

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

CURZON TOBACCO COMPANY LIMITED,

Applicant,

and

THE REPUBLIC OF CYPRUS, THROUGH
THE OFFICIAL RECEIVER AND REGISTRAR IN HIS
CAPACITY AS REGISTRAR OF TRADE MARKS,

Respondent.

(Case No. 92/73).

Trade Marks—Registration—Revocation of registration accepted in the first instance and without opposition by third parties—Possible if application has been accepted in error—Section 21 (1) of the Trade Marks Law, Cap. 268 and rule 53 of the Trade Marks Rules, 1951.

Trade Marks—Registrability—Invented word—"Premier"—Foreign word—Cannot merely by reason thereof be considered as an invented word—Application for registration of word "Premier" in respect of cigarettes, cigars and tobacco products—Having regard to the meanings of the word it cannot be said that it has no direct reference to the character and quality of the goods—Section 11 (1) (c) and (d) of the Trade Marks Law, Cap. 268.

Administrative Law—Revocation of administrative decision—Open to Registrar of Trade Marks to withdraw his acceptance to registration of trade marks if acceptance had been made in error—Section 21 (1) of the Trade Marks Law, Cap. 268.

The applicant challenges the validity of the decision of the Registrar of Trade Marks, dated 26th February, 1973, whereby he revoked his own earlier decision, taken after hearing the applicants, to accept registration of the word "Premier" without the said decision having been objected to or challenged by anybody.

It was contended on behalf of the applicants that:

(a) Under the provisions of s. 21 (1) of the Trade Marks Law, Cap. 268 it was not open to the Registrar to

withdraw his acceptance, because at the hearing he had agreed to register the mark in part B of the register and informed applicant's counsel accordingly.

- (b) The Registrar's decision is contrary to the principles of administrative Law. 5
- (c) The word "Premier" is registrable under the provisions of s. 11 (1) of Cap. 268.

Held, (1) It is quite apparent from the wording of section 21 (1) that the Registrar has power to refuse registration even though the application has been accepted in the first instance and there has been no opposition to the registration if such application has been accepted in error. (See, also, rule 53 of the Trade Marks Rules, 1951). 10

(2) (a) Regarding the issue of registrability this application could only be considered under paragraphs (c) and (d) of s. 11 (1) of Cap. 268. 15

(2) (b) As to paragraph (c) of s. 11 (1) it is impossible to suggest that the word "Premier" is an invented word in the sense that it is "new and freshly coined" as very aptly described by Lord Macnaghten in the "*Solio*" case [1898] A.C. 571. It is a word in ordinary and common use and is to be found in any English or French dictionary; and there is ample authority in support of the proposition that a foreign word cannot merely by reason thereof be considered an invented word. 20

(2) (c) Regarding paragraph (d) of s. 11 (1) Cap. 268 I agree with the submission of counsel for the respondent that having regard to the meanings of the word it cannot be said that it has no direct reference to the character and quality of the goods. 25

Application dismissed. 30

Cases referred to:

"*Solio*" case (*Eastman Photographic Materials Co. Ltd. and The Comptroller-General of Patents, Designs and Trade Marks* [1898] A.C. 571.

Recourse. 35

Recourse against the decision of the respondent dated 26th February, 1973, whereby he revoked his earlier decision to

accept registration of the word "Premier", without the said decision having been objected to or challenged by anybody.

A. *Emilianides* with *E. Emilianides*, for the applicant.

R. *Gavrielides*, Counsel of the Republic, for the respondent.

5 *Cur. adv. vult.*

The facts sufficiently appear in the judgment* of the Court deliberated by:-

10 L. LOIZOU, J.: By the present recourse the applicant challenges the validity of the decision of the Registrar of Trade Marks dated 26th February, 1973, whereby he revoked his own earlier decision, taken after hearing the applicants, to accept registration of the word "Premier" without the said decision having been objected to or challenged by anybody.

