

IN THE SUPREME COURT OF THE DEMOCRATIC
SOCIALIST REPUBLIC OF SRI LANKA

M.S. Hebtulabhoy and Co. Ltd.,
No. 257, Grandpass Road,
Colombo 14.

Applicant-Respondent-Defendant-
Respondent-Appellant

SC APPEAL NO: SC/APPEAL/155/2012

CA NO: CA/APPEAL/286/1993(F)

DC COLOMBO NO: 3051/SPL

Vs.

1. Stassen Exports Ltd.,
No. 833, Sirimavo Bandaranaike
Mawatha, Colombo 14.

Opponent-Appellant-Plaintiff-
Petitioner-Respondent

2. Registrar of Patents and Trade
Marks,
No. 267, Union Place, Colombo 02.

Respondent-Defendant-
Respondent-Respondent

AND

1B. Ahmed Abu Baker Baeshen

1C. Mohamed Abdul Kader Baeshen

1D. Ahamed Abdul Kader Baeshen

All partners of Ahmed Mohamed
Saleh Baeshen and Company,
a limited liability partnership
existing under the laws of the
Kingdom of Saudi Arabia of

PO Box 18,
Al Dahab Street,
Jeddah 21411, Saudi Arabia.

Substituted Applicant-Respondent-
Defendant-Respondent-Appellants

Vs.

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No. 833, Sirimavo Bandaranaike
Mawatha, Colombo 14.
Opponent-Appellant-Plaintiff-
Petitioner-Respondent
2. Registrar of Patents and Trade
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Respondent-Defendant-
Respondent-Respondent

LATER

- 1B. i) Kalid Ahmed Abu Baker Abdullah
Baeshen
- ii) Osama Ahmed Abu Baker
Abdullah Baeshen

- iii) Sumaya Ahmed Abu Baker
Abdullah Baeshen
- iv) Sahar Ahmed Abu Baker Abdullah
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Mawatha, Colombo 14.

Opponent-Appellant-Plaintiff-
Respondent-Respondent-
Respondent

2. Director General of Intellectual
Property of Sri Lanka,
National Intellectual Property
Office, No. 400, D.R. Wijewardena
Mawatha, Colombo 10.

Formerly designated as and for the
successor to the Registrar of
Patents and Trade Marks,
No. 267, Union Place, Colombo 02.
Respondent-Defendant-
Respondent-Respondent-
Respondent

Before: Hon. Chief Justice Jayantha Jayasuriya, P.C.
Hon. Justice S. Thurairaja, P.C.
Hon. Justice Mahinda Samayawardhena

Counsel: Chandaka Jayasundere, P.C. with Vishmi Fernando for the
Applicant-Respondent-Defendant-Respondent-Appellant.
Nihal Fernando, P.C. with Harshula Seneviratne for the 1st
Respondent.
Yuresha De Silva, D.S.G., for the 2nd Respondent.

Written Submissions:

By the Applicant-Respondent-Defendant-Respondent-
Appellant on 22.10.2012

By the 1st Respondent on 17.10.2019

By the 2nd Respondent on 03.05.2023

Argued on: 11.12.2023

Further Written Submissions:

By the Applicant-Respondent-Defendant-Respondent-
Appellant on 16.02.2024

By the 1st Respondent on 09.02.2024

Decided on: 20.06.2024

Samayawardhena, J.

This is a Trade Mark dispute that arose and was decided by the Registrar of Patents and Trade Marks of Sri Lanka (the 2nd respondent), and subsequently on appeal by the District Court of Colombo when the Code of Intellectual Property Act, No. 52 of 1979 (the Act) was in force. Therefore, this appeal must be adjudicated in light of the provisions of that Act. According to section 97 of the Act, “Trade Mark” means any visible sign serving to distinguish the goods of one enterprise from those of another.

M.S. Hebtulabhoy & Co. Ltd. (the appellant) is the registered owner of the Trade Mark RABEA in Roman characters under Trade Mark No. 31953 in Class 30 in respect of Tea since 06.10.1969. The registered Mark was simply the word RABEA without any get-up or design.

On 30.05.1984, the appellant, in terms of section 102(1) of the Act, applied to the 2nd respondent for registration of the word RABEA in Roman characters, and the word RABEA in Arabic script written above it, to be associated with Trade Mark No. 31953, within a rectangle with a double line border, under Trade Mark No. 47706 in Class 30 in respect of Tea.

