

**IN THE HIGH COURT OF FIJI
(WESTERN DIVISION) AT LAUTOKA
CIVIL JURISDICTION**

CIVIL ACTION NO. HBM 23 OF 2021

IN THE MATTER of an Appeal under section 11 of the Trade Marks Act 1933

BETWEEN : **R C MANUBHAI AND COMPANY PTE LTD** Company having its registered office at Shop 6, Ba Market Sub-Division, P O Box 9, Ba, Fiji.
APPELLANT

AND: : **THE ATTORNEY GENERAL OF FIJI** as a representative of The Fiji Intellectual Property Office (Copyright, patents & Trademarks, Traditional Knowledge & Expressions of Culture) Level 3 Suvavou House, Victoria Parade, P O Box 2213, Government Buildings Suva, Fiji
RESPONDENT

BEFORE : Hon. Justice A.M. Mohamed Mackie.

APPEARANCES : Mr. Padarath. N, with Ms. Chand. M. for the Appellant.
Mr. Mainavolau. J, for the Respondent.

DATE OF HEARING : 17th November 2023.

WRITTEN SUBMISSIONS: Filed by both the parties on 17th November 2023.

DATE OF JUDGMENT : 7th March, 2024

JUDGMENT

A. INTRODUCTION:

1. This is an Appeal preferred by, R.C. Manubhai, a Limited liability Company (“the Appellant”), against the decision of the Fiji Intellectual Property Office (**FIPO**), which is represented by the Attorney General (“the Respondent”), to refuse the amended Application dated 18th November 2020 lodged by the Appellant’s Solicitors for the registration of the Appellant’s trademark described in paragraph 2 of the prayer to the Notice of Originating Motion filed on 2nd September 2021, which is also depicted in the first page of the said Application For Registration of Trade Mark under **class 18**.
2. The amended Application was refused by the FIPO’s letter dated 19th January 2021 marked as “4”, and the Appellant’s Solicitors by their letter dated 2nd February 2021

marked as “5” requested for the grounds for refusal and this being not responded, the Appellant’s Solicitors by their subsequent letter dated 23rd June 2021 marked as “6” sent a reminder seeking for the grounds for refusal.

3. The Respondent FIPO, finally by their letter dated 14th June 2021 marked as “7” informed the Appellant’s Solicitors the grounds in detail for refusal of the Application. Thereafter, the Appellant’s Solicitors by their letter dated 11th August 2021 marked as “8”, having disputed the reasons for refusal adduced by the FIPO, requested for the reconsideration of the decision.

B. THE APPEAL:

4. However, before the receipt of any further response to the said letter marked “8”, which did not eventuate, the Appellant’s Solicitors by their Notice of Originating Motion filed this Appeal on 02nd September 2021 seeking the following Orders;

1. *The Appellant be granted leave to lodge and serve this Appeal out of time if required.*
2. *The decision by the Fiji Intellectual Property Office to refuse the registration of the trademark “Elements Beyond Expectation “as fully described in the Application with reference trademark number 271/ 75/2020) on the grounds that it is not permitted under section 8 (1) (d) of the Trademark Act 1933 be set aside;*
3. *The Respondent (FIPO) accept and register trademark “Element Beyond expectation” fully described in the Application with reference Trademark number 271/2020.*
4. *And that the costs of an incidental to this Appeal be paid by the Respondent.*

C. GROUND OF APPEAL:

5. Followings are the grounds the Appellant relied on for the prosecution of this Appeal, as per paragraph 5 of the Notice of Originating Motion.

5.1. *The Respondent erred in law in rejecting the application for Trade Mark on the grounds that the Trademark included a plug device bearing a direct reference to the character of the goods classified as described under the application number 271/2020. **When;***

- 5.1.1. *The Plug device is not descriptive of the class of goods that the appellant intends to sell under the trademark.*
- 5.1.2. *The authority of **British Sugar plc v James Robertson & sons ltd (1996) RPC 281** is not applicable to the trademark the appellant intends to register. The Authority did not establish that drawing or design are not capable of being registered as the Trademark.*
- 5.1.3. *The provision of section 8(1) (d) of the trademark Act is limited to only words and does not go beyond to regulate drawing or design.*

6. The Application is supported by an Affidavit sworn by, **Amit Pratap**, Financial Accountant of the Appellant company and filed on 02nd September 2021, along with annexures “AP1” to “AP9”. The Respondent’s Affidavit in opposition sworn by one **Sanjay Ram** on 03rd October 2021, being

an Executive Officer, was filed on 4th October 2023 together with annexures marked as “SR-1” to “SR 3”. The Appellant opted not to file Affidavit in reply.

