctive device. Mr. Liao said that the device sprang to mind. The impression of the letter "F" was an ex post facto analysis for the following reasons :-

- (1) In its overall appearance the immediate reaction is that the device is not a letter "F".
- (2) There are differences in comparing the Fila mark, and a letter "F". The two portions of the applied for mark are of contrasting colours. The portions are not joined together and are not of unified whole.
- (3) Two tube-like impressions reinforced the impression that it is not a letter "F".
- (4) It is the immediate reaction that it is important.

12. Mr. Liao then referred to the various cases which he said were important for identifying what approach one should take. The question when faced with a device mark which might be a letter of alphabet was : How fanciful was the impression? Was it a letter or device? The cases were :-

- (1) Electrical Protection Company (Proprietary) Limited's  
Application (1967) R.P.C. 261

Mr. Liao said that the question was one of the impression. The mark EPC was fanciful. The approach of this case was that the more a mark was different from ordinary letters of the alphabet, then the less likely it was to be construed as a letter of the alphabet. In this case there were concentric circles which gave the mark its significance. Mr. Liao said that as regards the Fila mark, there was a much stronger difference from the letter "F". One also had to look at the colouring and the tube effect.

(2) Elliott Machine Tools Limited's Application (1970) R.P.C. 79

Mr. Liao said that the approach was to look at the mark. Mr. Liao said that the Fila mark did not feature the letter "F". He again mentioned the square frame. He said that the horizontal rod was red. He referred to the L shaped lower portion which looked like a bent tube and this was coloured blue. All these were set against a background of white. The bars were rounded off.

(3) Alfred Dunhill Limited's Trade Mark Application (1982) R.P.C. 1

Mr. Liao said that in the Dunhill case there was letter "d" with a broken circle. The only unusual feature was the ascender. The Court said that the letter "d" was not an uncommon script.

13. Mr. Liao again emphasized that the immediate spontaneous reaction of a viewer to the Fila mark was that it was a device. It was only ex post facto reasoning that would lead anyone to seeing it as a letter "F". The Fila mark was an artistic derivation from the letter "F" at most. It was not from any known script.

14. Mr. Liao asked how anyone would be inconvenienced if the Fila mark were allowed. Would other traders be prejudiced? There was no reason why other traders would want to employ this device with this colouring. Colour was important. (Mr. Liao referred to S. 11 of the Trade Marks Ordinance.) Mr. Liao referred to the Smith, Kline and French Laboratories Limited V Sterling - Winthrop Group Limited (1976) R.P.C. 511 which he said proved that a colour could be a trade mark and this was the importance of the case.

15. Finally, Mr. Liao referred to Unilever's (Striped Toothpaste) Trade Mark Application (1980) FSR, P. 280 which he used to prove that colour was an important factor.

16. Mr. Liao then referred to by way of analogy to the cited Faberge mark. He said that the cited mark looked like a letter "F". It was not coloured. It was registered in 1972. He said that the impression was that it looked like a script "F". There was no colour limitation.

17. Mr. Liao referred to the M device (Registration No. 2437/81) which he said had a colour limitation and also disclaimed the use of the letter M. This limitation illustrated that the device (i.e. Registration No. 2437/81) was not a M. Mr. Liao said that the Fila mark was like this M Mark. The alphabetical significance was an afterthought.

18. Mr. Liao then dealt with the question of conflict with the Faberge mark. He referred to the test stated in the Smith Hayden case and he referred me to page 172 of Kerly (10th Edition). He referred to (b) on page 172 which was an extract from Evershed J's judgement. He said that the approach is to compare the two marks i.e. notional fair use in a normal fair manner.

19. Mr. Liao referred to para. 10.04 of Kerly (10th Edition). He said that we were concerned with the S. 20 of the Trade Marks Ordinance. One had to imagine use in a normal fair manner. I had earlier pointed out that the cited Faberge mark had no colour limitation and had asked how one could compare the two marks? Should one think of the Faberge mark in red and blue? Mr. Liao submitted that it would not be normal or fair so to do. I asked why not? Mr. Liao said that the Faberge mark was registered in black (although it was conceded there was no colour limitation) and so it was not normal or fair to consider the Faberge mark used with a different colour combination when it had been registered in one colour.