Sections 99 and 100 enumerate the grounds for refusal of registration of a Mark. The 2nd respondent, being of the opinion that the said Mark did not fall within the purview of sections 99 or 100, published it in the Gazette prior to its registration, as stipulated in section 107(9) of the Act.

In response to this publication, Stassen Exports Limited (the 1st respondent) tendered notice of opposition dated 19.06.1985, in terms of section 107(10) of the Act.

After inquiry, by order dated 28.12.1989, the 2nd respondent overruled the objections of the 1st respondent and decided to register the Trade Mark No. 47706 on the basis that the propounded Mark is distinctive.

On appeal by the 1st respondent in terms of section 182 of the Act, the District Court of Colombo, by judgment dated 22.02.1993, set aside the order of the 2nd respondent and refused registration of the appellant's Mark No. 47706.

Being dissatisfied, the appellant appealed to the Court of Appeal. The Court of Appeal dismissed the appeal by judgment dated 04.11.2011.

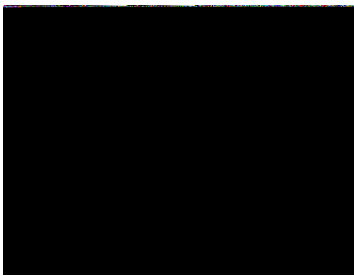
The appellant came before this Court against the judgment of the Court of Appeal. This Court granted special leave to appeal on three questions of law.

1. Did the Court of Appeal err in law by failing to appreciate the fact that the District Court commenced its order with a manifestly erroneous conclusion that RABEA is an English word and that the propounded Trade Mark set out a "purported translation of the said word in English and in Arabic"?
2. Did the Court of Appeal err in law by failing to appreciate that the transliteration of the word RABEA in the Roman script and/or the Arabic script was permissible in law and could not in any way

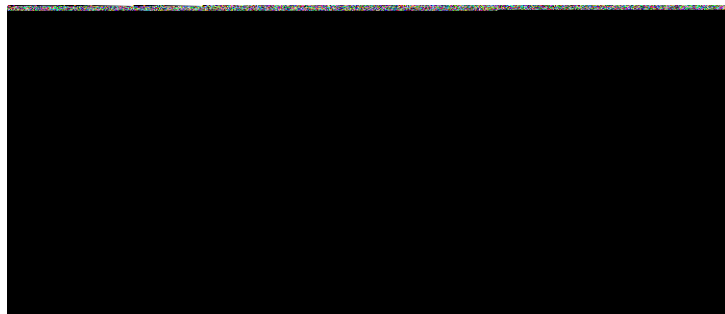
cause confusion with the English words SPRING BRAND which was the registered Trade Mark of the 1st respondent?

3. Did the Court of Appeal err in law by making a finding that the propounded Mark bore relevance to the Mark of the 1st respondent despite the fact that neither the SPRING BRAND Trade Mark nor a depiction thereof was before Court or available for inspection by Court?

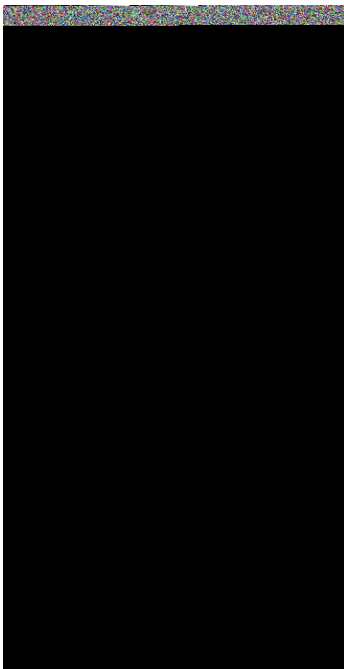
The four Trade Marks relevant to this appeal are as follows.



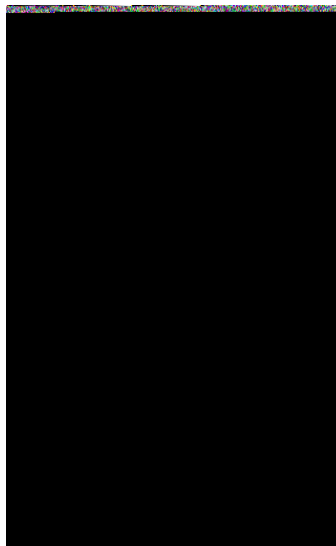
Trade Mark No. 31953



Trade Mark No. 40847



Trade Mark No. 40849



Trade Mark No. 47706

Let me now consider on what grounds the 1st respondent opposed the registration of the appellant's Mark No. 47706. I will consider them as submitted by the 1st respondent in the notice of opposition dated 19.06.1985 tendered to the 2nd respondent.

