

H. C. OF A. *Trade-Marks* (1); *Kerly on Trade Marks*, 6th ed., (1927), p. 73).
 1948-1949. There are somewhat similar provisions in the *Patents Act* 1903-
 1946: see ss. 53, 54, 59, 121; *R. v. Commissioner of Patents*; *Ex*
 SHELL parte *Reid* (2) and *Tate v. Haskins* (3). The registrar is entitled
 CO. OF to have regard to previous refused applications: *Halsbury's Laws*
 AUSTRALIA of *England*, 2nd ed., vol. 32, p. 564, note (s). The practice in
 LTD. England in respect of these matters, being under a different statute,
 v. is not of any assistance to the court. The words "unless prescribed
 ROHM AND by the regulations" in s. 47 were intended for a purpose such as
 HAAS Co. that dealt with in reg. 32, namely, to provide that in certain circum-
 — stances the registrar need not register a mark even though the
 earlier portion of s. 47 has been complied with. It is well settled
 that failure to oppose does not deprive a person of his right to apply
 for rectification. There is a big distinction between marks being
 deceptively similar and marks being nearly identical (*Innes v.*
Lincoln Motor Co. (4)). The Court said that notwithstanding the
 observations of *Sargant J.* to the contrary in *In re Maeder's Trade*
Mark Application (5), it took the view that the two phrases
 "deceptively similar" and "nearly identical" were not the same.
 The view expressed by *Sargant J.* was, subject to some modification,
 approved in *In the Matter of an Application by Alex. Pirie and Sons*
Ltd. to Register a Trade Mark (6) and on appeal (7). If the Court
 is against the respondent on the other submissions but is satisfied
 that the two marks are nearly identical marks the Court should
 come to the conclusion that the order for rectification which has
 been made should stand because it was based upon a wrong decision
 of the registrar on this point and on his failure to confine his mind
 to the provisions of s. 27.

Wright (with him *Henchman*), for the Registrar of Trade Marks.
 In the circumstances, his decision being involved, and all the facts
 being before the Court, the registrar is of opinion that it would not
 be proper for him to take part in the argument. The registrar
 does desire to be present to assist the Court both in the public
 interest and in respect of technical matters which arise in trade
 mark and patent cases, but he submits that in the absence of any
 rule or regulation so providing he should not be joined as a party
 in proceedings of this nature.

(1) (1886) 32 Ch. D. 311, at pp. 317-319.

(2) (1915) 20 C.L.R. 261, at p. 265.

(3) (1935) 53 C.L.R. 594, at p. 610.

(4) (1921) 29 C.L.R. 277.

(5) (1916) 1 Ch. 304; (1915) 33 R.P.C. 77.

(6) (1932) 49 R.P.C. 195, at pp. 213, 215, 217.

(7) (1933) 50 R.P.C. 147, at p. 159.

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Sponder K.C., in reply. The court has jurisdiction under s. 71 to order the rectification of the register but upon an application for rectification it is not competent for the court to give a direction to the registrar under ss. 27, 28 and 29 (*Hansman v. Regal Shoe Co.* (1)). It is entirely beside the point whether the registrar, in the belief that he had an obligation, directed himself in respect of that. To ask this Court to construe the words "already on the register" in s. 25 as meaning "notionally on the register" is to ask this Court to legislate. Section 25 is directed to registered trade marks only (*Paine & Co. v. Daniell & Sons' Breweries, Ltd.* (2)). The natural meaning of those words is: "subject to this Act the registrar shall not register." Section 25 and s. 114 refer to the date of registration. *Re Peddie's Applications* (3) was wrongly decided. Decisions in respect of the provisions of s. 114 are: *In the Matter of an Application by Notox Ltd. for a Trade Mark* and *In the Matter of an Opposition by Inecto Inc.* (4); *Impex Electrical Ltd. v. Weinbaum* and *In the Matter of Trade Marks of Impex Electrical Ltd.* (5), and *In the Matter of an Application by Evans Sons Lescher & Webb Ltd. for the Registration of a Trade Mark* (6). Sections 38 and 42 support the view that the Act does not impose an obligation to dispose of an earlier application before dealing with a later application. Sections 41 and 46 of the *Patents Act* 1903-1946 contain specific provisions for searching prior applications but similar provisions do not appear in the *Trade Marks Act* and should not, in the circumstances, be implied.