20. Mr. Liao went on to say that there were a number of differences between the Faberge mark and the Fila mark :-

- (a) There was an absence of a frame in the Faberge mark. The frame in the Fila mark was coloured blue and distinctive.
- (b) The Faberge mark consisted of 3 rectangular blocks but the Fila mark was a horizontal upper block and lower L shaped block.
- (c) The Faberge mark had sharp corners but the Fila mark had rounded ends.
- (d) The Fila mark had 3 members but the Faberge mark had 2 members.
- (e) The Faberge mark was flattened and had a pressed appearance. But the Fila mark had a taller appearance.

21. Mr. Liao argued that the Trade Marks Registry recognised the difference in the two marks. He referred to the third paragraph of the Registry's letter of the 5th May 1982, which I quote :-

"The cited Trade Mark No. 196 of 1973 strikes one as a conglomeration of 3 jigsaw pieces. It is felt that in that instance, visual distinctiveness has been achieved in that the prominence of a letter "F" has been overshadowed or pushed onto the background. On the other hand, the subject mark is predominantly and essentially the letter "F" and in all likelihood, it will be primarily visualized,

recognised and remembered as a letter "F". The goods marketed thereunder will in all events be known or ordered as "F". It is noted that the subject mark is only a subject of Part B registration in the United Kingdom in various classes whereas in Hong Kong evidence of user has been filed by the applicant company for the purpose of obtaining Part B registration in Class 25."

22. Mr. Liao wondered if the Fila mark and the Faberge mark were similar, how could we say one was inherently distinct and the other not? Mr. Liao said that it was unreal to look under S. 9(1)(e) and apply one standard and then look under S. 20 of the Trade Marks Ordinance and apply another standard. I put forward the argument that the Faberge mark had a disclaimer of a letter "F" but under Section 20 of the Trade Marks Ordinance one had to compare structures.

23. Mr. Liao said that the Fila mark was very original; its structure was different and it was distinctively coloured. He asked whether a grant of the Fila mark would be an inconvenience to other traders. He said it would not.

24. After the hearing, I wrote to Messrs. Cheuk & Co on the 14th December 1983 confirming my agreement to the views of the Trade Marks Registry as set out in their letters of 2nd February 1982, 5th May 1982, 14th July 1982 and 18th March 1983. I am now asked, under the provisions of Trade Mark Rule 20 to state in writing the grounds of my decision and the materials used in arriving at it.

25. The Applicants have made no claim that there has been any use of the mark prior to the date of the application and so I have only the prima facie case to consider.

26. I will deal first with the objection that the Fila mark consists of "F", a letter of the alphabet in which it is not possible to acquire a monopoly. In considering these matters, I am dealing with the question of whether the mark is distinctive within the meaning of Section 9 of the Trade Marks Ordinance. It is well established that mere letters of the alphabet are lacking in inherent distinctiveness. (See Kerly, 11th Edition, Law of Trade Marks and Trade Names, at para. 3-63, page 112.)

27. But the question is whether the Fila mark is a letter of the alphabet or a device. I refer here to the arguments of Mr. Liao expressed in paras. 10 to 13 above. I found great assistance from the cases (see para. 12 above) on the approach to be adopted, in particular the judgement of Mr. Myall in the Alfred Dunhill Limited Trade Mark Application (at page 149, lines 4 to 29) where Mr. Myall states :-

"An applicant who wishes to obtain registration as a new mark of what is essentially a single letter of the alphabet must apply originality in presenting it as a device. The applicant's chances of success will vary with the degree to which originality is incorporated into the presentation of his mark for it is principally in this quality that registrability must be sought. At one end

