[HIGH COURT OF AUSTRALIA.]

RECKITT & COLMAN (AUSTRALIA) LIMITED APPELLANT; OPPONENT,

AND

BODEN . . . . . RESPONDENT. APPLICANT,

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SYDNEY. *June* 5, 6; *July* 30.

Latham C.J., Rich, Dixon, McTiernan and Williams JJ.

Trade Mark—Registration—Opposition proceedings—Similarity of trade marks—Likelihood of deception—Onus of proof—Trade Marks Act 1905-1936 (*No.* 20 *of* 1905—*No.* 75 *of* 1936), *ss.* 25, 114.

An application for the registration of a trade mark consisting of the word "Dekol" in class 1 in respect of wood preserving oils and paints was opposed, on the ground that the proposed mark would be likely to deceive, by the proprietor of a trade mark registered in respect of disinfectants and germicides included in class 2 and consisting of a design in the approximate form of a keyhole across which the word "Dettol" was prominently displayed transversely over a perpendicular sword. "Dettol" is a relatively expensive preparation mainly sold by chemists to the public in small quantities in bottles ranging from 4 ozs. upwards and is also sold in larger quantities in tins to hospitals and similar organizations, whereas "Dekol," an oily paint-like substance, is sold mainly at hardware stores by the gallon in tins. There was no evidence that any confusion or deception had ever occurred.

Held, by *Latham* C.J., *Dixon* and *McTiernan* JJ. (*Rich* and *Williams* JJ. dissenting), that on the evidence the applicant had discharged the onus of showing that his mark was not likely to deceive, and, therefore, that he was entitled to registration of the mark.

APPEAL from the Deputy Registrar of Trade Marks.

An application was made by Alexander Boden, carrying on business under the registered firm name of Alex. Minter & Co., at Number 75 Elizabeth Street, Sydney, Chemist, to register the word "Dekol" as a trade mark in class 1 in respect of wood preserving oils and paints.

The application was opposed by Reckitt & Colman (Australia) Ltd. upon the grounds (*a*) that it, the opponent, was the registered proprietor of a trade mark in class 2 which applied to disinfectants and germicides included in class 2, and the trade mark of the applicant, Alexander Boden, so closely resembled the trade mark of the opponent as to be likely to deceive or cause confusion in trade; (*b*) that the opponent had extensively used for many years and was still using its trade mark throughout the several States of Australia and other parts of the world to distinguish its disinfectant and germicide, which product was sold in bulk containers and in retail containers; (*c*) that the opponent had extensively advertised for many years and was still advertising its trade mark and the goods to which it was applied throughout the several States of Australia and other parts of the world and the trade mark had become well known to the trade and public as designating the goods of the opponent; (*d*) that the registration or use of the applicant's trade mark would interfere with the use by the opponent of its trade mark; (*e*) that in view of the use by the opponent of its trade mark the applicant's trade mark was not distinctive; (*f*) that the use by the applicant of his trade mark would by reason of its being likely to deceive be deemed disentitled to protection in a court of justice; (*g*) that the registration of the applicant's trade mark would be unjust to the opponent and contrary to natural justice; and (*h*) that the registration of the applicant's trade mark should be refused on the ground that it was not clear that deception and confusion would not arise and the onus was on the applicant.

The applicant's counter-statement was as follows:—1. In reply to ground (*a*), he denied that his trade mark "Dekol" so closely resembled so as to be likely to deceive or cause confusion in trade the opponent's trade mark which consisted of "a somewhat keyhole shaped label, in use coloured black, bearing in white a large sword theredown, a panel across the disc-like part of the label, in use coloured green, and bearing thereon the word 'Dettol,' with the notification 'Regd.' close to the said word, and around the disc-like part, appearing in white, the words 'Antiseptic', 'Non-poisonous', 'Germicidal'"; 2. in reply to ground (*b*), he admitted that the opponent had extensively used its said trade mark applied to small quantities of its goods in small containers which were sold to the public only by chemists as advertised by the opponent; 3. in reply to ground (*c*), he admitted that the opponent's said trade mark had been well advertised, and that each advertisement contained the statement "sold only by chemists"; 4. in reply to ground (*d*), he denied that the use of his trade mark

