

**HIGH COURT OF FIJI**

**JAPAN TOBACCO INC**

v

**ADMINISTRATOR-GENERAL**

[HIGH COURT, 1992 (Byrne J) 20 February]

Civil Jurisdiction

*Trade Marks - whether proposed trade mark deceptive, contrary to morality and offensive - Trade Marks Act (Cap 240) Ss 8, 10.*

On appeal against a refusal by the Administrator-General to register a tobacco products trade mark the High Court HELD: that the use of an apparently Christian symbol for such trade purposes was both immoral and deceptive.

Cases cited:

*Madame Trade Mark* (1966) RPC 541

*Re Hallelujah Trade Mark* (1976) RPC 605

*Re Pruriderm Trade Mark* (1985) RPC (No. 8) 187

Appeal to the High Court from decision of the Administrator-General.

*J.G. Singh* for the Appellant

*G.E. Leung* for the Respondent

**Byrne J:**

This is an Appeal against the ruling of the Administrator-General handed down on 1st of February 1989 refusing the registration of a Trade Mark filed for registration by Japan Tobacco Inc. under classification 45 of the Trade Marks Act Cap. 240 being those types of Trade Mark which may be registered in Fiji under Section 8 of the Act. The Trade Mark in issue is a combination of device and word. The device is of a bird claimed by the Respondent to be a dove but alleged by the Appellant to be "not a conventional dove, more a gannet or bittern or shag". Having studied the device closely I am of the view that it bears more resemblance to that of a dove than a bittern or shag. Certainly the bird bears in its beak a branch with three leaves and although it is facing downwards I am satisfied, as the Administrator-General obviously was, that the ordinary reasonable person in the community would consider the bird to be a dove bearing a branch which seems to have a distinct resemblance, to that of an olive tree. Below the device appears the word PEACE in bold capital letters but not in any stylised form.

The application for registration of the mark was accepted under Section 11(2) of the Trade Marks Act on the 31st of October 1986, duly advertised in the Fiji Royal Gazette on the 5th of December 1986 and in the Fiji Times on the 12<sup>th</sup> of November 1986.

After being advertised objections were called for from persons interested to the registration of the Trade Mark pursuant to Section 13 of the Act. Two objectors being the General Secretary of the Pacific Conference of Churches and the Session Clerk of St. Andrew's Presbyterian Church Suva lodged notice of their objections with the Administrator-General on the 12th and 18th of November 1986.

Despite the fact that the objections were not in the form prescribed by the Trade Marks Act and both were outside the prescribed three months period provided by the Act the Administrator-General allowed the objectors to tender their objections and to be heard if they wished at the hearing of the application.

Both of the objectors based their opposition to the registration of the Trade Mark on the ground that the device represented in the proposed Trade Mark was the Christian symbol for the Holy Spirit and for peace. It was submitted that to use this symbol for a commercial purpose, namely the advertising of tobacco and tobacco products such as proposed by the Appellant for cigarettes, would be highly demeaning of this Christian symbol. It was also alleged in passing but not developed in any argument that the mark was immoral.

The Appellant on the other hand had prepared a counter-statement as required for a hearing before the Administrator-General wherein it presented five different grounds why registration should be granted. These were:

- (1) The mark applied for is distinctive of the Appellant's goods or at least capable of distinguishing those goods within the meaning of Trade Marks Act.
- (2) The mark applied for is not likely to deceive or cause confusion nor is it a mark which is disentitled to production within the meaning of the Trade Marks Act.
- (3) It is denied that the mark applied for contains any religious symbol. It is submitted that the objectors do not have any monopoly to the use of symbols of this nature which are used by many other organisations and commercial entities.
- (4) The mark applied for has been used and registered extensively in many countries throughout the world.
- (5) The mark applied for has no obvious association with any church or religious bodies or with Christianity and is not contrary to morality.

The Administrator-General held the mark to be distinctive and thus complied with Section 8 of the Act.

The Administrator-General however looked at Section 10 of the Act which places certain further restrictions on the registration of trade marks and considered whether registration would be contrary to morality within the meaning of Section 10. He appears to have been satisfied that the mark was not calculated to deceive, as to which I shall say more later, or to be scandalous as to which I shall also say something later.

It is convenient to set out Section 10 here. It is quite brief and reads thus:

"It shall not be lawful to register as a trade-mark or part of a trade-mark any matter the use of which would be reason of its being calculated to deceive or otherwise, be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design."

It is common ground that the proposed Trade Mark has never previously been registered in Fiji. It is also clear and not disputed that the Administrator's reasons for refusing to register the mark are contained in the last three paragraphs of his ruling and because they are brief I shall now set them out here:

"The device of the dove bearing a branch I find as fact has been in use in Christendom since the birth of Christianity. It is the Christians' symbol of the Holy Spirit, of God's covenant with man and of peace and goodwill. The device when used for commercial purposes such as proposed by the applicant for tobacco and tobacco products is morally offensive to Christians. It demeans and breaches the high Christian purpose represented by the symbol.