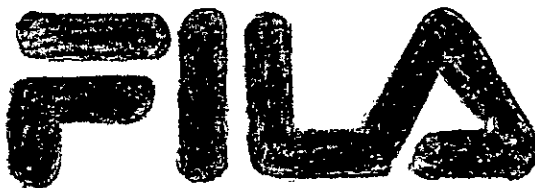
of the scale he may be able to achieve such a grotesque or peculiar presentation that any letter significance disappears and it will be the device which impinges itself upon the mind and in the memory. In such a case there will be almost no likelihood that the mark will be seen or referred to by the letter so that, since the overwhelming impression left by such a mark is that of a device, the conclusion that the mark is distinctive is inescapable. Such a mark is registrable in Part A and no disclaimer of the letter will be required. At the other end of the scale will be a letter to which nothing, or very little, has been added. Here the possibility that the mark will be referred to as a letter will approach certainty and user will be necessary before such a mark can be accepted for registration even in Part B of the register. Between these two extremes lies a continuum of design ranging from cases where a letter is easily seen to those where it is lost in the mark. At some point in this range there may be a mark in which the letter significance, although present to some small degree, is such that a substantial number of people are likely to receive merely an impression of the letter and not a very clear impression at that. Such marks may be capable of distinguishing and therefore acceptable in Part B of the register. The range of design possibilities

is practically unlimited and there will be cases on the borderline between acceptability in Part A and Part B or between acceptability in Part B and refusal. Marks may be viewed differently by different people at different times since the impression left on different minds may not always be the same or to the same degree."

28. Looking at the Fila mark, my immediate reaction is that it is a letter "F". In my opinion, there is insufficient originality to qualify the Fila mark as a device. I do not think that the different colours used hides the immediate impact of a letter of the alphabet.

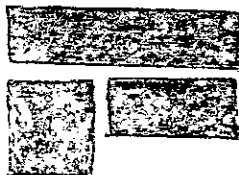
29. It is interesting to note that the actual decisions in the cases referred to in para. 12 above really provide very little assistance to the Applicant's case. In Durhill's case, the application for Part A failed. The Electrical Protection Company case resulted in the mark being accepted in Part B. In the Elliott Machine Tool's case, the application for Part B was rejected.

30. Further, I note that the Applicants already have a mark registered in class 3 which is as follows :

The word "FILA" is rendered in a very bold, heavy, and somewhat irregular font. The letters are thick and blocky, with a slightly distressed or textured appearance. The 'F' is particularly prominent, with a wide base and a thick vertical stem. The 'I' is a simple, thick vertical bar. The 'L' is also thick and blocky, with a slightly curved top. The 'A' is a simple, thick, blocky letter with a slightly pointed top. The overall style is reminiscent of a stamp or a very heavy, hand-drawn font.

In his statement on Form TM-No. 4 (statement in support of Application) with regard to that application, Mr. Massimo Henssler referred to this as "FILA" showing he regarded the first letter as a letter "F".

31. I turn now to consider the second objection to the Fila mark made by the Trade Marks Registry, namely that it was considered to be in conflict with the Faberge mark. The Faberge mark is as follows :



This mark is registered in respect of soaps, perfumery, essential oils, cosmetics, hair lotions, non-medicated toilet preparations, dentifrices and cosmetic powder boxes. It is provided on the Certificate of Registration for this mark that "Registration of this Trade Mark shall give no right to the exclusive use of a letter "F". It is also important to note that no colour limitation has been attached to this mark.

32. The relevant Section in the Trade Marks Ordinance is Section 20 which provides :

"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."

33. There is no doubt that we are - in comparing the Fila mark and the Faberge mark - dealing with "the same goods or description of goods".

34. Both marks are clearly not identical. But the question is whether both marks so nearly resemble each other as to be likely to deceive or cause confusion, bearing in mind that these two marks are not word marks.

35. The "idea of the mark" has also to be regarded. As Kerly puts it :

"Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same."

"On the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same." (See Kerly 11th Edition, para. 17-08, page 408)

36. The notion of imperfect recollection has also to be taken into account in comparing marks, and I refer here to the discussion of this topic in Kerly (at para. 17-23, page 418, 11th Edition) and particularly to the remarks of Sargant J. in Sandow's Appn. (1914) 31 R.P.C. 196, at page 205 which I quote here :

"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 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."

I feel this to be a very important notion here where the goods involved are not the sort of items one would purchase on a daily basis.