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"Dekol" upon and in connection with wood preserving oil and paint in class 1 could in any way interfere with the use by the opponent of its said trade mark being a peculiar label as above described and registered in respect of and used upon a different class and different description of goods. His, the applicant's, trade mark had been in use upon and in respect of wood preserving oil during the last six years and had been well advertised for some time and no occurrence whatsoever of any confusion or interference with the opponent's special goods sold only by chemists had come to his knowledge; 5. in reply to ground (*e*), he asserted that his trade mark "Dekol" was distinctive of wood preserving oils and paints. It had been used for that purpose from about February 1938; 6. in reply to ground (*f*), he asserted that the use of his trade mark "Dekol" upon wood preserving oils and paints was not likely in any way to deceive, and was entitled to registration. Such registration would not cause or enable his goods to be passed off as and for the goods of the opponent; 7. in reply to ground (*g*), the registration of his trade mark "Dekol" could not in any way injure the trade of the opponent and therefore would not be unjust to the opponent; and 8. in reply to ground (*h*), his trade mark should be registered; deception and confusion could not occur between the opponent's goods bearing its trade mark and his goods bearing his trade mark; and the opponent's goods and his goods were quite different, in nature, appearance, smell and use, and, moreover, were sold in different shops and different departments of stores, to different classes of customers, and at very different attention-compelling prices, and the get-up of each was vastly different.

Evidence along the lines suggested in the counter-statement was given by way of statutory declarations.

Evidence in support of the opposition was given by various persons by way of statutory declarations, including twenty-five statutory declarations in stereotyped form from general storekeepers in various parts of the Commonwealth, who all expressed the opinion that "Dekol" was so like "Dettol" that "there was reasonable likelihood of one being mistaken for the other both visually and orally."

Taking into account the difference between the respective goods, the uses to which they were applied, the type of customer who would be likely to purchase the goods, the difference between the marks and having considered all the surrounding circumstances, the Deputy Registrar was of opinion that the applicant had shown that user of the trade mark "Dekol" on the goods specified in the

application would not be likely to deceive. He dismissed the opposition and granted the application.

From that decision the opponent appealed to the High Court.

Further material facts and relevant statutory provisions appear in the judgments hereunder.

May, for the appellant. The word " Dekol " as used by the respondent closely resembles in form and sound the word " Dettol " which for many years has been the essential characteristic of the appellant's trade mark and is a feature which the public associate with the appellant in connection with the vending of its goods. This resemblance will tend to confuse and mislead the public. As the preparation known as " Dettol " may be taken as a gargle and the substance " Dekol," according to the evidence, is a poisonous substance, the confusion may create an element of danger and lead to harmful results. This possibility is emphasized by the fact that both commodities are sold at general stores throughout the Commonwealth. The respondent is not entitled to register his trade mark as of right and if the matter is left *in dubio* he should not succeed. In addition to the rights of the parties, the rights of the public must be considered. The facts show that the matter is not free from doubt (*A. & F. Pears Ltd.* v. *Pearson Soap Co. Ltd.* (1); *Australian Woollen Mills Ltd.* v. *F. S. Walton & Co. Ltd.* (2)).

Thomas, for the respondent. The trade marks under consideration are so dissimilar in every respect as to render remote the possibility of confusion or deception in the minds of the public. The test that should be applied is shown in *McDowell* v. *Standard Oil Co. (New Jersey)* (3). The evidence does not establish that " Dettol " is widely known as a germicide (*Radio Corporation Pty. Ltd.* v. *Disney* (4)). In that case, the applicant sought to use the identical words. The claim made by the appellant is that the goods are sold under its registered trade mark. The test of the likelihood of confusion or deception is the usual manner in which ordinary people behave (*Australian Woollen Mills Ltd.* v. *F. S. Walton & Co. Ltd.* (5)). Ordinary people would be able to differentiate readily between the sound of " Dekol " and the sound of " Dettol." The respective preparations are not of the same class and are fundamentally dissimilar, that is " Dettol " is a medicinal preparation and " Dekol " is a paint-like preparation used as a wood and canvas

(1) (1925) 37 C.L.R. 340, at pp. 342, 345, 346, 348, 349.
(2) (1937) 58 C.L.R. 641, at p. 658.
(3) (1927) A.C. 632, at pp. 638, 639; 44 R.P.C. 335, at p. 341.
(4) (1937) 57 C.L.R. 448.
(5) (1937) 58 C.L.R., at p. 658.