In my view, it would be wrong morally that the dove and the branch be used for commercial items such as proposed by the applicant.

The application is therefore refused and I make no order as to costs."

It is submitted that in these last paragraphs the Administrator erred in making his ruling.

The objector was a member of a small church in Fiji, St. Andrew's. Prior to the hearing the Pacific Conference of Churches had circularised all the Christian churches in Fiji in a letter dated the 12th of November 1986 urging them to object to the registration of the Trade Mark on the grounds eventually found by the Administrator-General. The Appellant makes much of the fact that only the Pacific Conference of Churches and St. Andrew's Presbyterian Church responded or objected to the application. However I do not hold this a valid objection to the ruling. It may be that the other Christian churches were content to leave any opposition to the Pacific Conference and not by so doing intending to indicate any lack of interest in the application or any lack of offence by the proposed mark. Whatever reasons they may have had for not joining physically in opposition to registration would be to indulge in speculation and would not assist me in deciding this appeal.

In his submission to this Court the Administrator-General remarked that the Appellant's counsel had argued time and again at the hearing that a similar trade mark had been registered in the United Kingdom, Jamaica, Hong Kong, the United States of America and Australia. In his submission to me on the appeal counsel added to these countries France and Italy all of which he says are hardly non-Christian countries. I find this argument unconvincing. It has repeatedly been held by the Courts in England that the fact that similar marks were registered in England or else where does not necessarily or automatically make another similar mark registerable. In Re Pruriderm Trade Mark (1985) R.P.C (No. 8) 187 at 189, it was held that:

(1) *ex parte* treatment of an application for registration does not fortify the Applicant's when formal opposition proceedings are set in train; and

(2) while the Registrar cannot fail to understand the need for consistency in his handling of applications, he has to decide each case on its own facts and merits.

In Madame Trade Mark (1966) R.P.C. 541 G.W. Tookey, Q. C. sitting as the Board of Trade said at 545, line 34:

"Although uniformity of treatment is of course desirable as far as possible where examination of applications is concerned, I agree with the Registrar that each application must be dealt with on its merits."

Consequently I hold that the fact that similar marks were registered abroad is irrelevant to this application. It is what may be regarded as contrary to morality or deceptive in Fiji which matters.

The word "morality" is not defined in the Act but the Administrator-General quoted the meaning given to the word "moral" in Webster's New Encyclopaedia Dictionary as "concerned with the principles of right and wrong in conduct and character; teaching or upholding standards of good behaviour confirming to the rules of right conduct ..." A broadly similar meaning is given in the Shorter Oxford English Dictionary.

Generally I concur with the findings of the Administrator-General but would take the matter further by reference to the Oxford Dictionary of the Christian Church wherein it is said that use of the Dove and Leaf symbol as applied either to the Church - e.g. by Tertulian, St. Ambrose and St. Augustine or to the individual soul regenerated by baptism denotes certain Christian virtues, such as purity and humility.

The symbol also forms part of the universal flag of the United Nations - a body looked upon, consciously or unconsciously by the peoples of the world, as a doer of good.

The word 'PEACE' suggests freedom from fear or worry. I find both the symbol and the word 'PEACE' when related to the advertising of a known carcinogenic, such as tobacco, to be deceptive in that, for the reasons given above, it gives forth a subliminal message that only good can come from the use of this product. It would appear to create in the unconscious mind of the user a false sense of safety from the medically acknowledged dangers of cigarette smoking.

In my judgment therefore, had he been so minded, the Administrator-General could also have found that the proposed trade-mark was calculated to deceive.

I would also say that in my view it may have been possible to argue also that the proposed trade-mark was scandalous, being of the nature of or causing an occasion of offence, to quote the Shorter Oxford English Dictionary meaning of the word. However apparently no argument was addressed to the Administrator-General on this point and so I say nothing more about it.

Finally in upholding the Administrator-General's decision I think I can take judicial notice of the fact that a not insubstantial portion of Fiji's population is Christian-orientated in belief and life-style. In Re Hallelujah Trade Mark (1976) R.P.C. 605 a company sought registration of the word 'HALLELUJAH' in respect of clothes for women. It was held that registration

should be refused, *inter alia* in the exercise of the Registrar's discretion as it would offend the religious susceptibilities of a not insubstantial number of persons.

In the instant case I am not persuaded that similar offence would not be given in Fiji if this trade mark were registered. For this reason and the other reasons I have given I therefore dismiss the appeal. The Appellant must pay the Respondent's costs.

*(Appeal dismissed.)*