7. This Appeal is made pursuant to Order 100 of the High Court Rules 1988 and the inherent jurisdiction of this Court. In addition to the oral submissions made at the hearing, parties have filed their respective written submissions as well as stated above.

D. HISTORY & FACTS IN BRIEF:

8. The Appellant is a Company, engaged in the supply and sale of hardware products, including electrical parts and accessories. Initially, on 4th May 2020, the Appellant’s Solicitors lodged an application to register the Trademark comprised of the words “**Elements beyond expectation**” with a device of an electrical male plug inserted into the artistically designed letter “n”, which along with other letters, formed the word “**Elements**”.
9. In other words, the image of the disputed plug is embedded in the middle of the word “n”, which is a part of the word “Elements”. Vide the disputed Trade-mark shown in the first page of the initial Application dated 23rd April 2020 and in paragraph 20 bellow.
10. According to the Appellant, the said Trade-mark intends to cover the goods under Class 18 for substances used as Electric filament or discharge lamps, including sealed beam lights and ultra-violet or infra -red lamps. arc-lamps and lighting fittings including search lights and spotlights and its parts illuminated signs, illuminated name plates, Air or Vacuum pumps, air or other gas compressors and fans, ventilating or recycling hoods incorporating a fan, whether or not fitted with filters, table, floor wall window uncelling or roof fans with a self-contained motor.
11. The FIPO refused the Application saying that the plug device in the Trademark was a direct reference to the character of goods.

E. LAW & ANALYSIS:

12. Section 8 (1) of the Trademark Act 1933 states as follows;

8.-(1) A registrable trade-mark must contain or consist of at least one of the following essential particulars: -

- (a) the name of a company, individual or firm represented in a special or Particular manner;*
- (b) the signature of the applicant for registration or some predecessor in his business.*
- (c) an invented word or invented words;*
- (d) **a word or words having no direct reference to the character or quality of the goods and not being, according to its ordinary signification, a geographical name or a surname; (emphasis mine)***
- (e) any other distinctive mark, but a name, signature or word or words other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d) shall not*

be registrable under the provisions of this paragraph except upon evidence of its distinctiveness:

Is the Appeal Out of Time?

13. The first relief sought by the Appellant is the leave for the Appellant to lodge and serve the Appeal out of time, if required. The Appellant claims that the letter dated 14th June 2021 marked as “AP-7” notifying the grounds for refusal was received by them only on 5th August 2021. It is observed that on 11th August 2021, as per the annexure “AP-8”, the Appellant’s Solicitors have written back requesting for the reconsideration of the Registration, but this letter was not responded by the FIPO. Having waited for further response, which did not eventuate, the Appellant on 2nd September 2021 filed the Appeal in hand. Thus, it appears the Appellants are well within the time period to Appeal the decision and cannot be found fault for laches. However, the Respondent has not taken up this as an issue during the hearing or in their written submissions. Thus, I consider that the Appeal was filed within time.

The Substantive Matter.

14. By way of its ground of Appeal, the Appellant urges that the Respondent erred in law in rejecting the Application for the registration of Trade mark on the grounds that the Trademark includes a Plug device bearing a direct reference to the character of goods classified under the application 271/2020, **when**
- 5.1.1. *The Plug device is not descriptive of the class of goods that the appellant intends to sell under the trademark.*
 - 5.1.2. *The authority of British Sugar plc v James Robertson & Sons Ltd (1996) RPC 281 is not applicable to the trademark the appellant intends to register. The Authority did not establish that drawing or design are not capable of being registered as the Trademark.*
 - 5.1.3. *The provision of section 8(1) (d) of the trademark Act is limited to only words and does not go beyond to regulate drawing or design.*

The Appellant’s Submissions:

15. The Appellant’s counsel submits, inter alia,
- a. ***“THAT the Fiji Intellectual Property Office (FIPO) refused the Appellant’s registration on the ground that the device was directly descriptive of the character of the goods.***
 - b. ***THAT the FIPO relied on the decision of, British Sugar plc v James Robertson Ltd (1996) RPC 281, which dealt with the refusal of the registration of a word as a Trademark, as opposed to a device and the FIPO failed to distinguish between the words “device” and “word” as used in the Trademark Act 1933.***
 - c. ***THAT it is clear from the wording that a “device” is different from a “word” used in a Trademark. That section 8 (1) (d) of the Trademark Act 1933 and British Sugar (Supra) both prohibit only “word or words” from making reference to the “character or quality of the***

goods, they do not refer to a “device”. That the device shown in the letter “n” is not descriptive of the class of the goods that the Appellant sells.