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preservative, therefore there cannot be any confusion either in the trade or in the public mind (*Eno* v. *Dunn* (1)). The onus of proving non-likelihood of deception does not pass to an applicant unless and until the opponent produces evidence of the manner in which and the means by which his goods are sold. The principles applicable are stated in *Halsbury's Laws of England*, 2nd ed., vol. 32, pp. 563-568, and *Kerly* on *Trade Marks*, 6th ed. (1927), pp. 258-262. An important matter for consideration is whether the goods are of the same description (*In re the Australian Wine Importers Ltd.* (2)). The sum total of the appellant's evidence in respect of its commodity is that storekeepers do not sell the larger containers but sell only bottles bearing the word "Dettol" without the registered trade mark. The respondent's commodity is sold in tins. The two commodities differ in respect of appearance, form, odour, physical properties and purpose. The get-up is entirely different. There is not any evidence that confusion or deception has actually happened, nor is there any evidence that in fact the two preparations have been sold in the same establishment.

May, in reply. The use of the respondent's mark would be "likely to deceive" within the meaning of s. 114 of the *Trade Marks Act* 1905-1936. The position in this case is very similar to the position in *Eno* v. *Dunn* (3). The likelihood of confusion was dealt with in *In re Compagnie Industrielle des Pétroles' Application*; *In re Price's Patent Candle Co.'s Trade Mark* (4).

Cur. adv. vult.

July 30. The following written judgments were delivered :—

LATHAM C.J. This is an appeal from a decision of the Deputy Registrar of Trade Marks dismissing the opposition to an application for the grant of a trade mark. The applicant has applied for the registration of a trade mark consisting of the word "Dekol" in class No. 1 in respect of wood-preserving oils and paints. The opponent company is the proprietor of a trade mark registered in respect of disinfectants and germicides included in class 2, and consisting of a design in the approximate form of a key hole across which the word "Dettol" is prominently displayed transversely over a perpendicular sword. Between the word "Dekol" and the opponent's trade mark taken as a whole there is no resemblance,

(1) (1890) 15 App. Cas. 252, at p. 260.
(2) (1889) 41 Ch. D. 278, at pp. 287, 291.
(3) (1890) 15 App. Cas. 252.
(4) (1907) 2 Ch. 435.

except in the words "Dekol" and "Dettol." Those words are similar, both to the eye and to the ear, and the opposition is founded upon the contention that, if the word "Dekol" is registered as a trade mark, there will be a risk of confusion between goods sold under that name and goods sold under the opponent's mark.

In considering this matter, the Court must take into account not only any similarities and differences between the trade marks as directly compared, but also any risk of confusion arising from an imperfect recollection of one trade mark when goods bearing the other trade mark are being bought and sold. The actual user of both marks must be considered, and also any other user which may honestly be made of them. I refer to the statement of these principles contained in *Jafferjee* v. *Scarlett* (1).

The evidence shows that, since the year 1938, the word "Dekol" has been applied to a liquid substance sold by the pint, quart or gallon in tins. The preparation is a form of paint used for protecting wood and canvas from the ravages of white ants, borers, dry rot, mildew, &c. The advertisements of this substance emphasize that it is a preparation for preserving wood and canvas. It is sold at 14s. 6d. a gallon in one-gallon tins and 12s. a gallon in four-gallon tins. About 8,000 gallons have been sold since the preparation was placed upon the market.

The opponent company uses the word "Dettol" for the purpose of describing a pharmaceutical product which has a large sale—over 2,500,000 packages have been sold since the year 1934. This is a medicinal preparation, and is nothing like a paint. It is described in advertisements as antiseptic, non-poisonous and germicidal, and as being sold only by chemists, though the evidence shows that it would also be sold in general stores which sold medicinal preparations. "Dettol" is sold principally in bottles—4 ozs., 8 ozs., 16 ozs. and 32 ozs.—but also in larger quantities in tins. The labels used show that it is designed for the purpose of treating cuts, bites, abrasions and insect stings, for use in epidemics, for the treatment of linen and floors, for personal hygiene, for use as a gargle, &c. The price of a small bottle is advertized at 2s. 1d. The opponent largely circulates "To the medical profession only" a leaflet entitled "Dettol Products," in which the recommended uses of "Dettol" in application to the human body are described and set forth. "Dettol" is particularly recommended as a preparation suitable for making the hands antiseptic by being used in dilution as a wash.

