

IN THE MATTER of the Trade Marks  
Ordinance, Cap. 43

and

IN THE MATTER of an application by  
Syntex Corporation to register the  
mark No. 1020/84 in Class 5 in  
respect of NAPRO in Part A of the  
Register.

D E C I S I O N

of

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

Hearing on 12th December 1988.

Mr. J. Yan, on the instructions of Wilkinson & Grist, appeared on behalf  
of Syntex Corporation.

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On the 2nd April 1984 the Trade Marks Registry received an application dated 29th March 1984 submitted by Messrs. Wilkinson & Grist on behalf of Syntex Corporation ("the Applicant") in respect of the trade mark "Napro". The application was in Class 5 in respect of "pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; plasters, material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin".

By a letter dated 11th October 1985 addressed to Messrs. Wilkinson & Grist the Trade Marks Registry advised that the applied for mark "Napro" was considered to be in conflict with the trade mark "Nupro" being trade mark No. 1887 of 1982 registered in Class 5 in respect of "pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; plasters, materials for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin; dentifrices" in the name of Johnson & Johnson, of 501 George Street, New Brunswick, New Jersey, U.S.A.

Correspondence has been exchanged between the Trade Marks Registry and Messrs. Wilkinson & Grist and by their letter dated 30th of January 1988 Messrs. Wilkinson & Grist advised the Trade Marks Registry that:

" We would inform you that our clients are willing to amend the specification of goods to "anti-inflammatory, analgesic and antipyretic preparations" and the specifications under the cited mark is amended to "pharmaceutical preparations excluding anti-inflammatory, analgesic and antipyretic preparations, veterinary and sanitary substances; infants' and invalids' foods; plasters, material for bandaging, material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin; dentifrices."

In view thereof, we hope you will waive the citation and grant us leave to advertise".

On the 7th March 1988 the Trade Marks Registry wrote to Messrs. Wilkinson & Grist along the following terms :-

" Your letter dated 30th January 1988 refers.

Your proposed specification will not assist to remove the citation. In the same connection, I would invite your attention to the following observations of Mr. Ward Dyer in the "Floradix" Trade Mark Application (1974 RPC 583) :

"The Registrar holds and has consistently held for many years, that all goods covered by the class heading to class 5 of schedule IV except "plasters, material for bandages; material for stopping teeth, dental wax" are goods of the same description.

The reasons for so holding are that although the uses of the wide range of goods concerned vary their nature is the same in that all of them have or are intended to have a specific effect or specific effects, curative, palliative, inhibitory, diagnostic, fortifying or destructive, in relation to living organisms; and that all of them pass through the same channels of trade, for the most part at the manufacturing level and without exception (in so far as they are traded in by wholesale or retail) at the wholesale and retail levels".

By excluding "anti-inflammatory, analgesic & antipyretic preparations" from pharmaceutical preparations will not, in effect, or successfully exclude pharmaceutical preparations serving similar purposes or for use in similar diagnosis.

Since the citation has been considered at an informal discussion and followed by several written considered replies, I regret that the next course of action is either to apply for a formal hearing under Trade Mark Rule 18 or to put on end to the application".

At present the goods for which the trade mark "Napro" is being applied for has been set out in the first paragraph on page 2. It is very wideranging indeed. Normally where the particular specification for goods is being limited, an Applicant has to file a Form TM-No. 33, but this form has not yet been filed by the Applicant as regards his application. Therefore what I have to compare is in fact the two sets of goods referred to above in the first and second paragraphs on page 2 above for the applied for mark "Napro" and the cited mark "Nupro", which are both wide ranging.

Section 20 of the Trade Marks Ordinance, Cap. 43 provides that "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".

What I have to consider is an application for "Napro" in Class 5 for a very wide ranging category of goods. There are two questions arising from Section 20 of the Trade Marks Ordinance, namely :-

- (1) Do the trade marks "Napro" and "Nupro" so nearly resemble each other as to be likely to deceive or cause confusion?
- (2) Are the sets of goods for which "Napro" is being applied for and for which "Nupro" is registered the same goods or description of goods?

I turn to consider question (1) i.e. the likelihood of deception or confusion. At the Hearing held before me it was conceded by Mr. Yan that there was a very close similarity between the word mark "Napro" and "Nupro", the only difference being in the second letter of each word.

The question of resemblance such as to be likely to deceive or cause confusion is discussed in Kerly's Law of Trade Marks and Trade Names, 12th Edition, page 438 et seq. I quote the following passages from Kerly :-

"It is not possible to discover from the decided cases any standard as to the amount of resemblance which may suffice to deceive or cause confusion. As Lord Cranworth said in *Seixo v. Provezende* "What degree of resemblance is necessary ... is from the nature of things incapable of definition a priori". Nor is the standard always the same : thus in the case of pharmaceutical products, in the absence of restrictions upon their distribution, it is the more important that the public should be protected from the consequences of deception and confusion..." (at para. 17-07, page 438).

Kerly also refers to Parker J.'s decision in the *Pianotist* (1906) 23 R.P.C. 774 at 777

"The test in relation to the reasonable probability of deception under the predecessor Section 12(1) of the 1938 Act was summed up by Parker J. in a case involving the comparison of two words, as follows :

"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 respective owners of the marks""'. (Kerly, para. 17-08, at page 439).