- 1. The propounded mark is identical or similar to or otherwise deceptively resembles Trade Mark No. 40847 dated 07.12.1979 registered by the opponent.*
- 2. The propounded mark is identical to or similar to or resembles the said Trade Mark No. 40847 and is sought to be registered in respect of the same class or description of goods as the said Trade Mark already in use by the opponent, and is likely to mislead and/or is calculated to deceive or cause confusion amongst the trade and the public.*

Although the 1st respondent's main ground of objection before the 2nd respondent was that the propounded Mark No. 47706 is identical to Trade Mark No. 40847 registered by the 1st respondent, it is clear that the 1st respondent did not pursue this purported main ground of objection, despite mentioning it in paragraph 5(a) and (b) of the plaint (the appeal) submitted to the District Court.

No submissions were made on behalf of the 1st respondent regarding Trade Mark No. 40847 before this Court either.

Let me now turn to paragraphs 3 and 4 of the notice of opposition. This is relevant to the 1st respondent's Trade Mark No. 40849.

- 3. The opponent has applied for registration of Trade Mark No. 40849 consisting, inter alia, of the name "Spring Brand" for tea in class 30 and the same was accepted for registration and published in Gazette No. 204 of 30th July 1972 and the said application is now pending.*

4. *The propounded mark has been advertised with the limitation, inter alia, that “the transliteration of the Arabic words appearing on the label is Rabea which means spring.” It is presumed that this representation has been made to the Registrar by the applicant. Even if the transliteration is assumed to be correct, then this establishes a surreptitious or devious attempt by the applicant to indirectly obtain registration of a mark similar to or deceptively resembling the opponent’s said Trade Mark No. 40849.*

According to paragraph 3 quoted above, Trade Mark No. 40849 was pending registration at the time of filing objections. In other words, when the 1st respondent opposed registration of the appellant’s propounded Trade Mark No. 47706, the 1st respondent’s Mark No. 40849 was not registered in the name of the 1st respondent. Although one does not necessarily need to be the registered owner to oppose, it is evident from the judgments of both Courts that they proceeded under the assumption that the 1st respondent was the registered owner of Trade Mark No. 40849 when the appellant applied for registration of Mark No. 47706.

It is of paramount importance to highlight that the 1st respondent did not tender Trade Mark No. 40847 or Trade Mark No. 40849 to the District Court or to the Court of Appeal or to this Court for inspection. Those Marks or any depiction thereof were not in the brief or in the original case record. It is at the end of the argument that His Lordship Hon. Chief Justice as the presiding Judge directed learned President’s Counsel for the 1st respondent to tender them to Court by way of a motion. To put it differently, not only did the District Court and the Court of Appeal proceed on the erroneous basis that the 1st respondent was the registered owner of Mark No. 40849 when the appellant applied for registration of Mark No. 47706, but both Courts also concluded that the appellant’s propounded Mark was misleadingly similar to the 1st respondent’s Mark

without even examining the 1st respondent's Marks. This goes to the root of the judgments of the District Court and the Court of Appeal, constituting a fundamental error that vitiates both judgments.

In *United Biscuits (U.K.) Limited v. Asda Stores Limited* [1997] RPC 513, issues of trademark infringement and passing off arose concerning two brands producing similar goods using the signs 'Penguin' by United Biscuits, the plaintiff, and Asda's 'Puffin', the defendant. In his judgment, Robert Walker, J. emphasised at pages 526 and 538 that in cases of trademark infringement and passing off, the judge must first form his own provisional view regarding the similarity of the goods or services in question. To do this, the Marks must be presented before the judge, and the judge must inspect them.

There is some authority that in a case of this sort a judge should, before having regard to the evidence of trade witnesses (and apart from factual evidence of actual confusion) form his own provisional view: see for instance the approach of Rattee J. in The European v. The Economist Newspapers [1996] F.S.R. 431, especially at pages 441-2 and 445. [Page 526]

In *M.S. Hebtulabhoy & Company Ltd v. Stassen Exports Ltd & Another* [1989] 1 Sri LR 182, Palakidnar J. stated at 188:

The question whether there is confusing similarity is primarily one for the Judges. Lord Evershed said that the Judge must make up his mind and not abdicate the decision in that matter to witnesses before him.

