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1919.

TRONSON
v.
WHITE.

Appeal dismissed with costs, except so far as the costs were increased by the transfer of the appeal from Brisbane to Sydney, the respondent to pay to the appellant the amount of such increase, the one amount to be set off against the other.

Solicitors for the appellant, *Atthow & McGregor*, Brisbane.

Solicitors for the respondent, *Chambers, McNab & McNab*, Brisbane.

N. McT.

[HIGH COURT OF AUSTRALIA.]

STANDARD PAINT COMPANY . . . APPELLANT;
OPPONENT,

AND

HALES LIMITED . . . RESPONDENT.
APPLICANT,

H. C. OF A. *Trade Mark—Registration—Similarity to registered trade mark—Likelihood of*
1920. *deception—Trade Marks Act 1905-1912 (No. 20 of 1905—No. 19 of 1912),*
secs. 25, 33, 114.

MELBOURNE,
March 1.

Knox C.J.,
Isaacs,
Gavan Duffy
and Rich J.J.

An application by the respondent for the registration of the word "Superoid" as a trade mark in class 17 in respect of roofing, flooring, damp course and waterproof cement was opposed by the appellant, which was the registered proprietor of a trade mark consisting of the word "Ruberoïd" and registered in class 17 in respect of similar goods.

Held, on the evidence, that the respondent had not discharged the onus of establishing that the use of the word "Superoid" as a trade mark was not likely to deceive, and therefore that the word should not be registered as a trade mark.

APPEAL from the Law Officer.

On 10th August 1916 Hales Ltd. applied to the Registrar of Trade Marks for the registration of the word "Superoid" as a trade mark in class 17 in respect of roofing, flooring, damp course and waterproof cement. The Registrar refused to accept the application on the ground that the mark so nearly resembled the registered trade mark No. 18664, consisting of the word "Ru-ber-oid", and registered on 31st July 1915 in class 17 in respect of manufactures from mineral and other substances for building or decoration, as to be likely to deceive. On appeal the Law Officer directed that the application should be accepted. It having been accepted, the registration of the trade mark was opposed by the Standard Paint Co., which was the registered proprietor of the trade mark No. 2834, consisting of the word "Ruberoid" and registered on 26th October 1906 in class 17 in respect of waterproof compositions and fabrics useful for wall and roof coverings, damp courses, floors and linings of buildings, and also of the trade mark No. 18664 referred to above. The substantial ground of opposition was that the applicant's trade mark was so like the opponent's registered trade marks No. 2834 and No. 18664 as to be likely to deceive. From the declarations in support of the opposition it appeared (*inter alia*) that E. Rich & Co. Ltd. of Sydney was the first selling and distributing agent in Australia for waterproof compositions and fabrics got up in rolls and known under the trade name "Ruberoid" and manufactured by the opponent, and first began selling those goods in 1898; that in March 1912 the applicant took over the business of E. Rich & Co. Ltd., and became the principal selling and distributing agent for the goods of the opponent known under the trade mark "Ruberoid"; that such agency was terminated on 10th September 1916 pursuant to a notice given by the opponent to the applicant on 10th June 1916. It also appeared that the first syllable of the word "Ruberoid" in both forms in which it was registered was pronounced as "ru" in the word "ruby," the form "Ru-ber-oid" having been adopted for advertising purposes, and that waterproof material manufactured by the opponent was got up and sold in rolls enclosed in wrappers, the trade mark "Ruberoid" in one of its forms being printed both on the material

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H. C. OF A. and on the wrappers. The Registrar refused the application for
 1920. registration; but the Law Officer, on appeal, reversed the Registrar's
 STANDARD decision, and determined that the application ought to be registered.
 PAINT CO. From the decision of the Law Officer the opponent now appealed
 v. HALES LTD. to the High Court.

J. R. Macfarlan (with him *Sproule*), for the appellant. The respondent's mark is likely to deceive, or at least he has not made it clear, as he is bound to do, that it is not likely to deceive; and therefore registration should have been refused under secs. 25 and 114 of the *Trade Marks Act* 1905-1912.

[KNOX C.J. referred to *Slazenger & Sons v. Feltham & Co.* (1).]

[ISAACS J. referred to *Robert Harper & Co. Proprietary Ltd. v. A. Boake Roberts & Co.* (2).]

[GAVAN DUFFY J. referred to *Don v. Burley* (3).]

The Court will take into consideration what is in the mind of an applicant for a trade mark, and if he is evidently setting out to deceive will not aid him (*In re Tilley's Trade Mark* (4); *In re Geo. Cording Ltd.'s Application* (5)).