(1) (1937) 57 C.L.R. 115.

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"Dekol" cannot be diluted with water. It is an oily paint-like substance, and if it gets upon the hands it should, according to the advertisement upon a label used by the applicant, be removed by the use of kerosene.

The opposition is based in the first place upon s. 25 of the *Trade Marks Act* 1905-1936, which is in the following terms:—"Subject to this Act, the Registrar shall not register in respect of goods a trade mark identical with one belonging to a different proprietor which is already on the register in respect of the same goods or description of goods or so nearly resembling such a trade mark as to be likely to deceive." This provision applies only in cases where application is made for the registration of a trade mark in respect of the same goods or description of goods in respect of which a trade mark belonging to a different proprietor is already on the register. The Deputy Registrar has held that the goods in respect of which the word "Dettol" is registered are not the same goods or goods of the same description as those in respect of which registration is sought by the applicant. It is true that registration is sought in respect of different classes of goods as set forth in the *Trade Mark Regulations*, but this fact does not in itself show that the goods are not of the same description. Goods may be of the same description although they are included in different classes mentioned in the regulations, and they may be of different descriptions though they are included in the same class: See *In re The Australian Wine Importers Ltd.* (1). The goods here in question are plainly not the same goods, and they are not, in my opinion, goods of the same description. There is a great difference between a germicidal antiseptic and a wood-preserving paint.

The opponent also relies, however, upon s. 114 of the *Trade Marks Act*, which is in the following terms:—"No scandalous design, and no mark the use of which would by reason of its being likely to deceive or otherwise be deemed disentitled to protection in a court of justice, or the use of which would be contrary to law or morality, shall be used or registered as a trade mark or part of a trade mark."

The onus is upon the applicant for a trade mark to displace the probability of deception. If the matter is left in doubt the application fails: See *Eno* v. *Dunn* (2). The Deputy Registrar was of opinion that the applicant had shown that there was no probability of deception because it was shown that ordinary customers purchasing with ordinary caution were not likely to be misled. I agree with this decision. There is, it is true, a marked resemblance

(1) (1889) 41 Ch. D. 278, at p. 291. (2) (1890) 15 App. Cas. 252.

between the words " Dekol " and " Dettol " as spoken, and there is a risk of confusion of the two words when written. But the goods to which the words are applied and to which, if the application is granted, they may be applied, are very different and are sold under very different conditions. There is no evidence that any confusion has actually ever occurred. In my opinion, no-one who knew or had ever used the antiseptic " Dettol " would be likely to accept " Dekol " as being " Dettol " or vice versa. The substances and the uses of the substances are entirely different. " Dettol " is a relatively expensive preparation mainly sold to the public in small quantities in bottles ranging from 4 ozs. upwards, whereas " Dekol " is sold mainly by the gallon in tins. " Dettol " is also sold in larger quantities in tins to hospitals, ambulance societies and similar organizations. But such institutions could not, in my opinion, possibly confuse the wood-preserving paint with the germicidal antiseptic.

In *McDowell* v. *Standard Oil Co.* (*New Jersey*) (1), the evidence showed that the word " Nuvol " was used in respect of oil used for illumination, heating and lubrication, and that the word " Nujol " was used for a medicinal preparation of paraffin oil for human use. Both oils were refined from petroleum, the only difference being in the degree of refinement. If " Nuvol " were made in a more refined form and " Nujol " in a less refined form there might be, it was held, confusion between the two products. There is no evidence to show that any such risk exists in the present case. There is no evidence indicating that there is any reasonable probability of the opponent manufacturing a germicidal antiseptic in a form approximating to that of a non-dilutable paint or of the applicant manufacturing his paint in such a form that anyone would think that it was a germicidal antiseptic.