The Court of Appeal did not deal with the history of the case. The Court of Appeal, in the concluding part of the judgment, expressly states that the history of the Trade Marks relevant to this case is irrelevant. If the Court of Appeal looked at the history, especially the registration of Trade

Mark No. 31953 (RABEA) in the name of the appellant which happened more than 10 years before this dispute arose, it would have come to a different conclusion. The Court of Appeal states that the issue is not one of translation or transliteration of the word RABEA. The Court of Appeal does not deal with other legal arguments. The judgment of the Court of Appeal has been predominantly dedicated to discussing the tort of passing off, which was not, and which cannot be, the main argument of the 1st respondent. Simply stated, how could a Court rule on passing off or unfair competition without examining Trade Mark No. 40847 and Trade Mark No. 40849 of the 1st respondent alongside Trade Mark No. 31953 and Trade Mark No. 47706? It is not possible.

The 1st respondent in the above quoted paragraph 3 states that “*the name ‘Spring Brand’ for tea in class 30...was accepted for registration and published in Gazette No. 204 of 30th July 1972*”. This is also incorrect according to the Gazette tendered by the 1st respondent to this Court with Mark No. 40849. The relevant Gazette is No. 246 dated 20.05.1983, not No. 204 of 30.07.1972.

Although the 1st respondent stated in the notice of opposition “*The propounded mark [47706] is identical or similar to or otherwise deceptively resembles Trade Mark No. 40847 dated 07.12.1979 registered by the opponent*”, as reproduced at the beginning of this judgment, Trade Mark No. 40847 bears no resemblance whatsoever to the propounded Trade Mark No. 47706. The two Marks in Roman characters are completely different. The former is EL MAGHRABI whereas the latter is RABEA. There is no room whatsoever for any confusion in any respect. This may be the reason why the 1st respondent did not pursue this objection before the District Court or the Court of Appeal or this Court.

Trade Mark No. 47706 does not resemble or deceptively resemble Trade Mark No. 40849 either. The Trade Mark which the 1st respondent sought

to register was not merely the term “Spring Brand”. As reproduced at the beginning of this judgment, the Trade Mark No. 40849 is a complex one.

The learned District Judge has not understood the issue. This is evident by reading the following paragraph of the judgment, which the learned President’s Counsel for the 1st respondent has quoted in his post-argument written submission to resist the appeal.

On a perusal of the issues in the case one has to find out whether the words sought to be registered ‘RABEA’ is similar to plaintiff’s [the 1st respondent’s] registered name. In this respect, one can say that the mark sought to be registered is ‘RABEA’ and it is common ground that this plaintiff is the owner of the registered mark ‘SPRING BRAND’. Therefore, the registration of ‘SPRING BRAND’ in favour of the plaintiff will enable him to use the words ‘SPRING BRAND’. Even in its translated form in Arabic ‘SPRING BRAND’ means ‘RABEA’. The only conclusion that one can be drawn by this is that the plaintiff is entitled to use the translation of the words ‘SPRING BRAND’ which in turn means ‘RABEA’. The word ‘RABEA’ can be used by the plaintiff only. In the registration No. 40849 one cannot see any restriction or a limitation as far as the words ‘SPRING BRAND’ is concerned. If there is no limitation the word ‘SPRING’ can be used in a translated or transliterated form. When the ‘SPRING BRAND’ trade mark No. 40849 was advertised in the government gazette by the plaintiff, the defendant did not object to it and the trade mark ‘SPRING BRAND’ in registration No. 40849 was registered on 7th December 1979 long before the present application was made by the defendant.

If I take only this paragraph, there are several inaccuracies.

The learned District Judge states the Mark sought to be registered under Trade Mark No. 47706 by the appellant is RABEA and the 1st respondent is the owner of the Mark SPRING BRAND and SPRING BRAND in Arabic is RABEA.

I must reiterate that the District Judge has come to these findings of fact without examining the two Marks. In my view, without looking at the two Marks, it is impossible to come to accurate findings.

As previously mentioned, the appellant has been the owner of the Trade Mark RABEA since 06.10.1969 under Trade Mark No. 31953. The 1st respondent applied for the registration of his SPRING BRAND Mark No. 40849 on 07.12.1979 and it was gazetted on 20.05.1983. The appellant did not attempt to register the Mark RABEA for the first time on 30.05.1984 under Trade Mark No. 47706, as the District Judge states. What the appellant sought to do, 15 years after the registration of Trade Mark No. 31953, was to add the transliteration of the word RABEA in Arabic script above the already registered Mark RABEA, not the translation of the word RABEA.