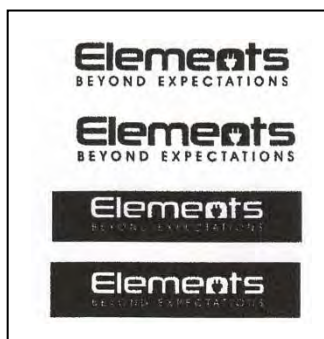
- d. **THAT** for the purpose of Trademark law, a device does not mean word or words and it refers to a drawing or diagram. That there is no law prohibiting a “device” from making reference to the character or quality of the goods, and the reasons for refusal of the Trademark by the Respondent and the Respondent has fallen into fundamental error in law.
 - e. **THAT** the device proposed to be registered as a Trademark is distinctive and is not used in common parlance to describe the goods that the appellant intends to sell under the trademark”.
16. It is also submitted by the Counsel for the Appellant that the addition of the drawing of a Plug in the blank space between the shapes making the letter “n” is not descriptive of the goods to which the trademark applies, and it does nothing more than adding more style to the way in which the small letter “n” is written.
17. In order to justify his position, Counsel for the Appellant refers to the reliance of the Respondent on **British Sugar (supra)** in their refusal letter, which speaks only about the “word” or “words” that must be distinctive of a person’s goods.

The Respondent’s Submission

18. Counsel for the Respondent submitted that the “Plug Device” in the word “Elements” is considered to be descriptive under section 8(1) (d) of the Act. A descriptive trade-mark is one where either the word or the picture(s) in the trade-mark describe the goods upon which the trade-mark will be used. Such trade-marks, under trade-mark principles are an absolute bar to registration.
19. Counsel for the Respondent relies on number of authorities, including **British Sugar PLC v James Robertson Ltd. 1996 RPC 81 (Chancery Division) (UK)** and **Superdry v Asahi Breweries No.2307338 Class 25. Thailand**, to substantiate his position.

Is the Device (the plug) Not Descriptive?

20. Counsel for the Appellant argues that the device hereof (the Electrical Plug in the letter “n” of the word “Elements”), which is depicted bellow, is not descriptive. For easy reference the image of the relevant word with the disputed plug is reproduced bellow.



21. A mere glance at the words “**Elements Beyond Expectation**”, submitted by the Appellant for registration, as its Trademark, shows that the Appellant, when designing it, under the guise of adding style to the letter “n” in the word “Elements”, has created an image of a male Plug, which clearly represents or refers to or shows some relationship to the electrical goods sold by the Appellant, which are shown in exhibits “AP-9”.
22. It is common knowledge that an electrical Plug (device), being an integral part of most of the electrical appliances and products in the market, is always accompanied with those products or subsequently purchased, which establishes the connectivity to the power supply socket for the operation of such electrical appliances or instruments. Undoubtedly, most of the electrical goods sold by the Appellant also fall into the category, which require the device of male plug for its connectivity to the power supply.
23. The Appellant’s stance that it does not engage in the sale of the Plug devices and its intended trademark will not affect the other traders, will not assist the Appellant as the disputed image of the Plug always gives direct reference to the character of the majority of the electrical goods and appliances in the marked, including those items sold by the Appellant.
24. After impregnation of the letter “n”, found in the word “Elements”, with the image of an Electrical Plug, the word “Elements”, being a part of the intended Trademark, plays a role more than it is expected to do. Because, once an image of this nature is introduced therein, it gives the direct reference to the character or quality of the goods, which eventually contravenes the section 8 (1) (d) of the Trademark Act of 1933.
25. If the Appellant is allowed to design the alphabet “n” or any other letter in the intended “word” or “words” to accommodate an image of a product, which is a Plug in this case, it will open the flood-gate for the traders to twist or distort the letters in the intended “word” or “words” that forms the trade-mark for registration, which will finally defeat the purpose of the section 8 (1) (d). By doing such a change to create an image in the letter “n”, under the guise of artistically designing, which undoubtedly gives direct reference to the character of the goods, the Appellant cannot claim that it’s intended Trademark is in full compliance with the section 8 (1) (d) of the Act.
26. The Appellant, who claims to be creative, while submitting its Trademark, namely, “**Elements Beyond Expectation**” for registration, which is composed of words to fall in line with section 8(1) (d) of the Act, by inserting an image of a Plug in to a letter therein, has directly and/ or indirectly given reference to the character of the goods sold by it.
27. As the counsel for the Appellant argues, a word or letter may not be a device. But it loses its character of being only a “word” or “words’ when an image of a device is found to be hiding behind those word or words, which gives direct reference to the character and quality of the goods and takes away the distinctiveness.