The facts of the case are briefly as follows:

15 The applicant is a tobacco company registered in Montreal in the province of Quebec in Canada.

20 In August, 1971, the applicant applied to the Registrar of Trade Marks for the registration of the word "Premier" in respect of cigarettes, cigars and tobacco products. By letter dated the 1st September, 1971, the respondent informed the applicant that his application could not be accepted on the ground that the proposed trade mark (a) had a direct reference to the character and quality of the goods and (b) was devoid of any distinctive character and also on the ground that it
25 offended against the provisions of section 13 of the Trade Marks Law, Cap. 268. Thereupon applicant's counsel requested an interview with the respondent in order to discuss the matter. After a hearing which was concluded on the 13th March, 1971, the respondent informed the applicant, through
30 his counsel, by letter dated 27th March, 1972 (*exhibit 2*) that the proposed trade mark was accepted for registration in part B of the Register and in consequence the application was duly published in Supplement No. 5 to the Gazette of the 25th August, 1972.

35 On the 9th December, 1972, the Registrar informed applicant's counsel by his letter *exhibit 3* that after further consideration of the matter he had decided to withdraw his acceptance of

* An appeal has been lodged against this judgment. The appeal has been heard and judgment thereon has been reserved.

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the application for registration of the trade mark in question on the ground that it had been accepted in error and advised him to proceed under rule 32 of the Trade Marks Rules 1951. This rule reads as follows:

“ 32. If the Registrar objects to the application, he shall inform the applicant of his objections in writing, and unless within two months applicant applies for a hearing or makes a considered reply in writing to those objections he shall be deemed to have withdrawn his application”. 5

It would appear that the applicant requested the respondent for further particulars for his decision to withdraw his acceptance of the application and in reply the Registrar wrote to applicant's counsel the letter *exhibit* 4 which is dated 29th December, 1972, and reads as follows: 10

“ I have to refer to your letters of the 15th and 18th December, 1972 and to inform you that the acceptance of the mark has been withdrawn in view of the following meanings of the word PREMIER which were overlooked at the time of the examination of the application: 15

“ 1) *Webster's New International Dictionary Premier* – First in position, rank or importance. Chief, principal, leading. 20

2) *Oxford's Dictionary Premier* – First in position, importance, or rank; Chief, leading, foremost.

3) *French Dictionary Premier, -éere* – First”. 25

Later on the applicant, pursuant to the provisions of rule 32 applied for a hearing. The hearing took place on the 26th February, 1973; copy of the notes kept at the hearing and of the Registrar's decision refusing the application for registration both under parts A and B of the Register has been produced by consent and is *exhibit* 5 in these proceedings. Following the Registrar's refusal applicant filed the present recourse. 30

The grounds of law upon which the application is based are the following:

* “ 1. ‘Η ακύρωση της έγγραφης έμπορικού σήματος γενομένου ήδη αποδεκτού κατόπιν μελέτης και γραπτής αποδοχής 35

* An English translation of this text appears at p. 370 *post*.

του ὑπὸ τοῦ καθ' οὗ ἡ αἴτησις Ἐφόρου Ἐμπορικῶν Σημάτων
μετὰ τὴν ἐπιβολὴν ὄρου καταχωρήσεως εἰς τὸ Τμήμα Β τοῦ
μητρώου καὶ μετὰ τὴν δημοσίευσιν τῆς ἀγγελίας του εἰς τὴν
Ἐπίσημον Ἐφημερίδα δὲν ἐπιτρέπεται. Μόνον κατόπιν προσ-
5 βολῆς καὶ προσφυγῆς ἀκυρότητος τῆς ἐγγραφῆς ἐκ μέρους
ἐπηρεαζομένου τρίτου καὶ κατόπιν δικαστικῆς ἀκροάσεως
ἐνώπιον ἀρμοδίου καὶ νομίμου δικαστηρίου ἐπιτρέπεται κατὰ
τὸ Σύνταγμα καὶ τοὺς Νόμους ἢ Ἀκύρωσις.

2. Ὁ καθ' οὗ ἡ Αἴτησις ἔσφαλεν εἰς τὸ ὅτι ἡ εἰς τὴν Ἀγγλι-
κὴν καὶ Γαλλικῆς προελεύσεως λέξις PREMIER δὲν εἶναι
10 ἐγγράψιμος καθ' ὅτι αὕτη εἶναι ἐγγεγραμμένη καὶ εἰς Καναδᾶν
ὄπου ἀμφότεραι ἡ Ἀγγλικὴ καὶ Γαλλικὴ γλῶσσαι ὁμιλοῦνται
καὶ εἶναι ἐπίσημοι καὶ εἰς τὴν Ἑλλάδα ὄπου ἡ Ἑλληνικὴ εἶναι
ἐπίσημος ὡς καὶ ἐν Κύπρῳ.”