Thus a person asking for " Dettol " as a medicinal preparation could not, in my opinion, be misled into taking " Dekol," a relatively thick substance with the characteristics of paint, as being a medicinal preparation. Similarly any person who wished to buy a paint to preserve wood or canvas &c. could not be misled into taking " Dettol ", which no-one would think of using for such a purpose. There is, I think, no risk of confusion as to goods. Nor, in my opinion, is there any risk of confusion as to the identity of the manufacturers of goods. The risk that any person purchasing either commodity would be misled into thinking that the commodity purchased was the product of the manufacturer of the other commodity is, in my opinion, so remote as to be negligible. To hold otherwise would in effect extend the effect of the registration of the " Dettol " trade

(1) (1927) A.C. 632; 44 R.P.C. 335.

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mark beyond the limits of the class of goods in respect of which it is registered, without there being any evidence that that mark has acquired any significance otherwise than in relation to the goods in connection with which it has been used. The case is very different from *Radio Corporation Pty. Ltd.* v. *Disney* (1), where it was shown that words proposed to be used as a trade mark had acquired a close association with a particular person.

In my opinion, the appeal should be dismissed.

RICH J. The Deputy Registrar of Trade Marks accepted the application of the respondent to register the word "Dekol" in class 1 in respect of oils and paints for the preservation of wood in spite of the opposition by the appellant company which has as a trade mark the word "Dettol" registered under class 2 in respect of disinfectants and germicides. The appeal against this decision is based upon the application of s. 114 of the *Trade Marks Act* 1905-1936 on the ground that the use of the respondent's mark would be likely to deceive. "It is well settled that the onus of proving that there is no reasonable probability of deception is cast on an applicant for registration of a mark" (*Aristoc Ltd.* v. *Rysta Ltd.* (2), citing *Eno* v. *Dunn* (3)). The great majority of people, whether customers or salesmen, have not been taught voice production and the ordinary pronunciation, apart from adenoidal slurring, of the two words "Dettol" and "Dekol," would be likely to deceive. The liability to deception both by ear and eye would certainly occur if the goods of the parties were in the same class. But it is said that the nature of the goods is so different that customers or the public are not likely to be deceived. The products of the opposing parties are chemical products and no doubt persons with some scientific knowledge or training might distinguish between germicidal and antiseptic products and those destructive of bacteria. But the ordinary purchaser has not that nice perception and might well think that the manufacturers of "Dettol", which has been extensively advertised and is well known to the public, were embarking on a crusade against white ant and borer by marketing some chemical compound calculated to destroy these insects or to preserve wood and canvas from them, in other words that the owners of "Dettol" "were starting a new line of goods," cf. *Halsbury's Laws of England*, 2nd ed., vol. 32, p. 571; *In re Ferodo Ltd.* (4).

The want of originality in the choice of this mark gives rise to scepticism and, in all the circumstances, I am unable to conclude

(1) (1937) 57 C.L.R. 448.
(2) (1945) A.C. 68, at p. 85.
(3) (1890) 15 App. Cas. 252.
(4) (1945) W.N. (Eng.) 137.

that the respondent's mark is not likely to deceive by reason of its resemblance to the appellant's mark. The matter is left in doubt and the application to register should have been refused. I would allow the appeal.

DIXON J. The Deputy Registrar of Trade Marks dismissed the opposition to the registration of the respondent's mark chiefly because the goods to which his mark is applied or is applicable belong to a different field from that occupied by the appellant company under their mark and from any which might be so occupied. He says also that he took into account the difference in the marks and the surrounding circumstances. The words, however, forming in the one case the mark, and in the other the chief feature of the mark, are very similar in sound, and, although the respondent claims that "Dekol" is pronounced with a long "e", there can be little doubt that, if the respondent's mark were applied to goods sold in the same trade or to the same class of customers as goods known by the appellants' mark, there would be a confusion between them. The appellants' mark, of which the word "Dettol" forms the most prominent part, is registered in respect of disinfectants and germicides in class 2, and the respondent applies for registration of his mark, "Dekol," in respect of wood preserving oils and paints in class 1.

"Dekol" has been used for the past six years by the respondent and his predecessors in business as the mark for, or trade name of, a preparation or preparations for preserving wood and canvas. The preparations are made by the respondent and distributed through a company carrying on the business of ship's chandlers and general merchants. They are heavy oily fluids not capable of dilution and apparently used to protect wood or materials made of cellulose from vermin such as white ants and borers and from dry rot and mildew. The fluids have been put up in tins of one or of four gallons marked "Dekol," "For wood" or "For canvas," as the case may be. Apparently they are also sold in tins of a pint and of a quart. "Dekol" is purchased from the distributors by hardware stores, shipowners, boat proprietors, timber yards, timber mills and builders. The trade in "Dekol" does not seem to have been large, though it has been fairly widespread, at all events in New South Wales.