Contrary to what the District Judge states, by the time the appellant made his application to register Trade Mark No. 47706, the 1st respondent's application to register Trade Mark No. 40849 (SPRING BRAND) was pending.

It is misleading to characterise the 1st respondent's Mark solely as SPRING BRAND. The English words SPRING BRAND found in the 1st respondent's Mark are not the only words present in the Mark.

The District Judge states there are no restrictions to the Mark SPRING BRAND and therefore the 1st respondent can use it in translated or transliterated form. He further states since "*in Arabic SPRING BRAND means RABEA*", "*The word RABEA can be used by the plaintiff [the 1st*

respondent/ only". This analysis is completely erroneous. RABEA is the registered Trade Mark of the appellant since 1969. The word RABEA can be used only by the appellant, not by the 1st respondent. The Arabic translation of the English term SPRING BRAND is not RABEA, although the Arabic translation of the English term SPRING (without BRAND) may be RABEA.

Had the learned District Judge looked at the Trade Mark No. 31953 tendered by the 1st respondent to the District Court, he would have realised that it was the first registered Trade Mark where the word RABEA is found.

It is also significant to note that the 2nd respondent in accepting Trade Mark No. 47706 for publication states "*This mark is associated with mark No. 31953*". Mark No. 31953 has been renewed for consecutive periods of 10 years as required by section 115 of the Act.

According to the Gazette, the appellant's propounded Mark No. 47706 has been accepted "*subjected to the condition that the mark will only be used as depicted in the application and that its translation in any language will not be used.*" It also states "*The transliteration of the Arabic words appearing on the label is 'Rabea' which means spring.*" What is prevented is the translation of the word RABEA, not transliteration. This was in line with section 100(1)(d) of Act No. 52 of 1979 (although the provisions of the new Act No. 36 of 2003 are different).

The appellant did not make an attempt to translate the word RABEA. The District Judge was wrong when he stated at page 9 of the judgment that "*T.M. 31953 sets a limitation in that it can be used only as depicted in the application and no translation or transliteration can be utilised.*"

The District Judge says when the 'SPRING BRAND' Trade Mark No. 40849 was advertised in the government Gazette by the 1st respondent,

the appellant did not object to it. First, the 2nd respondent accepted the Mark and decided to send it for publication. It appears that the appellant did not object to it, perhaps because they believed that both Marks could coexist—and rightly so. Merely because the appellant did not object to the 1st respondent's Mark No. 40849 does not mean that the appellant's Mark should be rejected. The District Judge has acknowledged this when he states, *"Anyway, the 1st respondent (now appellant) had not opposed the appellant's (now 1st respondent) said application No. 40849 as it did not consider the appellant's mark to resemble the 1st respondent's registration mark No. 31953 RABEA."*

Learned President's Counsel for the 1st respondent argues that *"if the propounded mark 47706 sought to be registered by the appellant is permitted to be registered it would in fact be permitting the appellant to register the translation of the respondent's registered trademark 'Spring' which will be a direct violation of the prohibition contained in section 100(1)(d) of the earlier Code and 104(1)(d) of the Intellectual Property Act No. 36 of 2003."* If this argument is valid, the first violation was committed by the 1st respondent when the 1st respondent applied to register the English translation of the appellant's registered Trade Mark RABEA, which is SPRING.

In any event, section 100(1)(d), as it stood, did not place a blanket prohibition even on translations of registered Marks. It only prohibited the registration of Marks that were translations of already registered Marks, provided such translations were "likely to mislead the public". Section 100(1)(d) read as follows:

*A mark shall not be registered which constitutes a reproduction in whole or in part, an imitation, translation or transcription, **likely to mislead the public**, of a mark or trade name which is well known in Sri Lanka and belongs to a third party.*

The 1st respondent in paragraphs 5-12 of his grounds of opposition mainly deals with unfair trade practices. It is the policy of the law to permit and encourage fair competition in trade while discouraging and preventing unfair competition. Fair competition benefits consumers by promoting innovation, improving product quality, and keeping prices competitive. Unfair competition, on the other hand, misleads consumers and undermines these principles. On the facts and circumstances of this case, the appellant did not engage in unfair trade practices. The appellant was not attempting to piggyback on the 1st respondent's Mark; *vice versa*, however, might be possible.