I also refer to following passage from Kerly on the question of imperfect recollection :

"It is clear that the tribunal ought not merely to look at the marks as they stand side by side, for, from the nature of the case, they will not be so put before any customer whom it is sought to deceive by means of either of them. He can only contrast the mark upon the goods offered to him with his recollection of the mark upon those he is seeking to buy, and allowance must be made for this in estimating the probability of deception. Any other rule would be of no practical use. It has to be borne in mind that the ordinary purchaser has only "an ordinary memory". (Kerly, para. 17-16, page 447).

Based on the concession of Mr. Yan made at the hearing, and the extracts from Kerly that I have quoted above, I find that the words "Napro" and "Nupro" so resemble each other as to be likely to deceive or cause confusion.

I turn now to consider question 2 on page 6 i.e. goods of the same description. I refer to the quote from the "Floradix" case referred to on page 4 above.

On the basis of the specifications referred to on page 2 above for which Napro is applied for and for which "Nupro" is registered, it is quite clear that goods of the same description are involved. Both sets of specifications are identical except that the specification "Nupro" also includes "dentifrices". Even, if Messrs. Wilkinson & Grist had filed a Form 33 limiting their clients' goods to "anti-inflammatory, analgesic and antipyretic preparations" I would still have been prepared to say that these were goods of the same description as the specification for which the mark "Nupro" is registered. The specification for which "Nupro" is registered includes "pharmaceutical, veterinary and sanitary substances" which could clearly embrace "anti-inflammatory, analgesic and antipyretic preparations".

At the hearing Mr. Yan sought to persuade me that his clients' registration for "Napro" should be allowed and he referred to the letter of Messrs. Wilkinson & Grist dated the 30th of January 1988 which is, inter alia, as follows :-

"We would inform you that our clients are willing to amend the specification of goods to "anti-inflammatory, analgesic and antipyretic preparations" and the specifications under the cited mark is amended to "pharmaceutical preparations

excluding anti-inflammatory, analgesic and antipyretic preparations, veterinary and sanitary substances; infants' and invalids' foods; plasters, material for bandaging, material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin; dentifrices".

Mr. Yan also referred to the letter dated 7th March 1988 from the Trade Marks Registry to Messrs. Wilkinson & Grist quoted above on page 4. Mr. Yan's arguments seemed to be that if his client was prepared to amend its specification of goods to "anti-inflammatory, analgesic and antipyretic preparations" and if the specification of "Nupro" was amended to "pharmaceutical preparations excluding anti-inflammatory; analgesic and antipyretic preparations; veterinary and sanitary substances; infants' and invalids' foods; plasters; material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin; dentifrices" then both marks could co-exist because they would no longer be goods of the same description. Mr. Yan referred me to the Hostess case (1959 RPC 120), and particularly to the comments of Lord Evershed M.R. (page 128, lines 28-48), Romer L.J. (the penultimate paragraph of page 132) and Ormerod L.J. (page 135, lines 7-12) on the question of goods being adjudged of the same description. He said that the Floradix case was not binding on the Registrar of Trade Marks in Hong Kong.

I believe that the arguments made at the Hearing by Mr. Yan proceeded on certain hypothetical assumptions. The first assumption is that his client would amend the specification of their goods to "anti-inflammatory, analgesic and antipyretic preparations". This is no doubt within the power of his client to do. I note also that the owner of the cited mark has given a letter of consent which is dated February 19, 1986 and is follows :-

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LETTER OF CONSENT

We, the undersigned, Johnson & Johnson, owners of the trademark NUPRO, Registration No. 1887/82 in Hong Kong do hereby declare that we have no objection to the registration and use of the trademark NAPRO, Application No. 1020/84 in Hong Kong by Syntex Corporation in respect of the following specification of goods :


"antiflamatory, analgesic and antipyretic preparations"".

This letter of consent from Johnson & Johnson does not, of itself, assist the Applicant if the specification for which "Nupro" is registered remains as stated in the second paragraph of page 2, for it is so wide ranging as to enable Johnson & Johnson to use its trade mark "Nupro", on anti-inflammatory, analgesic and antipyretic preparations. However, Messrs. Wilkinson & Grist's letter of 30th January 1988 also

refers to the specification of the cited mark "Nupro" being amended. This is the second assumption. Here, with respect, it is quite impossible to say whether this amendment will ever be carried out. At present a Certificate of Registration sealed on 5th August 1982 has been issued for the mark "Nupro" for the specification referred to in para. 2 on page 2 of this Decision. This Certificate of Registration may never be amended. I refer to Section 20 of the Trade Marks Ordinance (which I have quoted at page 5 above). The comparison to be made is between an applied for mark and "... a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods ...". I have therefore to deal with a particular trade mark and a specification of goods as it actually appears on the register, and not on the basis of a hypothetical amendment to a specification of goods which may or may never happen.

Pursuant to what I said in the previous paragraph, I therefore have to deal with specifications of goods for "Napro" and the cited mark "Nupro" which are as stated in the first and second paragraphs on page 2 of this Decision and I hold them to be goods of the same description. In doing so, I have taken into account what has been said by Mr. Ward Dyer in the "Floradix" case. Mr. Yan referred in his submissions to the Hostess case (page 10 above); but his submissions were based on hypothetical amendments to the specifications for which "Napro" is being applied for and for which "Nupro" is registered and therefore the Hostess case does not assist him.

Taking into account all the materials before me and the arguments submitted, I hold that the application to register the mark No. 1020/84 in Class 5 in respect of "Napro" in Part A of the Register must be refused because of the conflict with "Nupro" being trade mark No. 1887 of 1982.

  
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R.J. PERERA

Dated 9/1/89.