The appellants sell the well-known product commonly called by the name "Dettol." It is widely advertised as an antiseptic, a germicide and disinfectant and is sold to the general public in bottles of various sizes, usually by chemists. Indeed, though it is

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sold in general stores in the country and perhaps sometimes in other shops, the appellants state in some of their advertisements that it is sold only by chemists. It is intended for use upon the human frame, for example, for cuts, wounds, abrasions and bites, and as a mouth wash and so on. But on one label in evidence there is also a recommendation to use it, in dilution, for the treatment of linen, floors, &c., in the case of epidemics. In a pamphlet of the appellants to the medical profession, "Dettol" is described as a clear light yellow fluid with the unique property, for a potent disinfectant, of a pleasant and agreeable smell. It is in none of these things that a resemblance is to be found in the wood preserving oil, "Dekol." Though "Dettol" is sold to the public as a fluid, it appears that for some medical uses it is put up as a cream. It also appears that, in the case of hospitals and other large consumers, it is sold not only in bottles but also in metal containers holding as much as five gallons.

It is, I think, clear enough that the case is not one to which s. 25 of the *Trade Marks Act* applies. For the respondent is not seeking to register "Dekol" "in respect of the same goods or description of goods" as that in respect of which the mark containing the word "Dettol" is registered. What forms the same description of goods must be discovered from a consideration of the course of trade or business. One factor is the use to which the two sets of goods are put. Another is whether they are commonly dealt with in the same course of trade or business. In the present case, the goods are quite different, their uses are widely separated and they are not commonly sold in the same kinds of shops or departments. It is true that there is some evidence that in country stores wood oils and paints are sometimes sold and so is "Dettol." But that can hardly carry weight with anyone familiar with Australian country stores.

The appellants must, I think, depend on s. 114. Under the principles that have been developed in applying that provision to applications for registration, the applicant must negative all substantial likelihood of deception or confusion in consequence of the use of his proposed mark, notwithstanding that the descriptions of goods are different. The burden rests upon him of establishing that there will be no real risk of confusion and, if he leaves the matter in doubt, his application must be refused. Further, it is not enough for him to negative the likelihood of confusion in relation to the actual trade carried on by the opponent at the time of registration and to the manner in which the latter then uses his mark. The applicant must also take into account all legitimate uses which

the opponent may reasonably make of his mark within the ambit of his registration. Conversely, he must exclude the possibility of future deceptive or confusing uses of the mark for which he is applying. But he is not bound to satisfy the Registrar that merely speculative and fanciful risks will not arise.

In the present case, I cannot think that any real possibility exists of any customer for " Dettol " being deceived or confused so that he is supplied with the wrong goods or is in any way misled or confused as to the nature or identity of the goods. There are, I think, only two ways in which the appellants can put a plausible case of apprehended danger. The first consists in the suggestion that the similarity of " Dekol " to " Dettol " might lead the public to suppose that the proprietors of " Dettol " had turned their attention to preservatives for wood or canvas and were putting out a new product destructive of the bacterial or other microscopic life that attacks such material.

The second rests on the supposition that, as the appellants' mark is registered generally in respect of disinfectants and germicides, they may some day desire to extend its application to some products, germicidal in character, for the protection of wood, canvas, or the like. Stated from another point of view, this means that, as the appellants are entitled to use their mark for any product within the scope of the registration, the respondent may not bring into that area likelihood of confusion, should the appellants choose to extend the exercise of their exclusive right.

To my mind, the first of these suggestions of danger is not real, substantial, or practical. The goods are so remote from one another, the diversity between them is great and the trade in them is so entirely unconnected, that it is impossible to suppose that anyone would form the idea that the proprietors of " Dettol " had anything to do with oils or paints for preserving wood in respect of which the word " Dekol " is or may be used.