Latham and *Gorman*, for the respondent. Having regard to the distinctive features of the appellant's trade mark, the respondent's mark, if registered, will not be likely to deceive (*In re Farrow's Trade Mark* (6); *In re Thomas A. Smith Ltd.'s Application* (7); *In re Trade Mark "Herogen"* (8); *Coombe v. Mendit Ltd.* (9); *Tokalon Ltd. v. Davidson & Co.* (10)). The application should be regarded irrespective of the conduct of the applicant. A reasonable explanation of the word "Superoid" is that the termination "oid" is common to goods of the same class, and that the prefix "super" indicates a superiority over other similar goods. That explanation, if adopted, would have no sinister suggestion.

KNOX C.J. In my opinion this appeal should be allowed, and

(1) 6 R.P.C., 531, at p. 538.

(2) 17 C.L.R., 514.

(3) 22 C.L.R., 136, at p. 141.

(4) 26 V.L.R., 203, at p. 208; 22 A.L.T., 33.

(5) (1916) 1 Ch., 422.

(6) 7 R.P.C., 260, at p. 264.

(7) 30 R.P.C., 363.

(8) 30 R.P.C., 73.

(9) 30 R.P.C., 709.

(10) 32 R.P.C., 133.

registration refused. I feel no doubt that the applicant for registration has failed to establish, as he was bound to do, that the use of the word "Superoid" as a trade mark in connection with the class of goods to which his application relates is not calculated to deceive, having regard to the use and registration of the word "Ruberoid" as a trade mark in regard to goods of the same class. So far from the applicant discharging this onus, I think it is reasonably clear that, having regard to the spelling and pronunciation of the two words in question, and to the fact that both are invented words and not ordinary English words at all, those responsible for the invention of the word "Superoid" in launching this application entertained the idea that they were getting as near as possible to the word "Ruberoid" without incurring the disability of not being able to register the former word. The circumstance that the applicant tendered no evidence in opposition to that furnished by the opponent confirms me in that belief.

For these reasons I think that the appeal should be allowed.

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ISAACS J. I also agree that the appeal should be allowed. I will quote a few words from my judgment in *Robert Harper & Co. Proprietary Ltd. v. A. Boake Roberts & Co.* (1), not as an authority but because at the present moment I cannot frame my opinion in better words. I said:—"The respondents have failed to satisfy their obligation of negating the danger of deception. The well-known words of Lords *Watson* and *Herschell* in *Eno v. Dunn* (2) definitely settle that obligation. In a very recent case—*In re United Kingdom Tobacco Co.* (3)—Lord (then Mr. Justice) *Parker* said: 'Where a person applies for the registration of a new mark it is for him to show that that mark is free from all danger of leading, either on the part of the public or on the part of the trade, to deception or confusion.' That is a very distinct onus, and if after considering all the relevant circumstances a doubt remains, the mark is not to be registered. The resources of art and ingenuity must be sufficient to create a distinctive mark for the applicant's goods, without creating at the same time a zone of danger either for

(1) 17 C.L.R., at p. 520.

(2) 15 App. Cas., 252.

(3) 29 R.P.C., 489, at p. 496.

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other traders or the public.” Applying those principles and observations to the present case, the best that can be said for the respondent is, to my mind, that there is nothing in the circumstances to alter the mutual effect of the two marks when they come into competition in the market. Having regard to the nature of the goods to which the marks apply, the goods being exactly the same in each case, it cannot be said in this case that the registration of the respondent’s mark would be free from danger of confusion or deception.

I therefore think that the respondent has failed in discharging the onus cast upon it.

GAVAN DUFFY J. I agree that the appeal should be allowed.

RICH J. I agree that the appeal should be allowed, and I base my judgment on the ground that it is not clear that deception may not result from registration. I repeat what I said in *Don v. Burley* (1). I amplify that a little. The words of sec. 33 (3) are plain. There is no absolute right to registration of a trade mark, but, subject to certain limitations, the Statute clothes the Registrar with a discretion to refuse or accept registration (*In re Garrett’s Application* (2)). It is a proper exercise of this discretion to refuse registration where the matter is left *in dubio*, the applicant not making it perfectly clear that there is no danger of deception.

Appeal allowed with costs. Respondent to pay costs of appeal, and such amount by way of costs as would have been allowed if appellant had been successful both before the Registrar and the Law Officer, such costs to be taxed.

Solicitor for the appellant, *F. B. Waters.*

Solicitors for the respondent, *Strongman & Crouch.*

B. L.

(1) 22 C.L.R., at p. 141.

(2) (1916) 1 Ch., 436, at p. 441.