The District Judge at page 8 of the judgment states the 1st respondent “*has been using the unregistered mark SHAI EL RABEA in Arabic and its translation therein SPRING TIME TEA.*” If that is correct, it appears to me that it might be a violation of the appellant's registered Trade Mark RABEA for Tea. Section 142(1) of Act No. 52 of 1979 enacted “*Any act of competition contrary to honest practices in industrial or commercial matters shall constitute an act of unfair competition.*”

There is no universally applicable formula for evaluating the similarity of marks. Facts differ from case to case, so does the weight to be attached to such facts.

In L. Bently and B. Sherman, *Intellectual Property Law* (3rd edn, 2009) page 761 state:

It is important to note that the approach adopted by the courts in deciding whether the signs are similar always depends on the facts in hand. As such, the points below should be treated as providing no more than general guidance. In deciding whether two signs are similar enough to cause confusion, the marks are rarely looked at side-by-side. Instead, the courts tend to ask the hypothetical

question: if a person saw the signs separately, would they mistake the defendant's product for that of the claimant's? When deciding whether signs are similar, the courts also tend to look at the signs as a whole and in the context in which they are used.

It is in that context Laddie J. in *Wagamama Ltd v. City Centre Restaurants PLC* [1995] FSR 713 at 732 remarked, “*Whether there has been trade mark infringement is more a matter of feel than science.*”

Nevertheless, in order to assess similarity of the Marks, the tests of visual similarity and phonetic similarity are widely recognised and commonly employed across the board.

In *Sabel v. Puma* [1997] ECR I-6191, the European Court of Justice was called upon to apply Article 4(1)(b) of the First Council Directive 89/104/EEC of 21 December 1988 in adjudicating a dispute related to the registration of Trade Marks. Article 4(1)(b) provided that “*A trade mark shall not be registered or, if registered, shall be liable to be declared invalid: (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark*”. In doing so, the Court in considering how Trade Marks should be evaluated noted as follows:

22. As pointed out in paragraph 18 of this judgment, Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of

the degree of similarity between the trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

23. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive – ‘...there exists a likelihood of confusion on the part of the public...’ – shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

It is undisputed that there is no visual similarity between the two Marks; there is no likelihood of misleading the public in that respect when Trade Mark No. 47706 of the appellant is presented or compared with Trade Mark No. 40849 of the 1st respondent.

There is no phonetic/aural similarity between the two Marks: one is RABEA and the other is SPRING BRAND. There is no likelihood of confusion among consumers in that respect either.

The argument of the 1st respondent seems to be that when the Arabic script of RABEA is translated into English in the mind of a consumer, there might be confusion regarding the source of the goods because “RABEA” means “spring”. However, for this argument to succeed, the consumer would need to know both Arabic and English. There is no evidence that the targeted group is conversant in both Arabic and

English. Typically, consumers perceive a mark as a whole rather than analysing its individual components.

Although the District Judge starts the judgment by stating that RABEA is an English word, it is not an English word. Then he says “RABEA is an Arabic word”, which is also not correct. When transliterated into Arabic, “RABEA” is said to mean “spring”.

The 1st respondent in paragraph 5 of his grounds of opposition states *“The English word for the Muslim spring is Rabia and not Rabea.”* This raises the question whether the 1st respondent is not fully prepared to accept that “RABEA” means “spring” in the Arabic script.

I cannot resist re-emphasising that Mark No. 47706 is not the verbatim English translation of Mark No. 40849. The Mark No. 40849 does not solely constitute the English word SPRING or SPRING BRAND. It constitutes at least of 20 English words and a large picture of a flower. Mark No. 47706 has only two words, neither of which are English words; one is in Roman characters and the other is in Arabic characters.

On the facts and circumstances of this case, the 2nd respondent was correct when he concluded that the two Marks – No. 40849 of the 1st respondent and No. 47706 of the appellant – are distinctive.

I answer the three questions of law in the affirmative.

The judgments of the District Court and the Court of Appeal are set aside and the order of the 2nd respondent dated 28.12.1989 is restored. Although the 2nd respondent has not given adequate reasons for his decision, I agree with his conclusion.

The present appellants are entitled to recover all incurred costs in all four Tribunals/Courts (Intellectual Property Office, District Court, Court of Appeal and the Supreme Court) from the 1st respondent.

Judge of the Supreme Court

Jayantha Jayasuriya, P.C., C.J.

I agree.

Chief Justice

Thurairaja, P.C., J.

I agree.

Judge of the Supreme Court