The second of the foregoing grounds for apprehending possible confusion appears to me to place too great a strain on the word " germicides " in the description of the goods in respect of which the appellants' " Dettol " mark is registered. The word does not refer to the destruction of micro-organisms of any kind throughout the natural order. It is plainly used in its ordinary meaning, viz., that which is destructive of micro-organisms associated with disease. The word " disinfectants " is still less appropriate to wood preserving oils or paints. I take the word in the appellants' registration to refer to chemical agents for the prevention or the arrest of the spread

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of infections or infectious diseases by the destruction of micro-organisms and perhaps to chemical agents for dealing with odours.

To suppose that, under the registration, the appellants might embark on the production of any preparations serving the same purpose as the respondent's "Dekol," or enter the same commercial field, appears to me not only unreal and fanciful, but to involve a use of the mark for goods outside any to which it might fairly be applied.

Giving full weight to the similarities of the words "Dekol" and "Dettol" and to the necessity of the applicant's establishing the absence of all reasonable likelihood of confusion, I, nevertheless, agree with the Deputy Registrar in thinking that the respondent makes out his case. The Deputy Registrar has, I think, exercised a sound discretion in registering the respondent's mark.

Although it relates only to a matter of prejudice, I may perhaps add that I can see no reason to doubt the statement of the respondent's predecessor in title that the word "Dekol" was made up of the first syllable of "decay" and of the termination "ol," regarded as representing "oil," and I do not think that there is any ground for suspicion that he had the word "Dettol" in mind.

I think that the appeal should be dismissed.

McTIERNAN J. In my opinion the appeal should be dismissed. I agree with the reasons of my brother *Dixon*.

WILLIAMS J. This is an appeal under s. 45 of the *Trade Marks Act* 1905-1936 from a decision of the Deputy Registrar of Trade Marks to accept an application by the respondent to register the word "Dekol" in class 1 in respect of wood preserving oils and paints. The appellant, who opposed the application, is the registered proprietor under the Act of a trade mark dated 3rd August 1933 in class 2 in respect of disinfectants and germicides which consists of the word "Dettol" prominently displayed at right angles across a sword, the word and the sword being superimposed upon a black disc-shaped background.

The material sections of the Act are ss. 25 and 114. They are in the following terms:—"25. Subject to this Act, the Registrar shall not register in respect of goods a trade mark identical with one belonging to a different proprietor which is already on the register in respect of the same goods or description of goods or so nearly resembling such a trade mark as to be likely to deceive." "114. No scandalous design, and no mark the use of which would by reason of its being likely to deceive or otherwise be deemed disentitled to

protection in a court of justice, or the use of which would be contrary to law or morality, shall be used or registered as a trade mark or part of a trade mark."

The principles which should be applied in deciding whether a mark is entitled to registration have been stated in many cases. They have been conveniently summarized by *Morton* J. in a recent case, *In re Hack's Application* (1) :—" In the first place, the onus is on the Applicant to satisfy the Court that there is no reasonable probability of confusion. In the second place . . . the rights of the party or parties are to be determined as at the date of the application for registration. In the third place, the onus . . . must be discharged by the Applicant in respect of all the goods coming within the specification of goods for which the application is made and not only in respect of any particular article coming within such specification in respect of which the Applicant has in fact used or proposes to use the mark. In the fourth place, the effect on the public of the use of any particular get-up or mode of presentation of the product is not the question which has to be determined by the Court upon the application. The true test is whether the use of the mark by itself, in any manner which can be regarded as a fair use of it, will be calculated to deceive or cause confusion. . . . In the fifth place, the question whether a particular mark is calculated " (in s. 114 of our Act the word is " likely ") " to deceive or cause confusion is not the same as the question whether the use of the mark will lead to passing-off. The mark must be held to offend against the provisions of s. 11 if it is likely to cause confusion or deception in the minds of persons to whom the mark is addressed, even if actual purchasers will not ultimately be deceived."

The appellant's and the respondent's goods are both chemical products, but whereas " Dettol " is manufactured and sold for use as an antiseptic and disinfectant, " Dekol " is manufactured and sold for use as a paint to preserve wood and canvas against, *inter alia*, the ravages of white ants, borer, dry rot and mildew.