15 It was contended by learned counsel in the course of the
hearing of the recourse that under the provisions of section
21 (1) of the Trade Marks Law, Cap. 268 it was not open to
the Registrar to withdraw his acceptance because at the hearing
of the 13th March, 1972, he had agreed to register the mark
20 in part B of the register and informed applicant's counsel accor-
dingly by his letter of the 27th March, 1972 (*exhibit 2*). He
also argued that the Registrar's decision is contrary to the
principles of administrative law. He finally submitted that the
word “Premier” according to the Oxford Illustrated Dictionary
25 when used as a noun means “Prime Minister” or “the Secre-
tary of State” and that the registration of the same word was
accepted in Greece.

Learned counsel for the respondent, on the other hand,
submitted that respondent's acceptance could be withdrawn both
30 under the provisions of the Trade Marks Law and under adminis-
trative law; and that the respondent was justified in refusing
to register the mark as such mark was not registrable under the
law.

In so far as the first ground of law is concerned the relevant
35 section of the law is section 21 (1) which reads as follows:

“21 (1). When an application for registration of a trade
mark in Part A or in Part B of the register has been accepted,
and either —

(a) The application has not been opposed and the
40 time for notice of opposition has expired; or

(b) The application has been opposed and the registration has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error or unless the Court otherwise directs, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this law to be the date of registration.

(2) On the registration of a trade mark the Registrar shall under his hand and seal issue to the applicant a certificate in the prescribed form of the registration thereof.

(3) Where registration of a trade mark is not completed within 12 months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice".

It is quite apparent from the wording of this section that the Registrar has power to refuse registration even though the application has been accepted in the first instance and there has been no opposition to the registration if such application has been accepted in error. It is significant that under rule 53 of the Trade Marks Rules 1951 entry in the Register after the expiration of two months from the date of the advertisement in the Gazette is made subject to the determination of any opposition and also subject to the provisions of section 21(1). Furthermore both the initial acceptance and the advertisement of the application are merely interim measures leading to the final act, the registration of the trade mark, and in view of this and of the express provision in the law it is not correct to say that under administrative law it was not open to the Registrar to withdraw his acceptance.

Regarding the issue of registrability, to which the argument before me on behalf of the applicant was confined, the relevant section of the law is section 11 (1) which reads as follows:

" 11 (1). In order for a trade mark to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) The name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- 5 (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- 10 (e) any other distinctive mark but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence
- 15 of its distinctiveness”.

There is no question that the only paragraphs under which this application could be considered are paragraphs (c) and (d) *i.e.* whether the trade mark to which the application related was an invented word or a word having direct reference to the character or quality of the goods.

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As to paragraph (c) I think it is impossible to suggest that the word “Premier” is an invented word in the sense that it is “new and freshly coined” as very aptly described by Lord Macnaghten in the “Solio” case (*Eastman Photographic Materials Co. Ltd. and the Comptroller-General of Patents, Designs and Trade Marks* [1898] A.C. 571). It is a word in ordinary and common use and is to be found in any English or French dictionary; and there is ample authority in support of the proposition that a foreign word cannot merely by reason thereof be considered an invented word.

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Regarding paragraph (d) I agree with the submission of learned counsel for the respondent that having regard to the meanings of the word it cannot be said that it has no direct reference to the character and quality of the goods.

In the light of the above I hold the view that it was open to the respondent to take the decision complained of and that this recourse must, therefore, fail. In all the circumstances I make no order as to costs.

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*Application dismissed.
No order as to costs.*

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This is an English translation of the Greek text appearing at pp. 366-367 *ante*.

“ The revocation of the registration of a trade mark which had already been accepted upon due consideration and written acceptance by the respondent Registrar and after the imposition of a term for registration in Part B of the Register and after publication in the Official Gazette, is not permitted. Revocation is, by virtue of the provisions of the Constitution and the laws, only permitted upon a recourse for annulment by an interested party and upon a judicial hearing by a competent and lawfully constituted Court. 5 10

2. The respondent erroneously decided that the English word PREMIER, which is of French origin, is not registrable in that it is also registered in Canada, where both the English and French languages are spoken and are the official languages, and in Greece where, as in Cyprus, the Greek language is the official one”. 15