28. After introduction or interpolation of an image into a “word” or “words”, which gives direct reference to the character of goods, it will no longer be just a “word” or “words” in terms of the section 8 (1) (d) of the Act for it to be protected by that section. In this matter, the disputed plug device found in the letter “n” of the word “Elements” has to be considered as descriptive and gives reference to the Appellant’s goods.
29. The disputed Plug device in this case, which classifies and makes direct reference to the character of the goods, cannot hide itself in a letter or word and go undetected by the section 8 (1) (d) of the Act. The very word becomes disqualified for registration owing to the disputed image therein, which is descriptive of the nature or characteristic of the goods.
30. I observe that the word “Elements”, when taken together with the image of the electrical Plug designed within the letter “n” thereof, obviously gives direct reference to the character of the goods traded by the Appellant.
31. In the case of ***Superdry v Asahi Breweries No- 2307338 Class 25, Thailand***, the Supreme Court explained what constitutes the character of the goods as follows.

“To determine whether a word is directly descriptive of the nature or characteristic of the goods, it should consider whether the word enables the public to immediately know or understand the characteristic of the goods. If the word is a generic term that is closely related to the nature or characteristic of the goods, or the general public can use only limited judgment to know the nature or characteristic of the goods bearing the trademark, the word shall be deemed directly descriptive of the nature or characteristic of the goods.”

32. It was also highlighted that in order to be deemed non-distinctive, a word must be capable of making the general public immediately understand, or use only limited consideration of imagination to understand, the nature or characteristic of goods for which protection is sought. On the contrary, if the general public needs to apply at least reasonable consideration or imagination to understand the connection between the word and the goods for which it is used, then such word cannot be interpreted to be a directly descriptive word.
33. I find the plug device found in the letter “n” in the word “Elements” is considered to be descriptive under section 8(1) (d) of the Act. The plug device gives the description in relation to the product. The essential element that requires attention here is not the word, but the plug device, which is conspicuously embedded in the letter “n” of the word “Elements”. At a mere glance, it immediately shows the public as to what type of goods are being sold.
34. The stylish letter “E” in the Appellant’s earlier Trademark No-699/15, does not refer to or describe any product sold by the Appellant. But the present trademark, by carrying an image of a plug in the letter “n” of the word “Elements” goes against the section 8(1) (d).

35. Finally, and in short, what this Court observes is, that the disputed plug device found in the letter “n” has tainted the word “Elements” in the Trademark sought to be registered. As a result, the said word has lost its legitimacy to be rightfully registered in terms section 8 (1) (d) of the Act.

F. CONCLUSION:

36. Accordingly, for the reasons stated above, this Court has no alternative but to affirm the decision of the FIPO not to register the Trademark No- 271/ 2020 lodged by the Appellant and dismiss the Appeal with an order for summarily assessed costs in a sum of \$750.00 payable by the Appellant in 28 days.

G. FINAL ORDERS:

1. The Appeal is dismissed.
2. The decision of the Fiji Intellectual Property Office, to refuse the registration of the Trademark in question, is upheld.
3. The Respondent is entitled to a sum of \$750.00 from the Appellant being the summarily assessed costs.
4. The costs shall be paid within 28 days from today.


A.M. Mohamed Mackie
Judge



At High Court Lautoka this 7th day of March, 2024.

SOLICITORS:

For the Appellant:

Messrs. Samuel Ram Lawyers- Barristers & Solicitors

For the (FIPO) Respondent:

Office of the Attorney-General