The appellant's goods are mainly sold in bottles, but they are also sold in rectangular tins which hold up to five gallons. They are usually sold by chemists but, in some parts of Australia (apparently where there are no chemists), they are also sold by retail stores. In the large tins, the whole of the trade mark is not reproduced, but only the word " Dettol ", and the appellant has laid such particular emphasis on the word " Dettol " in its advertising, which has been very extensive, that it can claim, I think, that its

(1) (1940) 58 R.P.C. 91, at pp. 103, 104.

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products have become widely and favourably known to the Australian public under that name. The respondent's paint is put up in round and rectangular tins and sold, *inter alia*, to retail stores, but in those stores in which both the appellant's and the respondent's goods are sold they would be offered in different departments. There is also a marked difference in the appearance and smell of the two liquids and in the prices of the goods, and I agree with the finding of the Deputy Registrar that the goods are not of the same description within the meaning of s. 25.

But the appellant relies on s. 114 of the Act. It must be remembered that, in comparing the two marks in order to determine whether there is any reasonable likelihood of deception, it is the person who only knows one of them and has perhaps an imperfect recollection of it who is likely to be confused. Little assistance is to be obtained from a meticulous comparison of words, letter by letter, and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution, so that the Court must be careful to make an allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants: *Aristoc Ltd.* v. *Rysta Ltd.* (1). "Dettol" and "Dekol" are almost identical in spelling and sound. To the eye and ear of such a person there could clearly be a resemblance between the two words in appearance and in pronunciation. An applicant who has to displace the inference to be drawn from such facts, as Viscount *Cave* L.C. said in *McDowell's Application* (2), "starts with a somewhat heavy burden." If the goods were of the same description, there could be no doubt that there would be a reasonable likelihood of deception, and the question is whether the dissimilarities already mentioned are sufficient to remove that likelihood. As the opposing goods are sold at the present time, the risk of confusion may be small, and the prospects of success in a passing-off suit brought by the appellant against the respondent remote, but, as *Morton* J. pointed out in *In re Hack's Application* (3), that is not the question. The question, as he said in his fourth proposition, is whether the use of the mark in any way that it can be used as a mark would be likely to deceive. This proposition is evidently based on the statement of the Master of the Rolls in *In re Boots Pure Drug Co. Ltd.'s Trade Mark "Livron"* (4). It is not a big step for a manufacturer of chemical goods having

(1) (1945) A.C. 68, at p. 86.
(2) (1927) A.C., at p. 638; 44 R.P.C., at p. 341.
(3) (1940) 58 R.P.C., at pp. 103, 104.
(4) (1937) 54 R.P.C. 327, at p. 338.

antiseptic and disinfectant qualities to commence to manufacture chemical goods having preserving and disinfectant qualities in relation to wood and canvas. There could be more resemblances, I should think, between the appearance and smell of some disinfectants and germicides and some preserving oils and paints than those existing between the appellant's present goods and those of the respondent. It must be contemplated that if "Dekol" is registered, one or both manufacturers may in the future sell their goods under their trade marks without any reference to their names. Even in existing circumstances there is a likelihood, to my mind, that members of the public who had an imperfect recollection of the word "Dettol" and believed that "Dekol" was the same word would reasonably believe that the respondent's goods were manufactured by the appellant and, in the other circumstances which I have mentioned, the existence of which must be contemplated, that likelihood would increase.

The Deputy Registrar has decided that, in all the circumstances, there would be no such likelihood, and I must give weight to the conclusion of such an experienced officer, but s. 44 (2) requires the Court to determine for itself whether the application ought to be refused or granted, so that the Court must exercise its own discretion: *Jafferjee* v. *Scarlett* (1). In the present case, to use the words of Viscount *Cave* L.C. in *McDowell's Application* (2), the burden which lies upon an applicant of proving that there is no reasonable probability of deception is, to my mind, incomplete. The matter is, therefore, as Lord *Watson* said in *Eno* v. *Dunn* (3), left *in dubio*, and the application should have been refused.

For these reasons, I would allow the appeal.

Appeal dismissed with costs.

Solicitors for the appellant, *Robert Burge & Co.*
Solicitor for the respondent, *J. R. Thomas.*

J. B.

(1) (1937) 57 C.L.R. 115.
(2) (1927) A.C., at p. 638; 44 R.P.C., at p. 341.
(3) (1890) 15 App. Cas., at p. 259.