37.- Bearing in mind what has been said in paras. 35 and 36 above, I think there must be a very distinct possibility that customers could be deceived or confused if faced with similar goods bearing the Fila and the Faberge marks respectively. The goods are same or of the same description, and would be competing for the same customers. I have already stated earlier my opinion that the Fila mark is not so original as to disguise the letter "F". It is "F" in red and

and blue. The Faberge mark, though original enough to be accepted in Part A, had enough of a letter "F" in it to warrant the disclaimer of a letter "F". This practice of disclaiming a letter of the alphabet has been discussed by Mr. Myall in Alfred Dunhill's Trade Mark Application at page 151, lines 11 to 35.

38. What the disclaimer of "a letter" means is that while the proprietor of a mark with such a disclaimer cannot claim a monopoly of the letter of the alphabet (so that others may use the letter in other variations) his particular mark does receive protection should anyone create a mark that closely resembles it.

39. During the hearing, Mr. Liao drew my attention to the differences between the Fila mark and the Faberge mark (see para. 20 above). Now his analysis was based on a close examination of both marks. But bearing in mind the rules of comparison that I have mentioned in paras. 35 and 36 above, I have reached the conclusion that both marks so resemble each other in style and structure as to be likely to deceive. They would both be placed on the same goods and sold at the same shop counters. This similarity would unquestionably be affected by the problem of colour and notional fair use which I now turn to consider.

40. Section 11 of the Trade Marks Ordinance provides as follows :

"(1) A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of the trade mark.

(2) If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours."

41. I think it is important to note that the Faberge mark has been registered without any colour restriction and therefore Section 11(2) of the Trade Marks Ordinance applies. There is nothing to prevent the owners of the Faberge mark from adopting any colours it wishes. Mr. Liao states that there was no reason why other traders would want to employ a device with the same colouring as the Fila mark. (See para. 14 above) He also argues that in comparing marks one should compare them by reference to use in a normal and fair manner. (See para. 19 above) With respect, I cannot see the force of these arguments. If an owner has a mark which is not subject to a colour restriction then he can use it in any colour he wishes. I cannot see that there is anything unfair about this. What I have to do is to compare the Faberge mark as it has been registered and with all the scope afforded to its owner by virtue of such registration (i.e. the ability to use all colours for the mark) and the Fila mark. If the owners of the

Faberge mark decided to use red and blue (as they are fully entitled to do) then there will obviously be great confusion if the Fila mark were also allowed to be registered.

42. The other argument raised by Mr. Liao at the hearing was that the Trade Marks Registry "had not talked about colour". (See para. 9 above) Later he referred to the Smith, Kline and French Laboratories Limited case and the Unilever case. (See paras. 14 and 15 above) I think I can dispose of this point fairly shortly. Despite the colours used, I have already found that the Fila mark is an "F", and I do not think that the use of colours hides this fact. But if the question is whether the blue and red colours of the Fila mark entitle the owners to a Part A registration because of its distinctive get up then the following passage from Kerly (discussing the question of get up) is relevant :

"As a practical matter, however, it may be found that registration is difficult to secure without good evidence of distinctiveness." (page 110, para. 8-60, 11th Edition)

Kerly also points out that in the Smith Kline case, the capsule gets ups were only allowed to be registered on overwhelming evidence of distinctiveness. The Unilever case was another one where there was evidence of distinctiveness. So I feel that the arguments of Mr. Liao on this point have little relevance to the case before me where I am concerned with the prima facie acceptability of the Fila mark and where no evidence of distinctiveness of this mark has been presented to the Trade Marks Registry.

43. Finally, I wish to deal with two additional points :

First, as regards para. 17 above, I do not think reference to the M device assists Mr. Liao in overcoming the objection that the Fila mark is a letter of the alphabet because I agree with the views of the Registry expressed in its letter of 18th March 1983 :

"I regret that registration of the "Device" No. 2437 of 1981 in Part A will not persuade me to take a favourable stand towards the subject mark. That device is in the nature of some pyramid device whereas your clients' mark is the letter "F" in its only and principal identity."

Secondly, I refer to the arguments of Mr. Liao presented in para. 22 above. I think one has to appreciate that Section 9 of the Trade Marks Ordinance is concerned with the distinctiveness of a mark and Section 20 of the Trade Marks Ordinance is concerned with conflicting marks. There are two separate functions involved here and I therefore find it difficult to understand the relevance of Mr. Liao's arguments.

R.J. Perera

R.J. Perera

Dated 10th day of January 1984