Cur. adv. vult.

The following written judgments were delivered:—

LATHAM C.J. This is an appeal from an order of *Williams J.* directing that the trade mark "Ditrene" be expunged from the register of trade marks. The appellant, the Shell Company of Australia Ltd., is the registered proprietor under the *Trade Marks Act* 1905-1936 of the word "Ditrene" as a trade mark in respect of insecticides, fungicides or disinfectants. The application for registration was lodged on 19th June 1945. The documents placed before the Court show that the registrar, in considering whether he would accept the application for the registration of "Ditrene," took into consideration an application by the respondent company for the registration of "Dithane" which was then pending. The registrar was evidently of opinion that both trade marks could

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(1) (1912) 15 C.L.R. 529.

(2) (1893) 10 R.P.C., at p. 232.

(3) (1943) 61 R.P.C. 31.

(4) (1930) 48 R.P.C. 168.

(5) (1927) 44 R.P.C. 405, at p. 410.

(6) (1934) 51 R.P.C. 423.

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properly be registered and that there was not such a resemblance between "Ditrene" and "Dithane" as to be likely to deceive. The respondent company did not oppose the registration of "Ditrene." The application for "Ditrene" was accepted on 4th April 1946. After advertisement there was no opposition and the trade mark was registered on 4th October 1946.

The respondent company, Rohm & Haas Co., had applied on 20th April 1945 for registration of the word "Dithane" as a trade mark in respect of the same class as that in respect of which "Ditrene" has been registered. This application was therefore made before the application of the Shell Co. The application was accepted and advertized and the Shell Co. lodged a notice of opposition. The opposition proceedings have not yet been determined.

On 22nd March 1948, Rohm & Haas Co. instituted proceedings to expunge the entry of "Ditrene" from the register. The proceedings were taken by virtue of s. 71 (1) of the *Trade Marks Act* 1905-1936, which provides, *inter alia*, as follows :—" Subject to this Act, the Court, on the application of any person aggrieved or of the Registrar, may order the rectification of the register by— . . . (b) the expunging of any entry wrongly made in or remaining on the register ; ".

Williams J. held that Rohm & Haas Co. was an aggrieved person within the meaning of s. 71 (1) and that the mark "Ditrene" did so resemble the mark "Dithane" as to be likely to deceive, thus taking upon this matter a different view from that which had commended itself to the registrar. His Honour decided that the registrar was under a duty to deal with applications in the order of their date, and that he should have determined the earlier "Dithane" application before determining the later "Ditrene" application. It was therefore held that he acted wrongly in granting registration of "Ditrene" and that the mark "Ditrene" should be removed from the register.

Upon the appeal to this Court the Shell Co. did not challenge either the decision that Rohm & Haas Co. was an aggrieved person within the meaning of s. 71 or the conclusion reached by the learned judge that "Ditrene" and "Dithane" were so similar that if both were registered and used there would be a likelihood of deception.

The appellant, however, relies on what is contended to be a complete compliance with the Act, and argues that there is no ground for erecting upon the basis of the clear provisions of the Act a series of implications as to some duty of the registrar with respect to the order in which he is to deal with applications. The word "Ditrene" is admittedly an invented word which is registrable

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as a trade mark—the Act, s. 16 (c). The application for registration of “Ditrene” was regular in all respects.

Section 25 of the Act provides as follows :—“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.”

As already stated, before he registered “Ditrene,” the registrar looked at and considered the application for the registration of “Dithane.” He granted registration to “Ditrene” because he was of opinion that there was no risk of confusion between the two marks. In this opinion he was wrong for the reasons stated by *Williams J.* The Shell Co., having succeeded in obtaining registration in the absence of opposition upon the basis of this opinion, now contends (as it is entitled to do) that there is a danger of confusion between the two marks and that, “Ditrene” being on the register, “Dithane” should not now be registered.

The Shell Co. contends that the registrar was not entitled to consider the application for the registration of “Dithane” when he was reaching a determination upon the application for “Ditrene” because “Dithane” was not, at the time of registration of “Ditrene,” namely 4th October 1946, a trade mark which was “already on the register.” Indeed, “Dithane” is not yet on the register. There is, it was submitted, nothing in the Act to require the registrar to consider other pending applications before dealing with any particular application.

The appellant refers to ss. 29 and 33, where there are also references to trade marks “already on the register.” Section 29, which deals with associated trade marks, deals with the case where application is made for the registration of a trade mark so nearly resembling a trade mark of the applicant which is already on the register as to be likely to deceive or cause confusion. Here the reference is plainly to trade marks which are already on the register. Section 33 (2) provides that applications are to be referred by the registrar to an examiner, who shall ascertain and report whether the trade mark is a registrable trade mark, and whether it is “identical with a trade mark already on the register under this Act. . . .” In this section the words “already on the register” should, it is argued, be construed as referring to trade marks which were in fact on the register when the examiner was performing his duty.

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So also, it is submitted for the appellant, in s. 25 the prov that the registrar shall not register a trade mark identical with already on the register must be understood as referring to 1 marks which actually are on the register when the registrar performing the act of registration (in this case on 4th October 1948) and not to applications for trade marks which might or might be successful. It must be conceded that if the registrar is required to consider all pending applications before he dealt with any particular application he would be considering applications some or all of which might never be granted. If, in order to induce some practical limitation, the suggested rule were stated as to restrict the required consideration of pending applications to those which the registrar thought were applications for somewhat similar marks which he probably would grant, it would mean that he would be considering groups of applications together and determining their chances of success—sometimes in the absence of evidence which might be adduced later. If, on the other hand, the words in s. 25 are given what is said to be their plain meaning, compares a trade mark for which application is made with, and only with, trade marks which are actually on the register, and does this (it is contended) at the time when he actually grants (or refuses) registration.

The Act contains no express provision requiring the registrar to deal with applications in order of their date. In my opinion it is difficult to imply such an obligation on the part of the registrar. If such a duty existed there would be a breach of duty if an application for a trade mark were dealt with out of turn and the consequence would be that the mark, if registered, would be wrongly registered so that it should be removed upon an application under s. 71—even though the mark was otherwise entitled to registration. It would not be reasonable to make an absolute implication requiring the registrar to deal with *all* applications in order of date, even though they related to entirely different subjects. But, if the rule were not absolute, it would not be easy to specify with precision what applications earlier in date the registrar must take into consideration and what applications he could properly ignore in dealing with any later particular application. The consideration of an early application might take a long time. If no later application, or no later application which was more or less in the same field (which would often be matter for argument) could be determined before all, or all relevant, earlier applications had been determined, great delay would often result. The recognition and application of any rule that all or some applications must be dealt with in order of date

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would, in my opinion, result in delay, confusion and uncertainty of title to trade marks. It is not necessary to make such an implication in order to give effect to any of the provisions of the Act. I can see no adequate ground for implying such a rule.

An application for registration of a trade mark may be made by any person claiming to be the proprietor of a trade mark (s. 32) and "trade mark" means a mark used "or proposed to be used" in connection with goods for the purposes mentioned in the definition of "trade mark" in s. 4. There are no provisions in the Commonwealth Act making registration or application for registration equivalent to user of a trade mark. Thus a mark may be registered as a trade mark though it has never been either actually or notionally used. This will often be the case when the trade mark applied for is an invented word. But, in my opinion, the application for registration in itself gives no rights to the applicant against any other person. If the application is successful, he obtains the rights of a registered proprietor, but not otherwise. His application may be abandoned or refused or successfully opposed. Until he succeeds in obtaining registration he is only a person "claiming" to be the proprietor of a mark. When and if he obtains registration, he acquires rights which date back to the date of his application (s. 47) but until he obtains registration he is, if he has not actually used his trade mark and thereby acquired rights, in the same position with respect to the mark as any other member of the public. He cannot prevent any other person using it unless and until he succeeds in an application for registration. If he so succeeds he has a remedy against any person who used it after the date of his application because s. 47 provides that the date of application shall be deemed to be the date of registration. But it is the granting of registration, and not the making of the application, which gives him for the first time a right to the exclusive use of the previously unused mark.

In my opinion s. 47 of the Act provides a solution of the difficulties which have arisen in this case. Section 47 is in the following terms:—"When an application for registration has been accepted and has not been opposed and the time for notice of opposition has expired, or has been opposed and has been granted, the Registrar unless otherwise prescribed by the regulations shall register the trade mark as on the date of the lodging of the application, which date shall be deemed to be the date of the registration, and shall issue to the applicant a certificate of registration of the trade mark in the prescribed form."

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